

The Courts Fourth Finding of Fact Was That:

"The Lincoln Engineering Company of Missouri initially engaged in the business of making and selling automobile lubricating equipment in 1925, supplying its equipment exclusively to plaintiff. This relationship between the Lincoln Company and the plaintiff continued for several years thereafter, until 1933".

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The Courts Fourth Finding of Fact Was That:
The Butler patent in suit No. 1,593,791 illustrates, describes, and claims lubricating apparatus in which a headed or shouldered nipple or fitting is provided for attachment to each bearing of an automobile or other machine to be supplied with lubricant from a lubricant compressor or pump by successively attaching to the nipple a coupler with which the nipple cooperates to make a lubricant-tight connection by engagement against the end of the nipple, and which coupler has jaws engageable about the throat of the nipple automatically to grip the nipple when the compressor is operated in the customary way to deliver lubricant to a bearing. The tightness of the seal effected between the nipple and the coupler, and the tightness of the grip between the nipple and the coupler, are increased proportionately with increases in the pressure of the lubricant being supplied to the bearing".

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The Courts Fifth Finding of Fact Was That:

"In practical operation, grease pressures running up to thousands of pounds per square inch are frequently required in order to force the grease into the interstices of a bearing".

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The Courts' Sixth Finding of Fact Was That:

"When the compressor is operated to inject grease under these high pressures, the tendency is to burst the compressor, coupler and the nipple, and to break open the connection between the coupler and the nipple by forcing these parts asunder" 31

The Courts' Seventh Finding of Fact Was That:

"Because of the tremendous pressures which must be developed in a lubricating system it is important in order to prevent leakage of lubricant to secure the maximum tightness of seal and the maximum mechanical grip. Both the strength of the grip and the tightness of the seal must be proportional to the pressure of the grease to be transmitted. If the seal is not sufficiently tight, the grease will escape—and the requisite pressure cannot be developed. If the grip is not sufficiently strong, the parts will be forced asunder" 31

The Courts' Eighth Finding of Fact Was That:

"In the Butler combination the automatic end seal and the automatic grip both become more effective as the lubricant pressure increases and the need for a more effective seal and grip becomes greater" 31

The Courts' Ninth Finding of Fact Was That:

"In the Butler patent the end seal member is movable and thus may adjust itself to fittings (nipples) of slightly different dimensions" 32

The Courts' Tenth Finding of Fact Was That:

"Any resiliency in part 42, referred to in the Butler patent as constituting spring fingers, serves the purpose of compensating for any slight out-of-roundness of the fitting" 32

The Courts' Eleventh Finding of Fact Was That:

"Butler, applicant for the patent in suit, presented to his solicitors for the purpose of preparing the application for the patent in suit, a sample device including a coupler, the jaws of which were forced into clamping engagement with the nipple by a relatively rigid, hollow cylindrical part, corresponding exactly to the disclosure in Fig. 2 of the Butler patent here in suit. Claim 2 of the patent describes this early sample of the invention".....

32

The Courts' Twelfth Finding of Fact Was That:

"Butler was the first to propose or to devise a lubricating system in which the sealing of the joint between the end of the nipple and the coupler, and the mechanical grip between the nipple and the coupler, were effected automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor".....

33

The Courts' Thirteenth Finding of Fact Was That:

"Claim 2 of the Butler patent describes in more or less detail, a combination of seven elements which may be enumerated as nipple, compressor, cylinder, piston, aperture, jaws and sealing seat. Each and all of these parts cooperate with one another in new ways in the accomplishment of a new and unitary result".....

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The Courts' Twentieth Finding of Fact Was That:

"The Alemite Hydraulic system comprises the combination of elements set forth in claim 2 of the Butler patent".....

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The Courts' Fifteenth Finding of Fact Was That:

"Plaintiff commenced selling the Alemite Hydraulic lubricating equipment exemplified in Plaintiff's Exhibit 13 to 29 and 22 to 25, inclusive, in April, 1933" 40

The Courts' Sixteenth Finding of Fact Was That:

"Plaintiff sold 281,555,000 of the Alemite Hydraulic fitting parts of the combination during the period from April, 1933, to March, 1936, and during this same period sold 6,306,000 of the Alemite Hydraulic coupler parts thereof" 40

The Courts' Seventeenth Finding of Fact Was That:

"Of the 6,306,000 Alemite Hydraulic coupler parts sold during the period from April, 1933, to March, 1936, approximately 4,485,000 were sold with their associated compressors to automobile manufacturers, to be put in the tool kits of the cars at the factory" 44

The Courts' Eighteenth Finding of Fact Was That:

"The Alemite Hydraulic lubricating equipment embodying the invention of the patent in suit rapidly superseded the Gullborg and Zerk lubricating equipment because

(a) Under this equipment, it was not necessary to manipulate any coupler mechanism in the operation of attaching and detaching the coupler to and from the fitting,—as was necessary in effecting a connection between a Gullborg coupler and fitting, and

(b) It was not necessary for the user to apply force to hold the coupler against the fitting to prevent separation of these parts,—as was required in effecting a connection between the coupling nozzle and fitting of the Zerk lubricating system.

Within eight months after its introduction on the market, the plaintiff's Alemite Hydraulic system had been adopted as the factory lubricating equipment of every automobile and truck made in the United States, with the single exception of the Duesenberg"....

The Courts' Nineteenth Finding of Fact Was That:

"The mechanism embodied in the means by which the jaws are compressed about the nipple of the Alemite Hydraulic system, is identical in its mechanical principles with that disclosed in the Butler patent. It is a simple equivalent involving a mere reversal of parts"

The Courts' Thirty-first Finding of Fact Was That:

"There is nothing in the Butler patent which requires the use of spring fingers which can yield a substantial amount"

The Courts' Twenty-second Finding of Fact Was That:

"When, shortly after January 1, 1933, Lincoln Engineering Company began selling automobile lubricating apparatus to others than Alemite, the sales of such apparatus, equipped with couplers or nozzles of its own manufacture, were made with the knowledge and expectation that the purchasers would use the apparatus in combination and conjunction with Alemite fittings"

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The Courts' Twenty-third Finding of Fact Was
That:

"In May, 1933, Mr. A. P. Fox, the vice-president and designing engineer of Lincoln Engineering Company of Missouri, became familiar with the nipple parts of the Alemite Hydraulic system. Although he had known of the compressor and coupler parts at an earlier date, he became familiar with them at least as early as January, 1935". 49

The Courts' Twenty-fourth Finding of Fact Was
That:

"The Lincoln Company's Kleenseal nipples were thereafter sold with the knowledge that they could be substituted for the plaintiff's nipple part of the Alemite Hydraulic combination, and that they would be so combined in use. Claim 2 applies to the combination in the same way, regardless whether it incorporates the Lincoln Company's Kleenseal nipple part or the plaintiff's nipple part". 50

The Courts' Twenty-fifth Finding of Fact Was
That:

"The dimensions of the Lincoln Kleenseal fitting are exactly such as to make it cooperate satisfactorily with an Alemite Hydralic coupler. If the dimensions selected had been slightly different, such cooperation would have been impossible. Similar fittings of slightly different dimensions would have had all other utilities which have been ascribed to the Lincoln Company's fittings, and would have cost no more to make". 50

The Courts' Twenty-seventh Finding of Fact Was

That:

"Defendants sold Lincoln Kleenseal fittings
..... with the knowledge that they were to be used
..... in combination with the compressor and
coupler parts of the latter combination as
sold by the plaintiff for use with plaintiff's
Alemite Hydraulic coupler equipped grease
guns".....

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The Courts' Twenty-eighth Finding of Fact Was

That:

"The Lincoln Engineering Company of Mis-
souri expected that automobiles equipped
with the Lincoln nipple part of the combina-
tion and sold in the United States, would be
lubricated at garages and service stations.
The plaintiff had previously sold millions of
the compressors and coupler parts of the
combination, and had endeavored to supply
every public garage and service station in
the United States".....

50

The Courts' Twenty-ninth Finding of Fact Was

That:

"The Lincoln Engineering Company of Mis-
souri in its Kleenseal fittings, duplicated,
fitting for fitting, all of the arbitrary dimen-
sions of the entire line of Alemite Hydranlic
fittings".....

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The Courts' Thirtieth Finding of Fact Was That:

"The Lincoln Engineering Company did not
sell any of its grease guns or nozzles to
automobile manufacturers for tool kit equip-
ment of automobiles sold in the United
States, even though the automobiles were
equipped with Lincoln Kleenseal fittings".....

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| The Courts' Thirty-third Finding of Fact Was That: | |
| The Alemite Hydraulic coupler will grip and form a sealed connection with a Lincoln Kleenseal fitting as well as with an Alemite Hydraulic fitting and claim 2 of the Butler patent describes one combination as well as the other" | 51 |
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| "The Winkley Reissue patent No. 14,667 does not disclose the radially movable locking elements, the piston, or the means actuated by the piston for compressively clutching the locking elements upon the nipple, as Butler's invention is defined in claim 2 of his patent. The Winkley patent discloses a coupler having a spring pressed sealing member. It is not in any way analogous to the combination of elements defined in But- ler's claim 2" | 57 |

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IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1937.

No. **608**

LINCOLN ENGINEERING CO. OF ILLINOIS,
Defendant-Petitioner,
vs.

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

RESPONDENT'S BRIEF.

FOREWORD.

**THE PETITIONER'S STATEMENT OF THE CASE IS
QUITE MISREPRESENTATIVE. IT DOES NOT
ONCE CITE OR REFER TO ANY OF THE TESTI-
MONY.**

Paragraph 2 (d) of Rule 27 requires that the petitioner's brief shall contain "a concise statement of the case, containing all that is material to the consideration of the

questions presented, with appropriate page references to the printed record, e. g. (R. p. 12)."

The first half of petitioner's 90-page brief is devoted to a purported statement of the case. The printed record comprises more than 700 pages, of which some 275 pages comprise the narrated testimony of the witnesses upon the trial.

Except for the identification of various documents and papers, such, for example, as the opinion of the Court of Appeals, and copies of certain patents, the petitioner's brief does not, throughout the whole of its 90 pages, make one single reference to or citation of the record. Not one word of the testimony contained in it is cited or referred to.

The First Page of the Petitioner's Brief Is Typical of All of Its Pages.

The petitioner's purported statement of the case is an ingeniously contrived misrepresentation of the facts. Petitioner's brief starts off on the first page with the statement that

"The Circuit Court of Appeals held that the sale by the petitioner of an old grease-cup, constituted 'contributory' infringement of the patent in suit, even though the patent in suit is based upon an alleged improvement in an entirely different device, to-wit, an alleged improvement in a coupler. The patent in suit, while based upon an alleged improvement in the internal construction or mechanism of a coupler, claims the allegedly improved coupler in so-called 'combination' with the old grease-cup and the old pump with which the allegedly improved coupler is intended to be used." (The emphasis is that of counsel for the petitioner.)

The Butler patent in suit neither describes nor claims nor alludes to anything which is called a "grease-cup."

Neither the patent in suit nor the respondent nor anyone

else has ever alleged or contended that the patent in suit describes or claims an "improved coupler" or an "improvement in a coupler" or "an improvement in the internal construction or mechanism of a coupler." One of the elements of the combination claimed in the patent in suit is a "lubricant compressor" (see claims 1 and 2, R. p. 470). Counsel for petitioner choose to re-name this element as a "pump." No lubricant compressor prior to the advent of Butler's invention ever performed the functions of Butler's compressor. Yet counsel for the petitioner choose in the opening paragraph of their brief to refer to this lubricant compressor as "the old pump."

Butler describes and refers to one part of his unitary lubricating mechanism as a "headed nipple." In their very first breath, counsel for the petitioner apply a new name to this part; they call it a "grease cup." Although no nipple which existed prior to the advent of the Butler invention,—although no "grease cup" which existed prior to the advent of the Butler invention had either the mode of operation or the functions of the "headed nipple" part of the Butler combination,—counsel for the petitioner immediately dub this re-named part with the appellation "old."

The plaintiff, Stewart-Warner Corporation, purchased the Butler patent from the Cincinnati Ball Crank Company (R. p. 36), and in April, 1933, began for the first time to manufacture and sell the lubricating device described and claimed in this Butler patent. It was not until a year and a half later,—in October, 1934, that the defendant, Lincoln Engineering Company, devised and began to sell the headed nipple part of the Butler invention. (R. p. 124) The Lincoln Company's headed nipple was newly and specially contrived for the sole purpose of enabling it to be incorporated as a part of the lubricating mechanism

of the Butler patent in suit, as manufactured and sold by Stewart-Warner. No such "headed nipple" had ever existed until more than a year after the Stewart-Warner Corporation began to market the Butler invention in April, 1933.

Nevertheless, counsel for the petitioner, on the first page of their brief, refer to this new and specially contrived nipple as an "old grease cup."

The petitioner's misrepresentations as to what is alleged by the respondent to constitute the real invention of the Butler patent, the misnomers, and the nonapplicable adjectives with which counsel for the petitioner begin their brief, are reiterated and repeated throughout some 90 pages. Every succeeding page contains similar misrepresentations of the facts. We could devote the whole of a long brief to a criticism and correction of the factual background upon which petitioner's counsel attempt to carry their argument.

Any such word-by-word criticism and correction of the factual assumptions of the petitioner's brief would be wearisome to us and wearisome to the Court. Let us turn rather to the record itself.

A RESTATEMENT OF THE CASE AS DERIVED FROM THE RECORD.

AS AGAINST THE PETITIONER'S PRETENDED STATEMENT OF THE FACTS, WE WISH TO CONTRAST THE REAL FACTS AS DETERMINED BY THE LOWER COURTS AND AS THEY APPEAR IN THE RECORD.

Counsel for the petitioner have pretended to state the facts in their own language. Let us state the facts in the language employed in the decisions of the Courts. It will promptly become apparent that the facts as determined by the courts are radically at variance with the facts as presented to your Honors by counsel for the petitioner.

The Facts As Determined by the Seventh Circuit Court of Appeals.

In its opinion, the Seventh Circuit Court of Appeals pointed out that

"the District Court prepared his own findings and conclusions which fully covered the nature of the invention, the claims, the defenses, the state of the art, as well as other material issues." (91 Fed. (2d) 757, 758.)

At page 759 of its opinion, the Court of Appeals adopted Judge Lindley's characterization of the Butler invention, saying:

"Judge Lindley, describing the patent, said:

"* * * Butler was the first to propose or to devise a lubricating system in which the sealing of the joint between the end of the nipple and the coupler and the mechanical grip between the nipple and the coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping opera-

tion of the compressor, . . . the advantage of this combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized . . . due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler into the fitting, the coupler grabs hold of the projecting shoulder of the nipple with its jaws and automatically, as the pressure of the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for grease to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure.' ''

A little later in the opinion of the Seventh Circuit Court of Appeals, his Honor Judge Evans quoted *in extenso* what he called "the substance of the more important findings of the trial court."

The Court of Appeals approved and adopted Judge Lindley's factual determinations. The Judges of the Court of Appeals pointed out, however, that they had not done so either blindly or carelessly. They said expressly,

"It is only after observation of the various lubricating systems that we have come to the same conclusion as was reached by the District Court." (91 Fed. (2d) 757, 765.)

Before quoting further from the opinion of the Court of Appeals relative to the facts which distinguish the instant suit, let us turn first to the factual situation as found by the District Court and subsequently approved and adopted by the Court of Appeals. The defendant's various petitions subsequent to the filing of an original opinion by the District Court, led Judge Lindley to supplement his original opinion with two further opinions.

The Three Opinions of the District Court and the One
Opinion of the Court of Appeals.

Judge Lindley's first opinion is reported at 15 Fed. Supp. 571. His second opinion is reported at 16 Fed. Supp. 778. His third opinion is reported at 31 U. S. P. Q. 195. All of these opinions, as also the opinion of the Court of Appeals, are reprinted in a pamphlet which accompanied the respondent's brief in opposition to the petition for writ of certiorari.

SOME OF THE FACTS AS SET FORTH IN THE OPINION OF THE DISTRICT COURT AND AS SUBSEQUENTLY ADOPTED AND APPROVED BY THE COURT OF APPEALS.

Here, then, are the facts as determined by the District Court and as subsequently adopted and approved by the Court of Appeals.

The Invention of the Butler Patent.

In his first opinion, Judge Lindley said:

"Claim 2 of the Butler patent describes a lubricating system for automobiles or other machines, essentially high pressure in character, in which each bearing is provided with a headed nipple for receiving oil or grease of a lubricant compressor having a coupling member for connecting said compressor with the nipples. The coupler is slipped easily and somewhat loosely over the nipple head. As the operator pushes on the compressor, the pressure of the lubricant moves a piston within the cylinder in such manner as to cause the locking or gripping jaws to clutch or grab about or upon the nipple head. At the same time the grease under pressure acts also upon an apertured sealing seat, carried by the jaws and actuated by the piston in such a way as to engage the end of the nipple and thereby produce a tight seal. Gripping, grabbing or clutching of the nipple is effected automatically, and engagement of the seal against the end of the nipple is achieved in the same manner. Both of these functions are effectuated by the pressure of the lubricant, without other manipulation of the coupler. Thus, the coupler and nipple are so constructed as to produce an essential relationship between the two functions and the mechanism for performing them. Yet each of the two functions is carried out completely and perfectly without interference by the other. As a result, the operation is successful even though there be considerable

{ variation in the precise dimensions in the forms and parts involved.

"Upon analysis we find that the claim includes seven elements; namely, a headed nipple, a compressor or pump, a cylinder, a piston, an opening in the piston, a sealing seat, and laterally or radially moving locking elements or jaws." (15 Fed. Supp. 571, 572.)

The Butler Invention Is a New Combination of Generically Old Elements.

Regarded generically, each of these seven elements is just as old as counsel for petitioner assert the nipple be. On the other hand, the precise conformation of the nipple whereby it is enabled to knit itself into the cooperative unit involving all of the seven elements, is just as new as each and every other element of this combination. Judge Lindley himself adverted to these facts. He said in this connection:

"Admittedly, each of these elements is old, and plaintiff makes no claim of invention because of the presence of any one of the particular elements, but insists that invention resides in a new combination of old elements so associated, related and interrelated as to accomplish a new result."

"The headed nipples are adapted to be screwed to each of the bearings of an automobile; the compressors are intended to be filled with grease and then to be coupled in succession to each of the nipples in order to inject grease into the openings of the several bearings. Consequently, the combination of the nipple, compressor, and coupler is brought together only periodically and temporarily and in the hands of the owners or servicers of the car." (15 Fed. Supp. 571, 572.)

Butler Accomplished a New and Unitary Result by the New Relationships and the New Functions of All of the Several Parts of the Combination.

Then, after thus setting forth that the Butler invention was an entirely new structure, different in construction and operation from the prior art, the District Court went on to say:

"Here the question is whether Butler produced a combination which achieved a new and unitary result by the cooperation of all the elements, whether all the elements have new or modified functions as a result of changes or substitutions, or whether the old elements have only the old functions operating and cooperating in the old way to produce only an old result. We have seen that the combination consists of seven elements, all of which are old; that invention arises not from any one element, but from the new unitary result. Defendant insists that the essence of the combination is the coupler, but we have seen this is a fallacious theory, for if it were correct and available to excuse the use of the nipple to cooperate in the combination, one person might make the nipple, another, the cylinder; another a group of jaws, another the sealing seat; another the piston. Each of these are old; each of them sell separately. The purchaser could quickly assemble them and then claim that each part had an independent status apart from that in the Butler combination. There could then be no infringement.

"The headed nipple, which cooperates with the sealing seat and jaws of the coupler and thus with the piston and cylinder, is just as essential a part of the Butler invention as any of the several elements of the coupler. There is cooperation between the nipple and the jaws which produces the operation of the seal, which in turn effectuates the operation of the gripping jaws, making possible heretofore unachieved pressures. The headed nipple has new functions arising out of the direct cooperation with the jaws. The head spreads the jaws of the coupler when the latter is attached and thus prepares the coupler for operation in bringing about a mechanically strong and lubricant tight joint. In de-

taching the coupler the head of the nipple engages and pushes the jaws outwardly. These in turn push the piston backward, thereby effecting the release of the coupler from the nipple. The presence and the action of the nipple are essential, because the nipple alone makes it possible to build up in the cylinder of the coupler a grease pressure which will force the jaws into gripping enforcement with the nipple. The nipple is not merely a receptacle. It becomes an element which coacts to influence and make possible the desired operation of the coupler mechanism.

"Butler was the first to utilize a headed nipple and a compressor as cooperating elements of a combination whereby a grease-tight and mechanically strong connection between compressor and bearing were effected automatically in and by the grease pumping operation of the compressor alone."

"The high pressure delivery of grease from the compressor to the interior of the bearing, due to the strong and grease-tight attachment of the grease gun to the grease passageway of the bearing, was a new, useful, and unitary result. It could not be accomplished with anything less than the combination of all of the elements included in Butler. Each part of the combination performed new functions and operated and cooperated in new ways in order to accomplish the single new result. The invention of Butler resides in the combination and not in one specific element. Every one of the seven old elements' functions became essential factors in the new combination. The situation is not one where the language of the Supreme Court in the Gullborg case (56 S. Ct. 787, 791, 80 L. Ed., 1251) is applicable, for in the sense that the Supreme Court used the term pioneer, Butler is equally a pioneer. A completely new unitary result is achieved; something never accomplished before. Just as the Supreme Court said of the Berliner patent, 'each element was necessary to the operation of the other.' " (15 F. Supp. 571, 578, 578-579.)

Upon petition for rehearing, the District Court delivered a second opinion in which Judge Lindley said:

"We may well again refer to the character of the

Butler patent. I have pointed out in my findings of fact and conclusions of law heretofore entered that Butler was the first to propose or devise a lubricating system in which the sealing of a joint between the end of the nipple and coupler and the mechanical grip between the nipple and coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, and that the advantage of this combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized in order to remove and force out foreign bodies in the grease duct or channel. Former devices provided a seal by a screw connection between the coupler and the fitting, by a bayonet connection or by mere manual physical pressure. In all of these, some leakage occurred, and physical manipulation entailing some labor was necessary. In none of them could the pressure be exerted and the grease delivered perfectly without leakage, under desirable pressure, and with the saving of labor resulting from Butler's teaching. I previously pointed out, due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler into the fitting, the coupler grabs hold of the projecting shoulder of the nipple with its jaws and automatically, as the pressure of the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for grease to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure. This, I have said, was a step forward in the greasing of automobiles. No one had ever taken it, though the art is full of grease guns and nipples. It remained for Butler to devise an easy operable combination in which the nipple and the coupler automatically cooperate, each contributing its part to the one result of high pressure grease delivery through a sealed connection, effected automatically and

increasing in efficiency with the increase of the pressure. This, I said, was invention and the combination, I held, became, therefore, a pioneer invention in the sense that the Supreme Court used that word in the Leeds & Catlin case." (16 F. Supp. 778, 781.)

"So, here, Butler introduced into the art the idea of an automatic sealing connection achieved by the size and character of elements, which, in themselves, were old. But he employed a different mode of operation. He achieved his object by means of a different force and according to a different and new conception. His invention then was not an improvement but a new and separate invention and, within the reasoning of the Supreme Court in the Leeds & Catlin and the Hollingshead and Rogers cases, a pioneer. In the latter two cases the court was not dealing with a combination patent wherein, by the use of a nipple of a certain particular form and shape and dimensions cooperating with the gripping jaws of a coupler of special form and shape, an automatic unbreakable connection was achieved, making possible that highly desirable thing in automobile greasing, unlimited pressure. Butler did not combine a certain coupler with any nipple. He did not combine a certain nipple with any coupler. He was not, as the Supreme Court believed Gullborg had done, trying to extend his patent to a combination of a certain nipple with *any* kind of grease gun. Quite to the contrary, he demonstrated conception of a new creative thought, the achievement of a new valid combination in which not only the coupler was essential, but in which also the nipple of peculiar shape and dimension was essential. He produced a new combination, a new arrangement of known elements, by virtue of which he produced an entirely new and beneficial result. He developed new functions and new properties and achieved novelty, resulting in great commercial success.

"In this situation, defendant entered the field and developed its nipple of equivalent form, shape, and dimensions, which it sold, obviously, for use with Alemite guns, supplanting in the combination of Butler the nipple essential to his success. It is a striking fact that a nipple of this shape and dimension was not necessary.

to the operation of defendant's grease gun or of any guns other than those of plaintiff or of infringers or licensees of plaintiff—a fact of tremendous significance in determining the purposes and intent of defendant. It sold grease guns which operated with straight-headed nipples as well as with nipples with head and shoulders. It first made straight-headed nipples and exhibited them to General Motors Corporation, but it sold to that company only nipples of infringing character, a character not essential to any combination other than plaintiff's." (16 F. Supp. 778, 782.)

In his third opinion in this same suit, his Honor Judge Lindley said in part:

"I have the conviction that this patent is valid. I have the conviction that it is being infringed and an infringement of a patent is a tort. There is a continuing tort being committed by the defendants, a tort which a Court of Equity has seen fit to enjoin and a tort which the Court believes unjustified; a tort which the Court believes, by a mere minor modification in the manufacture of one small article, could be wholly avoided, and the strange commentary—the strange fact which stares us in the face, is that the particular form of manufacture, the particular shape of this small fitting, is, in no way, a vital idea to the defendant in cooperation with its other articles of manufacture, and this peculiarly shaped fitting is the one which is adapted to plaintiff's combination. Having found that this fitting was made for the express purpose of being sold to be used with and as a part of the infringed plaintiff's combination, and having found there was no excuse for the perpetuation of that tort in the protection of the defendant's interests, I am not disposed at this time, in view of the time that has elapsed since the hearing, to grant a supersedeas. I make this statement so that it may be presented to the Court of Appeals."

**IN THE FOLLOWING STATEMENT OF THE FACTS,
WE HAVE ADOPTED AS OUR CAPTIONS THE SEV-
ERAL FINDINGS OF FACT AS DETERMINED BY
THE DISTRICT COURT AND SUBSEQUENTLY AP-
PROVED BY THE COURT OF APPEALS.**

We have, in the foregoing quotations, stated certain of the facts said by the Court of Appeals to have been independently determined by it and in part as determined by the District Court and expressly adopted by the Court of Appeals.

In his third opinion in this case (31 U. S. P. Q. 195), his Honor Judge Lindley said:

"This case has been before the Court for some time and a rather extensive record was made up on the trial of the case. The Court expended a great deal of time, care, and study in the preparation of its memoranda, its findings of fact, and conclusions of law, and a decree was entered."

At the outset of its opinion, the Seventh Circuit Court of Appeals said:

"The trial was a long one, and the District Court prepared his own findings and conclusions which fully covered the nature of the invention, the claims, the defenses, the state of the art, as well as other material issues. These findings favored the appellee.

"Accompanying the findings was an opinion which set forth the reasons for the conclusions which the court reached. About three months later, upon a petition for rehearing filed by appellant, the court filed a second opinion, which may be found in *Stewart-Warner Co. v. Leavally* (D. C.) 16 F. Supp. 778. Three weeks later the court filed a third opinion which dealt with questions raised by appellant. The third opinion appears in 31 U. S. P. Q. 195. Reference is made to the places where these opinions appear because it will, we think, justify a more abbreviated statement of the facts."

Each of the following subcaptions quotes one of the findings of fact by the District Court and as approved by the Circuit Court of Appeals. All of these findings of fact are incorporated at pages 431 to 437 of the record. We have supplemented each of the Court's findings of fact with references to the parts and pages of the record showing the evidence upon which each particular finding was based.

The Courts' First Finding of Fact Was That:

"Plaintiff is a Virginia corporation and is the owner of the Butler patent No. 1,593,791, and of all rights thereunder." (R. pp. 35-36.)

The Courts' Second Finding of Fact Was That:

"Defendant Lincoln Engineering Company of Illinois is the distributor for the Chicago territory of lubricating apparatus manufactured by the Lincoln Engineering Company of St. Louis, Missouri, a Missouri corporation." (R. p. 35.)

The Courts' Third Finding of Fact Was That:

"The defense of this suit is being conducted by and under the control of Lincoln Engineering Company of St. Louis, Missouri, a Missouri Corporation." (R. p. 35.)

The lubricating apparatus manufactured by the Lincoln Engineering Company of St. Louis and sold by the defendant herein is marketed under the trade name Lincoln (R. pp. 141, 391-401).

Its infringing nipples are sold under the trade name Lincoln "Kleenseal" (R. pp. 87, 141, 397-399).

The Courts' Fourteenth Finding of Fact Was That:

"Prior to manufacturing and selling the Alemite Hydraulic system of the patent in suit (exemplified in Plaintiff's Exhibits 13 to 20 and 22 to 25, inclusive) plaintiff sold lubricating apparatus (Plaintiff's Exhibits 9 and 12) of the types illustrated in Gullborg patent No. 1,307,734 and Zerk patent No. 1,475,980."

The respondent, Stewart-Warner Corporation, through its subsidiaries and predecessors, Alemite Corporation and Bassiek Manufacturing Company, has been engaged since 1918 in the manufacture and sale of lubricating apparatus, first under Gullborg patent 1,307,734, and later under Zerk patent 1,475,980 and under many other patents. This lubricating apparatus of various kinds has always been sold under the trade name and mark "Alemite" (R. p. 38 and pp. 341-369).

The Courts' Twenty-first Finding of Fact Was That:

"The Lincoln Engineering Company of Missouri initially engaged in the business of making and selling automobile lubricating equipment in 1925, supplying its equipment exclusively to plaintiff. This relationship between the Lincoln Company and the plaintiff continued for several years thereafter, until 1933."

Relative to the same matter Judge Lindley said in his opinion of July 15, 1936:

"For seven years prior to January 1933, the Lincoln Engineering Company of St. Louis, Missouri, who is defending this suit, and who is treated herein as the real defendant, had manufactured grease guns for plaintiff. The latter took all of its product. Stewart-Warner had furnished couplers and nozzles to Lincoln, and the latter had incorporated them in compressors, which it in turn sold to Stewart-Warner. These compressors and nozzles were used in combination with hundreds of millions of Gullborg pin fittings and Zerk push type fittings manufactured and sold by plaintiff." (R. p. 605 and R. pp. 39, 79-80, 115-120.)

The Courts' Fourth Finding of Fact Was That:

"The Butler patent in suit No. 1,593,791 illustrates, describes, and claims lubricating apparatus in which a headed or shouldered nipple or fitting is provided for attachment to each bearing of an automobile or other machine to be supplied with lubricant from a lubricant compressor or pump by

successively attaching to the nipple, a coupled with which the nipple cooperates to make a lubricant-tight connection by engagement against the end of the nipple, and which coupler has jaws engageable about the throat of the nipple automatically to grip the nipple when the compressor is operated in the customary way to deliver lubricant to a bearing. The tightness of the seal effected between the nipple and the coupler, and the tightness of the grip between the nipple and the coupler, are increased proportionately with increases in the pressure of the lubricant being supplied to the bearing."

In his opinion of July 15, 1936, Judge Lindley supplemented his above-quoted finding of fact in description of the Butler invention. (R. p. 616.)

The Butler patent in suit appears at R. p. 464. The drawings contain several figures, but Figures 1 and 2 alone illustrate the subject-matter of claim 2, which alone is involved in this suit. We have reproduced these Figures 1 and 2 of the Butler patent on a colored chart attached to the back cover of this brief. We shall describe the construction and mode of operation of the Butler invention by reference to this colored chart, on which we have applied the same reference characters as those of the patent drawing.

In this colored reproduction of the Butler drawings, there is shown a lubricant compressor 9 which, together with its flexible discharge conduit, is colored yellow. This flexible discharge conduit terminates in a coupler represented generally by C and shown on an enlarged scale relative to that of the compressor and conduit 9. The coupler is shown in engagement with the blue nipple 35, which is threaded at the right end for attachment to the bearing of an automobile. There is an inwardly opening check-valve at the inlet end of the nipple, with a spring holding it to its seat. The coupling C comprises a green

shell providing a cylinder 50, in which there is a reciprocatingly mounted purple piston composed of a cup leather 45 and a metal backing part 43. The cup leather 45 makes a grease-tight seal against the inner wall of the cylinder 50 so as to prevent the leakage of grease around the piston. (R. pp. 51-54, 467-470.)

The right-hand end of the piston member 43, 45 comprises also a tubular or cylindrical extension which terminates at its right-hand end in an inclined female conical surface which engages the conical male surface or surfaces of the three red segmental jaws 40 (R. pp. 51-54, 467-470).

When a bearing is to be lubricated, the two halves of the interconnecting mechanism are brought together by the operator. The right-hand end of the coupler is pushed over the head of the nipple, thereby causing the head of the nipple to wedge its way into the space between the jaws. In so doing, the head of the nipple 35 spreads the jaws 40 of the coupler. These jaws cannot, however, be pushed radially outward without engaging the conically tapered cam surface at the forward end of the piston member. The result of the outwardly wedging action of the head of the nipple upon the jaws of the coupler is therefore to push the purple piston mechanism 46, 43, 42 to the left. It is necessary that the purple piston mechanism be pushed to its left-hand position in order that it may subsequently be pushed to the right by the pressure of the grease in order to effect the compression of the jaws of the coupler around the throat of the nipple. It is therefore the wedging action of the head of the nipple between and upon the jaws of the coupler which "cock" the coupler mechanism, thereby putting it in condition to respond subsequently to the pressure of the grease to effect the automatic gripping of the headed nipple to the coupler mechanism. It requires only a very small force on the part of the operator to slip the end of the coupler half of the

connector over the nipple half of the connector; in order to cause the head of the nipple to push and wedge its way into the space between the jaws. Only a small force is required because the piston 43, 45 is mounted to reciprocate freely and easily in the well-greased bore of the coupler shell 50.

The gripping mechanism of the coupler having thus been cocked by the headed nipple as it enters the space between the jaws of the coupler, the result is that when the compressor 9 is actuated to force grease into the space 50 behind the piston 43, 45, this piston will tend to move forwardly, i. e., toward the right. The inclined female surfaces at the right-hand end of the purple piston engage the outer conical surface of the three red jaws 40, thereby compressing or forcing these jaws inwardly against the throat of the blue nipple 35. When the piston 43, 45, 42 is pushed toward the right by the force of the grease pressure, the three red jaws 40 are prevented from moving toward the right with the piston itself by the perpendicular end wall of the cylinder as formed by the inturned flange of the green coupler shell.

As soon as the inner surfaces of the jaws engage about the throat of the nipple the nipple itself exerts its reaction in such a way as to prevent the further forward movement of the piston 45, 43, 42. The result is that the red jaws 40 are compressed between the inclined or tapered surface at the right-hand end 42 of the purple piston and the perpendicular surface of the adjacent end wall of the green coupling shell and the throat of the blue nipple 35. (R. pp. 51-54, 467-470).

The force which the inclined surfaces at the right-hand end of the piston exert on the three jaws, and consequently the force with which the three jaws grip the throat of the nipple just beneath its head is determined by the resistance

which the bearing offers to the ingress of grease through the bore of the nipple 35,—because the pressure of the lubricant, acting at the rear 50 of the piston 45 is dependent upon and limited to the amount of such resistance. The action of the nipple, limiting, as it does, the forward movement of the piston 42, 43, 45, and transmitting, as it does, the resistance of the bearing to the interior of the coupler, sets the stage for the operation of the automatic end sealing device. (R. pp. 51-54, 467-470.)

This automatic end sealing device comprises an orange colored sealing disc or washer 51. As soon as the reaction of the nipple has stopped the further forward movement of the piston 42, 43, 45, and thus brought about the development of an increased grease pressure in the compressor and conduit 9, the grease begins to force its way through the small aperture 48 in the piston, and thus into the space behind or at the left side of the sealing disc 51. (R. pp. 51-54, 467-470.)

The tubular extension 42 of the purple piston constitutes a small cylinder in which this orange colored sealing disc 51 can slide in an axial direction toward the end of the nipple under the influence of the lubricant pressure behind it. The result is that the sealing disc 51 is pushed forward into engagement with the end of the nipple to seal the joint between the grease filled passages of the coupler and the generally tubular wall of the nipple. It will be seen that the construction and operation are such that the sealing disc 51 will be caused to slide forwardly a greater or less distance until it engages the end of the nipple, no matter what the length or the position of the end of the nipple may be (within reasonable limits) as determined by such slightly different lengths of the nipples as will result from wear or from the cheap and slightly inaccurate methods of quantity production which may advantageously be employed.

The Courts' Ninth Finding of Fact Was That:

"In the Butler patent the end seal member is movable and thus may adjust itself to fittings (nipples) of slightly different dimensions." Butler patent, page 2, line 126 (R. p. 468), and R. p. 53.

The Courts' Tenth Finding of Fact Was That:

"Any resiliency in part 42, referred to in the Butler patent as constituting spring fingers, serves the purpose of compensating for any slight out-of-roundness of the fitting."

The Courts' Eleventh Finding of Fact Was That:

"Butler, applicant for the patent in suit, presented to his solicitors for the purpose of preparing the application for the patent in suit, a sample device including a coupler, the jaws of which were forced into clamping engagement with the nipple by a relatively rigid, hollow cylindrical part, corresponding exactly to the disclosure in Fig. 2 of the Butler patent here in suit. Claim 2 of the patent describes this early sample of the invention."

R. pp. 36, 37, 54-56, 245-257, Plaintiff's Exhibits 8, 62, 63, Defendant's Exhibit A-61.

See in this connection, Judge Lindley's Finding of Fact No. 31 (R. p. 435).

And see our argumentative discussion of the proposition that the Stewart-Warner Company's lubricating apparatus does embody to the invention of its own Butler patent. This cylindrical extension was, in the defendant's sample, slotted in several places at its forward end so as to provide such resiliency as would admit of the appellation "spring fingers" (Defendant's Exhibit A-61, Fox testimony, R. pp. 101-103).

In essence this slitting of the cylinder 42 conforms exactly with the plaintiff's views as to the disclosure of the Butler patent. It was, however, directly in conflict with the views

The Courts' Twelfth Finding of Fact Was That:

"Butler was the first to propose or to devise a lubricating system in which the sealing of the joint between the end of the nipple and the coupler, and the mechanical grip between the nipple and the coupler, were effected automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor."

The plaintiff's expert testified very cogently relative to the great advantages which Butler's invention had over the Gullborg and Zerk systems, which had previously filled the market, but which were completely displaced upon the commercial advent of the Butler system. See particularly R. pp. 45-8 and 50-1.

This testimony points out that in the operation of the lubricating equipment of the Gullborg patent, it was necessary for the mechanic to hold the grease gun in say the left hand and to hold the coupler in the right hand. The mechanic reached in with his right hand until he could push the coupler over the pin fitting. He then rotated the coupler with his right hand in order to effect the necessary bayonet lock between coupler and fitting. He then removed his right hand and used it, together with his left hand, in actuating the grease gun. In order to remove the coupler from the pin fitting, it was necessary for the mechanic to reach in again until he could get hold of the coupler, and then to rotate the coupler to disengage the bayonet locking mechanism.

Mr. Williams testified that most of the bearings of an automobile are necessarily located in positions which are difficult of access:

"If you have ever greased a car you know many of the fittings are located in very inaccessible positions, and that becomes more and more pronounced as they streamline them and put all sorts of shields and hoods

underneath and on the sides, making it more and more difficult to get at the fittings, so that it is more and more difficult to get your hand in there to make that connection." (R. pp. 50-51.)

The lubricating equipment of the Zerk patent was intended to overcome the difficulties involved in attaching the coupler of the Gullborg patent to and detaching it from the pin fittings associated with the bearings. The Zerk equipment comprised "push type" fittings. A nozzle was rigidly attached to the end of the grease gun. The arrangement was such that if the nozzle were pushed and held against the fitting with sufficient force, then grease could be delivered from the grease gun through the fitting and into the associated bearing.

This Zerk equipment had the advantage that the mechanic could hold the grease gun in one hand and then poke the nozzle in, through and around intervening obstacles and up against the end of the push type fitting,—all without the necessity of getting his hand into the inaccessible position in which the fitting might be located. It was this Zerk system to which his Honor Judge Evans referred when he spoke of "holding one part of the lubricating system against another while pressure was applied and grease squirted in all directions." It was the Gullborg system to which he referred when he spoke of "making the connection by the pin and slot or bayonet type while crawling under cars and reaching between spokes of a wheel."

The plaintiff's expert explained the reason for Judge Evans' subsequent reference to the squirting of grease in all directions in connection with the use of the Zerk equipment. The reason was that a man was not strong enough to hold the nozzle against the end of the fitting when any considerable grease pressures were required. Mr. Williams explained the tendency of the grease to burst the parts as-

under (R. p. 47). Comparing the Zerk system with that of the Gullborg patent, Mr. Williams said:

"As contrasted with that (the Gullborg system) which is a two-hand operation which calls for the placing of the hand right on the fitting in an inaccessible, dirty, cramped place, we have the Zerk system which does not have any interlocking connections between the coupler parts and the fitting parts. That connection is made simply by manual pressure or holding the two parts together. That means that you can go in from some distance, get on to the fitting, make the contact, and by manual pressure make the seal, and then pump the grease and the grease can go in.

"That was an advantage over the Gullborg system, but it had a disadvantage which was quite serious, or became quite serious, and that was this, that there is always a tendency of the greasing pressure to disrupt the two parts that are making the sealed connection.

* * * As a practical matter, with the Zerk system one can obtain pressures of, oh, perhaps 1500 to 2500 pounds. It depends upon how strong a man is, how strongly he can hold against that disrupting tendency and, of course, what he could hold for one instant he couldn't do all day, if he were in a greasing station.

"Now if I operate this Zerk gun against a Zerk fitting which is placed in this gauge block, you will see that if I operate it as hard as I can, I am getting about 3,000 pounds, and to do that I exerted all my effort. A stronger person could probably get a little more, but he couldn't do it all day." (R. pp. 46-47.)

Mr. Williams pointed out the great advantage in being able to develop pressures running up to five tons or 10,000 pounds per square inch. He demonstrated the ability of the Butler apparatus to inject grease into the interstices of a bearing at pressures of "some 7,500 to 8,000 pounds." (R. p. 50.) He demonstrated the "one hand" application of the coupler part of the connector to the nipple part of the connector in locations so cramped and inaccessible as to be almost beyond the reach of the operator of the Gullborg equipment, and he demonstrated the ease with which

the automatic gripping and the automatic end sealing of the Butler equipment made it possible to reach and grease all of the bearings of an automobile, no matter how difficult of access they would have been to the operator of the Gullborg equipment. (R. p. 50.)

The Courts' Thirteenth Finding of Fact Was That:

"Claim 2 of the Butler patent describes in more or less detail, a combination of seven elements which may be enumerated as nipple, compressor, cylinder, piston, aperture, jaws and sealing seat. Each and all of these parts cooperate with one another in new ways in the accomplishment of a new and unitary result."

Claim 2 of the Butler patent appears at R. p. 470. Judge Lindley quotes this claim in the margin of his opinion, and then discusses it very fully in his first opinion of July 15, 1936, beginning at R. pp. 603-605.

The Courts' Twentieth Finding of Fact Was That:

"The Alemite Hydraulic system comprises the combination of elements set forth in claim 2 of the Butler patent."

A detailed application of claim 2 of the Butler patent to the plaintiff's Alemite Hydraulic system is to be found in the testimony of Lynn Williams, Jr., at R. p. 59. His testimony in this connection concluded with the statement that

"This Alemite Hydraulic equipment as shown in the drawing and in the samples that have been offered in evidence, has in it the combination of elements enumerated in claim 2 of the Butler patent."

The colored chart attached to the back of this brief includes a colored reproduction of the drawing Plaintiff's Exhibit 34 herein. This drawing shows the Alemite Hydraulic type of equipment. It comprises a yellow compres-

sor 9 having a discharge tube or conduit to the end of which is attached the coupler C for connecting the compressor 9 to the blue nipple 35. The coupler consists of a green part providing a cylinder 50 in which there is located a purple piston which is moved toward the blue nipple by the pressure of the lubricant behind or to the left of the purple piston. The piston consists of the cup leather 45 confined between metal washers 43 and 44.

When in preparation for the lubrication of a bearing, the nipple and coupler are brought together, the tapered head and the shoulder of the nipple press the jaws 40 backwardly and outwardly. Their movement is transmitted through the piston members 43, 45 and 44 to the head 47 of the sealing member 51, so that the entire reciprocable assembly moves backwardly within the coupler shell. When the tapered head of the nipple has sufficiently pushed the jaws backwardly, and has sufficiently wedged them apart, the head of the nipple can be moved in to a point at which the end of the nipple engages the semi-spherical face of the sealing member 51, in such a way as to effect a light initial seal between the sealing member and the end of the nipple.

Just as in the form of the invention shown in Figure 2 of the Butler patent, it is the head and shoulder of the nipple which cocks and resets the piston mechanism of the coupler in such a way as to permit of its subsequent operation to bring about the automatic gripping and the automatic end sealing of the coupler to the nipple.

After the nipple has effected this cocking or resetting of the piston mechanism, and after an initial light seal has been effected between the end of the nipple and the sealing member 51 of the coupler, the associated compressor 9 is operated in such a way as to force grease into the rear end of the coupler shell behind the piston 44, 45, and

the associated sealing member 48. When grease under pressure is thus delivered into the rear end of the coupler shell, the purple piston 45 moves to the right under the pressure of the applied grease. The forward movement of the piston forces the red jaws 40 into the conical constriction provided at the right-hand end of the green coupler shell. As the jaws are forced into the tapered bore at the forward end of the coupler shell, they are compressed inwardly in such a way as to grip the nipple behind its enlarged head. This contraction or compressive actuation of the jaws prevents separation of the coupler from the nipple during the lubrication operation, *i. e.*, the injection of grease into the bearing to which the bore of the nipple is connected. The operation of this gripping mechanism is entirely automatic. It requires no manipulation. It results automatically from the normal actuation of the compressor as in the act of delivering grease into the coupler shell and thence through the nipple into the interstices of the bearing to be lubricated. As described in claim 2 of the Butler patent in suit, the jaws or movable locking elements are

“actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts.”

The orange-colored end-seal 51 is pressed against the head of the nipple by the pressure of the lubricant behind or to the left of this orange-colored end-seal. It will be noted that the end sealing member in this instance extends through the aperture 48 in the purple piston 45 and provides a central passage through which the lubricant can flow from the coupler into the blue nipple 35. The purple piston is located between the nut 47 and an opposing shoulder provided by the orange-colored seal, the nut and shoulder

being so spaced as to provide limited movement between the purple piston and the sealing member. (R. pp. 57-59, 253.)

The purple piston, red jaws, and the conically constricted end of the green coupling shell constitute an automatic gripping means actuated by the lubricant pressure for mechanically gripping the coupler to the blue nipple 35. The orange-colored sealing member 51 constitutes an apertured seat which is automatically pressed against the end of the blue nipple by the lubricant pressure. Because of the relative movement permitted between the sealing member 51 and the purple piston, the sealing member has a limited amount of movement independent of the movement of the gripping mechanism. (R. pp. 57-59, 253.)

When, after the injection of grease has been completed and it is desired to separate the coupler from the one nipple in preparation for its application to another nipple of the same kind, the grease pressure is relieved, whereupon a slight tilt of the coupler to one side or the other will cause the shoulder of the nipple at one side to disengage itself from the adjacent jaw. The grip between the nipple and the jaws of the coupler having in this way been relaxed, a slight tug or pull will effect the complete disengagement of the nipple from the coupler. The various parts of coupler mechanism are thereby restored to their initial positions,—ready for engagement by another nipple in the manner previously described. (R. pp. 57-59, 151.)

When the coupler is to be connected with the next nipple associated with another bearing, a light push on the compressor or coupler will cause the head of the nipple to wedge the jaws outwardly and backwardly in such a way as to cock and reset the piston mechanism for its gripping and sealing functions in the manner previously described.

The Courts' Fifteenth Finding of Fact Was That:

"Plaintiff commenced selling the Alemite Hydraulic lubricating equipment exemplified in Plaintiff's Exhibit 13 to 20 and 22 to 25, inclusive, in April, 1933." (R. pp. 39-42-64.)

This Alemite Hydraulic lubricating equipment was manufactured and sold under the Butler patent in suit, and is marked with the number of the Butler patent, as appears from an examination of Plaintiff's Exhibit 13. Its construction and mode of operation are fully described by the plaintiff's witness Lynn A. Williams, Jr. at R. pp. 57-60.

The Courts' Sixteenth Finding of Fact Was That:

"Plaintiff sold 281,555,000 of the Alemite Hydraulic fitting parts of the combination during the period from April, 1933, to March, 1936, and during this same period sold 6,306,000 of the Alemite Hydraulic coupler parts thereof." (R. p. 40.)

When the Butler apparatus is being used to inject grease into a bearing, it is a complete combination of elements co-operating and coacting with one another to accomplish a unitary result. During the moment of such use, it has the characteristic of all patentable machines,—that all of the elements of the combination cooperate and coact with one another in the accomplishment of a unitary result. In this instance, the unitary result is the injection of grease under extremely high pressure into the interstices of the bearing.

One of the greatest and most practical advantages of the Butler invention is that each of the bearings of an automobile or other machine can be permanently equipped with one of the nipples. These headed nipples are so small and so simple that they can be manufactured and sold at a price of a cent or two each. The compressor and coupler parts are more expensive. One compressor and coupler can be combined for use with any one of the 30 nipples on a

given automobile,—or indeed with any one of 30,000,000 nipples permanently attached to the bearings of 1,000,000 automobiles.

A farmer can buy an automobile having 30 nipples permanently attached to its 30 chassis bearings. He can take the one compressor and coupler out of the tool kit and combine it in succession with each of these 30 nipples. If he likes the ease and effectiveness with which he can lubricate the bearings of his automobile, he may decide to increase the repertory of his own compressor and coupler by buying 100 more nipples and screwing them into the holes leading to the bearings of his reaper, his tractor, and his windmill. He can then combine his one compressor and coupler with any one of the 130 headed nipples in order to effect the lubrication of any one of 130 bearings.

This interchangeability of the parts which make up the complete combination of the Butler invention is an unusual characteristic,—a characteristic which is not present in most machines. It is because of this characteristic that purchasers invariably wish to buy such parts and such assortments of parts as will best serve their particular needs. It is this unusual characteristic which makes it necessary for the patentee or his assignee to separately price and sell the component parts of the complete combination.

As we have seen, the Butler patent describes and claims a combination of seven elements. Some of these elements inhere in the headed nipple part, some in the coupler part, and some in the compressor part. The nipple parts are adapted and intended to be screwed or otherwise more or less permanently attached to each of the bearings of an automobile or other machine (R. p. 39-40.) The compressor is intended to be filled with grease and then to be coupled in succession to each of the several nipples in or-

der to inject grease into the interstices of the several bearings. In a lubricating system of this kind it is a necessary characteristic that the complete combination of nipple part, compressor parts, and coupler parts be brought together only periodically and temporarily and then, too, only in the hands of the ultimate user. (R. p. 41.)

The manufacturer cannot sell the completed combination as such. No one wants to buy the completed combination, as such. What the ultimate user of the lubricating equipment of the Butler patent desires is to buy from the manufacturer such a number and such an assortment of nipples as may be required for permanent association with the several bearings of his automobile or other machinery. He wishes then to have the use of a single compressor and coupler with which he may connect occasionally each of his many nipples. Some makes of automobile have twenty chassis bearings with which these nipples are more or less permanently associated. Others may have as many as thirty-six. One man may own a single automobile. Some one else may own two or ten. (R. pp. 13, 395-401.)

Some automobile owners wish to grease their own cars. Others wish to have this greasing done at more or less public service stations and garages (R. pp. 47, 145).

Some bearings can be most conveniently greased when equipped with a "straight" nipple, others with a "90 degree elbow" nipple, still others with nipples extending at angles of 45 degrees, $22\frac{1}{2}$ degrees, $67\frac{1}{2}$ degrees, etc. Some of the nipples had best be long, others short. Some must have single check valves. Others must have double check valves. Some must be screwed into holes tapped with one-eighth inch pipe threads, others with holes having one-fourth inch pipe threads, and still others with holes having machine screw threads (R. pp. 40, 132, 395-401).

What the purchaser desires to buy, and what the manu-

facturer necessarily makes, is, therefore, an assortment of nipples of various angles, lengths, and thread sizes. What the purchaser desires to buy, and what the manufacturer sells, is, therefore, a variety of compressors, some large and power driven for use in a public garage, others small and hand operated for use in Johnny Q. Public's back yard. The sale of this kind of lubricating equipment requires, therefore, that the manufacturer separately list and price each of the various kinds of nipples and that he separately list and price each of the various sizes of compressor which may be coupled to and used in conjunction with the nipples. This leaves the purchaser free to buy the particular assortment of nipples best adapted to the lubrication of his own particular automobile or other machine. It leaves him free to buy a compressor of small capacity or a compressor of large capacity,—as may be best adapted to his particular needs. He may buy a power driven compressor, if he has much greasing to do; or he may buy a hand operated compressor, if he has only occasional and limited use for that part of the complete combination (R. pp. 40, 132, 395-401).

An automobile owner who invariably has his car greased at a public service station or garage has no use whatsoever for the compressor and coupler parts of the combination. On the other hand, a garageman who spends his life in greasing other people's automobiles has no need to buy the nipple parts of the combination for his own use (R. pp. 136-137).

Speaking by and large, it is only at the moment of greasing a bearing that the complete combination is ever brought together. This may be at the hands of the ultimate user or it may be at the hands of the garageman (R. pp. 136-137).

The combination of the Butler patent as manufactured

and sold by the plaintiff provides a system whereby every automobile and truck may in the course of its manufacture have every chassis bearing equipped (as prior to the contributorily infringing acts of the defendant it was equipped) at its factory with one of the Alemite Hydraulic nipples (R. p. 129). The tool kits of the less expensive cars are generally provided at their factories with the Alemite Hydraulic compressor and coupler parts of the combination (R. p. 40). In the case of high priced cars, where presumably the greasing will be done at a public garage, it is the custom not to provide the tool kit with an Alemite Hydraulic compressor and coupler unless the purchaser of the car specially requests it (R. pp. 40, 136-137). The owner of every public greasing station provides himself with an Alemite Hydraulic compressor and coupler, furnished either by the plaintiff or one of its several licensees, so that the garageman will be in a position to grease any car which may drive in to his station (R. pp. 41-42).

If, as is the case, the dimensions of all of the several parts of the complete combination are standardized and maintained, then there will be complete universality of interchange and co-operability as between all of the nipple parts, all of the coupler parts, and all of the compressor parts of the complete combination. This universality of interchange and cooperability is one of the very practical merits of the Alemite Hydraulic System of chassis lubrication (Pl. Ex. 21).

The Courts' Seventeenth Finding of Fact Was That:

"Of the 6,306,000 Alemite Hydraulic coupler parts sold during the period from April, 1933, to March, 1936, approximately 4,485,000 were sold with their associated compressors to automobile manufacturers, to be put in the tool kits of the cars at the factory." (R. p. 48.)

The Courts' Eighteenth Finding of Fact Was That:

"The Alemite Hydraulic lubricating equipment embodying the invention of the patent in suit rapidly superseded the Gullborg and the Zerk lubricating equipment because

(a) Under this equipment, it was not necessary to manipulate any coupler mechanism in the operation of attaching and detaching the coupler to and from the fitting,—as was necessary in effecting a connection between a Gullborg coupler and fitting, and

(b) It was not necessary for the user to apply force to hold the coupler against the fitting to prevent separation of these parts,—as was required in effecting a connection between the coupling nozzle and fitting of the Zerk lubricating system.

Within eight months after its introduction on the market, the plaintiff's Alemite Hydraulic system had been adopted as the factory lubricating equipment of every automobile and truck made in the United States, with the single exception of the Duesenberg." (R. pp. 45-48, 50-51, 64, 128-129.)

The Courts' Nineteenth Finding of Fact Was That:

"The mechanism embodied in the means by which the jaws are compressed about the nipple of the Alemite Hydraulic system, is identical in its mechanical principles with that disclosed in the Butler patent. It is a simple equivalent involving a mere reversal of parts." (R. pp. 57-60.)

As shown in Figure 2 of the Butler patent, the segmental jaws are squeezed between a stationary surface perpendicular to the axis, and a moving inclined surface which is associated with the piston. The result is that upon the application of grease pressure the jaws are forced inwardly to grip the nipple. (R. pp. 51-59.)

In the Alemite Hydraulic embodiment of the Butler invention the perpendicular surface is associated with the piston, and the inclined surface is associated with the shell.

Despite this reversal, the pressure of the grease causes the jaws to be squeezed between the perpendicular surface and the inclined surface in such a way as to force them inwardly to grip the nipple. (R. p. 57.)

This distinction-without-a-difference was made the subject-matter of much controversy in the District Court (R. pp. 105-107, 254.) We find no allusion to the matter, however, in the petitioner's brief, and shall not, therefore, elaborate relative to the proofs in support of (or in opposition to) the proposition that the two reverse arrangements are such exact mechanical equivalents of one another that the language of claim 2 does not even distinguish between them.

The petitioner's brief does not refer to any of the evidence in this case upon which it is urged that the plaintiff's Alemite Hydraulic equipment does not embody the invention of claim 2 of the Butler patent. It confines itself to the erroneous assertion that the 8th Circuit Court of Appeals "held" and "adjudicated" that the Alemite Hydraulic equipment does not embody the invention claimed in the Butler patent. The Alemite Hydraulic equipment came into the Jiffy case only for the purpose of showing that the invention of the Butler patent had had great commercial success at the hands of the plaintiff. The matter was not in issue. It was only a matter of evidentiary persuasion.

What the 8th Circuit Court of Appeals said in the Jiffy case was that the plaintiff's Alemite Hydraulic couplers do not correspond "to the drawing and specification of its Butler patent" and that "the plaintiff had not manufactured for sale any couplers according to the drawings or specifications on which the claim in suit reads."

What these statements mean is that the plaintiff's couplers were not manufactured according to the drawings or

specifications relating particularly to Figure 2. The phrase "on which the claim in suit reads" is intended to identify the drawings and specifications. Thus the 8th C. C. A. might have said, "The plaintiff has not manufactured for sale any couplers according to the drawings or specifications of Figure 2 and the description concerning it." It is upon this drawing and description which the claim in suit (claim 1) reads. The 8th C. C. A. did not express even a dictum as to whether or not the plaintiff's Alemite Hydraulic equipment comes within the scope of Butler's claims or either of them.

On the other hand, the 8th Circuit Court of Appeals did say that it regarded the reversal of the location of the inclined and perpendicular surfaces as involving merely "a clear mechanical equivalent".

The Jiffy Company's coupler had the inclined surface incorporated in the shell as in the plaintiff's Alemite Hydraulic. It had the perpendicular surface incorporated in the piston member as in the plaintiff's Alemite Hydraulic. The coupler, made up by the plaintiff in the Jiffy case to demonstrate the Butler patent, had the perpendicular surface associated with the shell and the inclined surface associated with the piston member precisely as shown in the drawings of the Butler patent. It was relative to this matter of mere reversal that the 8th Circuit Court of Appeals said in its opinion (citation at page 793):

"We consider the Jiffy coupler a clear mechanical equivalent of the coupler which has been made by the plaintiff to demonstrate the Butler patent."

(To be sure, the 8th C. C. A. went on to say, "We find latter to be a departure and different from the real disclosure of that patent.") The difference was that in our embodiment of the Butler patent the "spring fingers" took the form of a slotted cylinder having a strength sufficient to grip the jaws 40 to the throat of the nipple. The 8th C.

C. A. formulated the view that Butler's "spring fingers" must be so flimsy as not to effect any gripping of the throat of the nipple.

As we have seen, however, both the plaintiff and the defendant in the instant case agree that the disclosure of the Butler patent is of a tubular or cylindrical member 42, which may be slotted as in the sample which the plaintiff made up for submission to the Court in the Jiffy case and as in the samples submitted to the District Court in the present suit. (Pl. Ex. 63, Deft. Ex. A-61.)

The Courts' Thirty-first Finding of Fact Was That:

"There is nothing in the Butler patent which requires the use of spring fingers which can yield a substantial amount." (R. p. 240.)

This was Judge Lindley's answer to the defendant's contentions as advanced upon the basis of the decision of the 8th C. C. A. in the Jiffy case, 81 F. (2d) 786.

It is based upon the disclosure within the four corners of the Butler patent. (R. p. 464.)

The record contains much testimony upon the subject. At the outset of the defendant's case in the District Court, Mr. Fox, the Vice President of the Lincoln Engineering Company, made an elaborate presentation of a certain sample. (Defendant's Exhibit A-61.) Mr. Fox endeavored to show that if the spring fingered cylinder 42 were quite stiff or rigid then it would be impossible to withdraw the coupler from the nipple. (R. pp. 103-104.) He endeavored to show, on the other hand, that if the walls of the small cylinder 42 were made sufficiently thin, and if the slits were carried far enough toward the base of the piston 43, then the flimsy fingers could be sprung outwardly a distance sufficient to permit the withdrawal of the coupler from the nipple. (R. pp. 101-103.) The attempted point of all

This was that in order to be operative at all the Butler coupler must have exceedingly thin, weak and flimsy "spring fingers". He compared this "necessary" flimsiness with the relative strength of the spring finger or jaw mechanism of the plaintiff's Alemite Hydraulic coupler in an effort to show that the relatively strong Alemite Hydraulic coupler did not embody the invention of the relatively weak Butler coupler. (R. pp. 105-107.)

All of Mr. Fox's testimony and all of Mr. Fox's demonstrations were turned into a pitiable fiasco when upon rebuttal Lynn A. Williams, Jr. discovered and demonstrated that Mr. Fox's demonstration apparatus had been falsified by making the cylinder shell so short that the piston mechanism could have no longitudinal movement whatsoever,—regardless whether the flexible "spring fingers" be made relatively stiff or relatively flimsy. (R. pp. 235-238.)

The Courts' Twenty-second Finding of Fact Was That:

"When, shortly after January 1, 1933, Lincoln Engineering Company began selling automobile lubricating apparatus to others than Alemite, the sales of such apparatus, equipped with couplers or nozzles of its own manufacture, were made with the knowledge and expectation that the purchasers would use the apparatus in combination and conjunction with Alemite fittings."

The Courts' Twenty-third Finding of Fact Was That:

"In May, 1933, Mr. A. P. Fox, the vice-president and designing engineer of Lincoln Engineering Company of Missouri, became familiar with the nipple parts of the Alemite Hydraulic system. Although he had known of the compressor and coupler parts at any earlier date, he became familiar with them at least as early as January, 1935."

The Courts' Twenty-fourth Finding of Fact Was That:

"The Lincoln Company's Kleenseal nipples were thereafter sold with the knowledge that they could be substituted for the plaintiff's nipple part of the Alemite Hydraulic combination, and that they would be so combined in use. Claim 2 applies to the combination in the same way, regardless whether it incorporates the Lincoln Company's Kleenseal nipple part or the plaintiff's nipple part."

The Courts' Twenty-fifth Finding of Fact Was That:

"The dimensions of the Lincoln Kleenseal fitting are exactly such as to make it cooperate satisfactorily with an Alemite Hydraulic coupler. If the dimensions selected had been slightly different, such cooperation would have been impossible. Similar fittings of slightly different dimensions would have had all other utilities which have been ascribed to the Lincoln Company's fittings, and would have cost no more to make."

The Courts' Twenty-seventh Finding of Fact Was That:

"Defendants sold Lincoln Kleenseal fittings with the knowledge that they were to be used in combination with the compressor and coupler parts of the Butler combination as sold by the plaintiff for use with plaintiff's Alemite Hydraulic coupler equipped grease guns."

The Courts' Twenty-eighth Finding of Fact Was That:

"The Lincoln Engineering Company of Missouri expected that automobiles equipped with the Lincoln nipple part of the combination and sold in the United States, would be lubricated at garages and service stations. The plaintiff had previously sold millions of the compressors and coupler parts of the combination, and had endeavored to supply every public garage and service station in the United States."

The Courts' Twenty-ninth Finding of Fact Was That:

"The Lincoln Engineering Company of Missouri in its Kleenseal fittings, duplicated, fitting for fitting, all of the arbitrary dimensions of the entire line of Alemite Hydraulic fittings."

The Courts' Thirtieth Finding of Fact Was That:

"The Lincoln Engineering Company did not sell any of its grease guns or nozzles to automobile manufacturers for tool kit equipment of automobiles sold in the United States, even though the automobiles were equipped with Lincoln Kleenseal fittings."

The Courts' Thirty-third Finding of Fact Was That:

"The Alemite Hydraulic coupler will grip and form a sealed connection with a Lincoln Kleenseal fitting as well as with an Alemite Hydraulic fitting and claim 2 of the Butler patent describes one combination as well as the other."

We have grouped together the foregoing findings because they relate to matters which constituted the principle defense in the District Court, but which are not made the subject of any defense or contention in this Court.

Taken together, these several findings mean simply that the Lincoln Company has endeavored to oust the Stewart-Warner Corporation from the sale of the nipple parts of the plaintiff's Alemite Hydraulic system. Briefly; the Lincoln Company has been selling the nipple parts of the complete combination of the Butler patent, with the knowledge and intent that the purchasers would combine them in use with the other parts of the combination as sold by the plaintiff.

Prior to the commencement of the Lincoln Company's manufacture and sale of its so-called "Kleenseal" nipples for intended and expected use in conjunction with the other parts of the Butler combination, the Lincoln Company had

worked up an elaborate pretense. It sought to put itself in a position where under this pretense it could assert that the Lincoln "Kleenseal" fittings were really designed and sold with the intention and expectation that the purchasers would use them in conjunction with certain compressors and nozzles furnished or to be furnished by the Lincoln Company itself, and in such ways as would not involve either direct or contributory infringement of the Butler patent.

This pretense was made the subject-matter of much testimony on the part of the defendant (R. pp. 87-89, 93-96, 127-128, 223-224). It was made the subject of much rebuttal testimony on the part of the plaintiff in showing that the exact form, size, shape, and configuration of the Lincoln Company's "Kleenseal" nipples was not necessary or appropriate to any of the innocent uses for which the Lincoln Company claimed to have made and sold them, but only for the contributory infringing use which the purchasers were shown to have made of them (R. pp. 60-61, 259-272).

A large part of the record was devoted to a showing that the Lincoln Company had developed straight-sided nipples with no groove or head or shoulder, and that these straight-sided nipples could be used just as effectively with the compressors and nozzles manufactured and sold by the Lincoln Company itself as could the grooved, shouldered, and headed nipples with which they were succeeded. There was much evidence showing the Lincoln Company's efforts to sell these straight-sided and non-infringing nipples to the General Motors Corporation and to others (R. pp. 124-127, 137-139, 143-144).

Much testimony was adduced to show that it was only when the Lincoln Company changed its nipples in such a way as to incorporate the characteristic features of the Butler nipple as found in the plaintiff's Alemite Hydraulic

system, that it became possible to make sales to the General Motors Corporation and its subsidiaries, Oldsmobile, Buick, Pontiac, Cadillac, etc. (R. pp. 127, 131-135, 137-139, 143-144, 147).

Much evidence was adduced to show that the inevitable result of these sales would be the use of the Lincoln Company's "Kleenseal" fittings in substitution for the plaintiff's Alemite Hydraulic fittings as parts of the complete combination of the Butler patent (R. pp. 42-44, 131-132, 135).

Much of the evidence had to do with the knowledge of the Lincoln Company's engineering staff relative to the construction and mode of operation of the plaintiff's Alemite Hydraulic equipment into which the Lincoln Company's "Kleenseal" nipples were intended to go. Much of it had to do with the exact date of this knowledge, or with bringing home such knowledge and intent as of a date prior to the filing of the supplemental bill of complaint herein (R. pp. 115, 120, 127-135).

Some of the evidence had to do with sales of the Lincoln "Kleenseal" nipples by the Lincoln Company's Chicago distributing agency, under circumstances which were conclusive as to the purpose and intent for which the Lincoln nipples were sold (R. pp. 43-44).

Your Honors will observe that a very considerable part of Judge Lindley's first opinion of July 15, 1936, is directed to a consideration of this evidence which led inevitably to the conclusion that the Lincoln Company's nipples were sold with the knowledge and intent that purchasers would combine them in use with the other parts of the plaintiff's Alemite Hydraulic equipment, manufactured and sold under claim 2 of the Butler patent in suit.

We do not elaborate our statement of facts in regard to these matters. This is for the reason that the petitioner

has completely abandoned this, its major line of defense in the District Court.

We have failed to find throughout the whole of the petitioner's brief, the slightest contention or suggestion that the Lincoln Company's "Kleenseal" nipples were not from the beginning and at all times thereafter, sold with the definite knowledge, intent, and expectation that the purchasers would combine them in use with the compressor and coupler parts of the Butler combination as manufactured and sold by the plaintiff.

The petitioner's present contention is that it had the right to do the very thing which the District Court found that it had been doing, but which in the District Court the petitioner denied that it had ever done at all.

In so far as any question of infringement is now concerned in this Court, the defendant's only contention is that the plaintiff's own Alemite Hydraulic equipment does not embody the invention of the Butler patent, and that therefore anybody and everybody is free to make and sell any and every part of it, including, of course, the nipple parts made and sold by the defendant. This contention is not based upon anything which can be found or which the defendant even alludes to as capable of being found in the record in the present suit. It is based solely upon the dictum-like view of the Eighth Circuit Court of Appeals in the Jiffy case, that the plaintiff's Alemite Hydraulic equipment is not made in the exact form shown and described in the drawings and specifications of the Butler patent.

It is for these reasons and under these circumstances that we do not elaborate our statement relative to the acts and guilty intent of the defendant in and about its sales of the Lincoln "Kleenseal" nipples or fittings.

Just inside the back cover of our brief, we have included

a chart comprising colored drawings of the structure of Figure 2 of the Butler patent, and of the Alemite Hydraulic equipment manufactured and sold by the plaintiff (Plaintiff's Exhibit 34), and of the defendant's "Kleenseal" nipple 35 when combined in use with the compressor and coupler parts sold by the plaintiff. The last of these drawings is a reproduction of Plaintiff's Exhibit 36. (R. p. 313.)

It was repeatedly demonstrated during the course of the trial that the cooperation of all of the parts and the functions of all of the parts of the complete combinations were identically the same, regardless whether the plaintiff's Alemite Hydraulic nipple or the defendant's Lincoln "Kleen-seal" nipple be associated with the Alemite Hydraulic compressor and coupler. (R. pp. 61-62.)

It is perfectly evident that if claim 2 of the Butler patent describes the Alemite Hydraulic equipment of Plaintiff's Exhibit 34, it describes also the defendant's nipple when combined in use with the plaintiff's compressor and coupler.

Claim 2 of the Butler patent reads in precisely the same way on the combination of the Lincoln "Kleen-seal" fittings (Plaintiff's Exhibit 27-A and 27-B) with the Alemite Hydraulic compressor and coupler (Plaintiff's Exhibit 28) which the witness Cornell had with him at the time he purchased these Lincoln fittings (R. p. 62), as it does on the combination of the Alemite Hydraulic fittings (Plaintiff's Exhibit 14) with the same Alemite Hydraulic compressor and coupler.

The Courts' Thirty-fourth Finding of Fact Was That:

"Defendants' model of Fig. 2 of the Butler patent does not accurately or fairly represent the invention of Butler."

The Courts' Thirty-fifth Finding of Fact Was That:

"Defendants' Exhibit A-61 does not correspond to the alleged drawing thereof, Defendants' Exhibit C-21."

These findings have to do with a matter to which we have previously referred, namely, the defendant's falsification in its Exhibit A-61 of the disclosure of the Butler patent. This falsification involved making the cylinder of the defendant's A-61 coupler so short that there was no room for the piston member to have any reciprocating movement whatsoever. The whole matter is covered in the testimony of the plaintiff's witness, Lynn Williams, Jr., at R. pp. 235-245.

In connection with its alleged sample A-61, the defendant presented a drawing, Defendant's Exhibit C-21. The representation was that the sample faithfully followed the details shown in the drawing. (R. pp. 104-105.) The drawing fairly represented two different embodiments of the Butler construction. The plaintiff discovered, however, that the defendant's physical sample did not correspond with the defendant's drawing as had been claimed by it, and it discovered also that it was solely because of this discrepancy that the physical sample did not operate in accordance with Butler's patent specifications.

The Courts' Thirty-sixth Finding of Fact Was That:

"Defendants' expert stated that none of the prior art except Winkley Reissue patent No. 14,667 accomplishes the results obtained by the Butler patent."

The part of the record to which this finding refers comprises certain of the testimony of Alexander P. Fox. Mr. Fox's testimony relative to this matter is as follows:

"Generally speaking, of all these prior art patents to which I have referred, the only ones which refer in any way to the art of lubrication are those to Richard-

son and Dupre and Seng and Wurster. All the patents to Richardson, Dupre, Wurster, and Seng, show headed fittings. The Wurster patent 356, 519 shows a compressor having a coupling member. I can't make up my mind which is the nearest or closest.

Q. Can you name any one patent or other publication or any patent application filed prior to the filing of the application for the Butler patent in suit on February 19, 1923, which in and of itself discloses lubricant equipment comprising in any form whatsoever, nipples permanently attached to the bearings, and a compressor having a coupler adapted for attachment to any of the nipples, in which the coupler has any kind of means whatsoever for compressively clutching or mechanically gripping the coupler to the nipple and any kind of means whatsoever for sealing the joint between the coupler and the end of the nipple against leaking, both of which means are automatically operated by the pressure of the lubricant in such a way that the intensity of the mechanical grip and the tightness of the end seal are increased as the pressure of the lubricant is increased?

A. I will look through my patent references here. I would say the first one I come on to here, which is F. D. Winkley re-issue 14,667 is for a lubricating system in which there is a compressor, a coupling member, and a headed nipple. I find this Winkley patent shows what is accomplished by the Butler patent." (R. pp. 220-221.)

The Courts' Thirty-seventh Finding of Fact Was That:

"The Winkley Reissue patent No. 14,667 does not disclose the radially movable locking elements, the piston, or the means actuated by the piston for compressively clutching the locking elements upon the nipple, as Butler's invention is defined in claim 2 of his patent. The Winkley patent discloses a coupler having a spring pressed sealing member. It is not in any way analogous to the combination of elements defined in Butler's claim 2."

The Winkley patent (owned by the plaintiff throughout its entire life) appears at page 526 of the Record. A brief examination of its drawings and specifications will show

how utterly remote it is from the subject-matter of the Butler patent in suit. In the Winkley patent the end of the compressor conduit is attached to the head of the shackle bolt solely by a manual hooking of the forked claws 36 (Figs. 4 and 5) over the head 29 of the shackle bolt. The only seal between the flexible conduit and the shackle bolt hole leading into the bearing is the cup-shaped member 37. This "oil cup" is pressed in the direction of the joint by a spring 46. As Winkley puts it in his specification,

"The oil cup 37 is yieldingly mounted in the nozzle proper, and is held downwardly therein with its bottom projecting beyond the plane of the nozzle proper by a relatively stiff expansion spring 46 interposed between the cap 43 of the cup and a cap 47 threaded into the top of the nozzle body." (page 2, line 60, R. p. 530.)

In the Winkley device the pressure of the grease has no part whatsoever in attaching or gripping the nozzle to the head of the shackle bolt. Furthermore, the pressure of the grease does not tend in the slightest degree to seal the joint between the nozzle and the head of the shackle bolt. On the contrary, the pressure of the grease tends to disrupt the union between the "oil cup" of the nozzle and the head of the shackle bolt. As soon as this pressure rises to a point sufficient to overcome the pressure of the spring 46, the oil cup 37 will be burst away from the head of the shackle bolt, and grease will be extruded into the atmosphere at the would-be joint between the oil cup and the shackle bolt.

It was for these and similar reasons that Judge Lindley found that the disclosure of the Winkley patent

"is not in any way analogous to the combination of elements defined in Butler's claim 2."

Despite the fact that the defendant's Vice-President and

Chief Engineer and expert witness, Fox, selected the Winkley patent at the closest approach in all of the prior art to the invention of the Butler patent, the petitioner does not in its brief in this Court make the slightest mention of this Winkley patent, except to list it with many other patents as showing a "headed" piece of metal for the reception of lubricant or for some other purpose. (Appellant's brief, pp. 14 and 50.)

The Courts' Thirty-eighth Finding of Fact Was That:

"The particular shape of the oil cup shown in the Richardson patent No. 8,251 has no significance of functional utility."

The Richardson patent (R. p. 472) was issued in 1851. It shows a tube with a spring-pressed check valve at the outer end, this valve "serving to close the mouth of the cup and exclude dirt, but yielding to the slightest pressure of the spout of an oil can or feeder, and allowing the oil or other lubricating material to be introduced; closing itself when the pressure is removed, and forming, in fact, a self-acting stopple." (p. 1, l. 21,—R. p. 473.)

The outside of this tubular member was given a somewhat ornamental configuration, including a little flange. The defendant seized upon this ornamental flange and then proceeded at great length (R. pp. 89-93, and Defendant's Exhibits A-45, C-18, and A-46) to convert Richardson's mechanically useless ornamentation into the functionally useful head, shoulder, and throat of Butler's nipple. The irrelevancy of the Richardson oil cup sufficiently appears from the fact that the oil was gotten into it from the spout of an old fashioned oil can poked into the hole at the top of the oil cup in such a way as to dislodge the dirt-excluding valve. (Such valve-closed oil holes became a matter of common knowledge in connection with sewing machines and bicycles.)

The Courts' Thirty-ninth Finding of Fact Was That:

"The patents to Paul No. 621,276, Ulleland No. 1,253,309, and Pinel French No. 327,557, each discloses a construction readily distinguishable from that claimed by Butler in that in each of these prior art patents the locking elements are not actuated by any piston nor automatically by the pressure of the grease."

The Paul patent shows a garden hose coupling (R. p. 480). The Ulleland patent shows another garden hose coupling at R. p. 516. The Pinel patent shows a garden hose coupling at R. p. 597. The petitioner's brief in this Court makes no reference to these patents except to list them, with many others, on a chart following page 16, showing what petitioner's counsel choose to designate as "headed 'nipples'." None of these patents had any relation to lubrication of any kind. None of them suggested a lubricant compressor or any such coupler as that of Butler for participating in the connection of anything whatsoever.

The Courts' Fortieth Finding of Fact Was That:

"The patent to Newton No. 1,118,876 discloses a train hose testing appliance which was never intended to be used for high pressure lubrication and could not be used for such purpose without making a great many alterations of an inventive character in its construction. It does not embody the combination of claim 2 of the Butler patent."

The Courts' Forty-first Finding of Fact Was That:

"Defendants' representation, Exhibit A-68, differs in many material respects from the disclosure of the Newton patent No. 1,118,876, but even with all of the changes which have not been incorporated in it, in an endeavor to make it work, it is not a commercially feasible or practically operative device for high pressure lubrication."

The "Defendants' representation, Exhibit A-68," embodied the defendants' attempt to reconstruct the railroad brake hose testing device of Newton patent No. 1,118,876 in such a way as to convert it into a high pressure automobile chassis lubricator.

Contrary to the main reliance in the District Court of the defendant's vice-president and chief engineer, Mr. Fox, upon the Winkley Reissue patent (R. pp. 221, 226), counsel for the petitioner now in this Court practically confine their attention to this Newton patent as invalidating the Butler patent on the score of anticipation (pages 28 to 30), or at least upon the contention that "no invention was involved." (page 32). Counsel for the petitioner conclude their nine-page discussion of the Newton patent by reference to certain distinctions between the mechanism of Butler's coupler and the mechanism of Newton's air brake hose testing device and say in this connection that

"Such distinction is without patentable significance because it, at best, merely spells the substitution of Gullborg's (R. pp. 534-9) or Seng's (R. pp. 542-4) conventional axially-sealing 'cup washer' in place of Newton's radially sealing tubular washer."

The "no invention" argument of counsel for the petitioner would carry far more weight if the defendant's vice-president and chief engineer had not attempted with brass and iron to show that Newton's air brake hose testing appliance could, by various changes, be converted into a high pressure lubricating system; because, despite all of Mr. Fox's many modifications and changes, the demonstration served only to convince Judge Lindley that the resulting device was "not a commercially feasible or practically operative device for high pressure lubrication."

The defendant's modified revamp of Newton's air brake hose testing appliance was offered in evidence as Defendant's Exhibit A-68. The brief of counsel for the petitioner

is careful to conceal the fact that there was any such attempt to construct a lubricating device upon the basis of Newton's disclosure or by the defendant's proposed modifications of it. Counsel are careful to conceal the fact that the attempt was offered in evidence and now constitutes an exhibit in the case. They do not even cite or refer to any of the many words of testimony relative to this matter. As a matter of fact, however, the impossibility of utilizing the Newton construction for high pressure lubrication was fully discussed by the plaintiff's expert at R. pp. 274-293.

The many, many differences between the disclosure of the Newton patent and the defendant's modified revamp, Exhibit A-68, are discussed by Lynn Williams, Jr., at R. pp. 278-279, 283-290. The demonstrations of the impracticability and non-feasibility even of this modified revamp for the purposes of high pressure lubrication, are fully discussed in the Record at pp. 278-279 and 289-290.

The many respects in which the Newton railway brake hose testing appliance fails to incorporate and embody the several elements of claim 2 of the Butler patent, are discussed at R. pp. 292 and 293.

One of the important respects in which the combination of the Butler patent differs from the air brake hose testing device of the Newton patent, is that upon the initial engagement of Butler's headed nipple by his coupling mechanism, the head of the nipple cooperates in such a way as to cock or reset the piston of the gripping mechanism so that it can subsequently be driven forward under the pressure of the grease, to grip the throat of the nipple between the jaws of the coupler.

In the Newton mechanism the metal terminal of the air brake hose (which counsel for the petitioner wish to regard as the "headed nipple" of the Newton device) does not and cannot perform the function of cocking or reset-

ting the piston mechanism. In the Newton device the return of the piston to its left-hand position as shown in Figure 1 of Newton's drawings (R. p. 502), is accomplished by manually turning the valve 3 into the position which it occupies in this Figure 1, thereby admitting compressed air into the space 17 to the right of the piston 16. It is this retraction of the piston and its associated mechanism under the power of the valve-controlled compressed air, which alone does or can return the piston mechanism from the position shown in Figure 2 to the position shown in Figure 1, in order to put the mechanism in condition to apply a fresh charge of compressed air to the piece of air brake hose which is to be tested.

Upon the trial, the plaintiff's expert found it impossible, with a sample of Newton's testing device, to insert the terminal of the air brake hose into the yielding packing tube 5 until he had manipulated the valve 3 in such a way as to retract the piston mechanism under the power of the compressed air supply. The whole matter is discussed at Record pages 274 to 285.

The resetting of the hose gripping mechanism of the Butler patent by a steam engine action of the piston mechanism under the power of the compressed air, is described as follows at page 2, line 47, of the Newton patent, where it is said:

"After the test has been made, and it is desired to disconnect the appliance from the hose so that it may be readily applied to another similar hose to be tested, the controlling cock 3 is again moved to the position shown in Fig. 1, which permits air to exhaust from the chamber 17 at the left of the piston 16 and causes air to enter through the port 20 at the right of the piston 16 which is thus moved from right to left back to the position shown in Fig. 1. This releases the clamping fingers 9, leaving them free to expand, and while the fluid from the clamping tube 5 and the hose may flow back through the passage 18 and thence escape to the

air, the said passage 18 is so small that it does not immediately make a large reduction in the pressure in the hose, the reaction of which thus serves to eject forcibly the coupling member 4 from the packing tube 5 as soon as the pressure of the spring fingers 9 thereon is relieved by the disengagement of the cam surfaces 10 and 11."

In the Butler combination, all of the resetting or cocking of the piston and its associated gripping mechanism is accomplished automatically by the head of the nipple as it wedges its way into the space between the jaws upon the disengagement of the coupler from one nipple preparatory to its connection with another nipple, or, if need be, upon the initial engagement of the coupler with any one of the many headed nipples with which it is to be combined in use.

The manner in which the headed nipple of the Butler combination effects the cocking or presetting of the piston mechanism upon the initial contact between the two parts of the connector mechanism, is extremely valuable in a high pressure lubricating apparatus. It makes possible the "one hand" operation of the lubricating mechanism in relatively concealed and inaccessible parts of an automobile (R. pp. 46 and 50). The steam engine reciprocation of the piston mechanism of the Newton device under the control of a manually operated air valve which must be located at or close to the point of junction, would make the Newton construction and method almost impossible of use in an automobile lubricating apparatus. (R. p. 286.)

One of the Newton brake hose testing appliances was purchased from Newton's assignee, the New York Air Brake Company, and offered in evidence as Plaintiff's Exhibit 79. Samples of air brake hose and their coupling terminals were offered in evidence as Plaintiff's Exhibits 59, 60, and 80. Even a casual examination of these exhibits makes it obvious that the large, complicated, and

extremely heavy apparatus of this Newton patent is utterly unsuited for any lubrication purpose. The air pressure utilized in testing air brake hose have a maximum of 160 pounds per square inch. The entire design and construction of the Newton brake hose testing device is utterly unsuited for handling grease pressures of the order of 10,000 pounds per square inch, as is a common requisite in the art of automobile chassis lubrication.

The full size air brake hose testing appliance of the Newton patent was set up and repeatedly demonstrated in the District Court with a power-driven air compressor, precisely in accordance with its intended use and mode of operation. This demonstration of the reality, as made and constructed by Newton and his assignees, was perhaps the best possible evidence of the manifold differences in construction and mode of operation between the Newton device and the lubricating system of the Butler patent in suit.

Finally, the testimony of the defendant's Chief Engineer and expert, Alexander P. Fox, almost completely removed the Newton air brake hose testing appliance from the need of further consideration. In this connection we very particularly refer the Court to the following cross-question which was put to Mr. Fox at R. p. 221, and to the answers and evasions which it elicited throughout the immediately succeeding pages of the record.

"Q. Can you name any one patent or other publication, or any patent application filed prior to the filing of the application for the Butler patent in suit on February 19, 1923, which discloses any kind of pumping system for any kind of fluid whatsoever, either liquid or gas, in which there is a compressor connected to a nipple by a coupler, which includes a cylinder and piston cooperating so as to tighten any kind of gripping elements inwardly around the nipple upon actuation of the compressor, and which also includes a fluid pressed seal engaging the end of the nipple to effect a fluid tight joint. I have cut that question out

of my notes so that you can read the question as well as having heard it."

It is to be observed that this "formal cross-question No. 2" was exceedingly broad and comprehensive. It was not limited to the art of lubrication. It embraced any and every field "for any kind of fluid whatsoever, either liquid or gas." Nevertheless, Mr. Fox could not answer it, and did not answer it by suggesting Newton (or anything else in the prior art) as meeting its broad and comprehensive terms.

He took refuge rather, in asserting that claim 2 of the Butler patent did not describe the structure shown in the drawings and specifications of the Butler patent itself. We do not stop to discuss the absurdity of such a position and contention.

Mr. Fox's contention that the claim of the Butler patent did not even describe the device shown in its own accompanying drawings and specifications was of course based upon his other contention and attempted demonstration that the Butler apparatus was operative only when the jaw-actuating mechanism of the piston member was so weak and flimsy that it would not apply any pressure upon the jaws or permit the jaws to apply any pressure to the nipple, and upon the allied contention and attempted demonstration that when the jaw-actuating mechanism was made sufficiently stiff to apply pressure, then the device would be completely inoperative because of the alleged impossibility of removing the coupler from the nipple.

These contentions were utterly annihilated upon the subsequent discovery and demonstration that Mr. Fox had falsified his presentation and demonstration by shortening the cylindrical shell of the coupler to an extent such that the piston mechanism could not reciprocate at all, as is of course required by the disclosure of Butler's drawings and specifications.

This subsequent demolition of any possible basis upon which Mr. Fox could take refuge in the alleged non-applicability of Butler's claim to Butler's disclosure, left him and the defendant in the position of being unable to advance Newton or anything else in the prior art as even approaching an anticipation of the Butler invention, even when considered in an aspect much broader than the art of lubrication.

The several other prior art patents listed but not otherwise discussed in the appellant's brief are of the kind which show one element or another element but not the complete new combination which Judge Lindley had in mind when, in his first opinion of July 15, 1936, he said:

"Obviously to any trial judge, in their final analyses, almost all patentable combinations are of the second class, namely: those in which all the elements are of themselves old." (R. p. 611.)

The defendant offered in evidence and, in its brief, lists a grist of patents, some showing one element and some showing another. None of them discloses the complete combination of the claim or anything approaching the complete combination of the claim. It would not seem to be profitable to canvass these many prior patents to which the petitioner's counsel themselves give only the scantiest and most passing attention.

The Courts' Twenty-sixth Finding of Fact Was That:

"The defendants John R. LeVally and Frederick A. Faville did not, as individuals, either jointly or severally, sell any Lincoln Kleenseal fittings."

This is the only one of Judge Lindley's Findings of Fact which we have not heretofore quoted. It means merely that the officers of the Lincoln Company were found not to be liable in their individual capacities.

ARGUMENT.

I.

THE SUPREME COURT HAS NOT RECENTLY ABOLISHED THE AGE-OLD LAW OF JOINT TORTS AS APPLIED TO THE INFRINGEMENT AND CONTRIBUTORY INFRINGEMENT OF PATENT RIGHTS. THERE HAS BEEN NO SUCH REVOLUTION IN THE LAW OF PATENTS AS IS ADVOCATED BY COUNSEL FOR THE PETITIONER.

The Petitioner's Contentions Raise a Question of Paramount Importance.

Is there any such thing as a contributory infringement?
If so, what is it?

If there is such a thing as contributory infringement, how should it be described,—or defined?

If there is no contributory infringement in the instant case, what possible facts or circumstances could support a charge of contributory infringement?

Such questions as these are the paramount issues before this Court.

For the Purposes of our Discussion of This Question of Contributory Infringement, We Shall Assume That the District Court and the Court of Appeals Were Fully Justified in Their Conclusions (1) That the Butler Patent in Suit Was Not Anticipated by the Prior Art; (2) That It Involved the Exercise of Invention; (3) That the Lubricating Apparatus Manufactured and Sold by the Stewart-Warner Corporation Does Embody the Invention of the Butler Patent; (4) That Claim 2 of the Butler Patent Describes a Patentable Combination,—Not an Unpatentable Aggregation; (5) That There Is No Issue of Alleged Clayton Act Violation; and (6) That There Is No Issue of License to the Defendant-Petitioner.

(1) Counsel for the petitioner urge that the Butler patent in suit is invalid because it is anticipated by the prior art. It is only by a flagrant disregard of the plain language of Butler's specification and claim that this contention can be advanced. We apprehend that the Court will not be able to find in any one disclosure of the prior art an anticipatory response to the plain language of Butler's claim 2, regardless whether it be read literally or whether it be read as it is entitled to be read, in the light of the accompanying specifications and drawings.

We shall recur to this defense of "anticipation." For the time being, we shall assume that the structure described in claim 2 of the Butler patent was not known or disclosed by any one else prior to the date when Butler filed an application for the patent in suit.

(2) Counsel for the petitioner urge that Butler's achievement did not involve the exercise of the inventive faculty,—that any one could and would, as a matter of course, have brought together the mechanism described in Butler's claim. The evidence is overwhelmingly to the contrary.

In less than a year after the Stewart-Warner Corporation bought the Butler patent and put the Butler lubricating equipment on the market, it had become the standard factory equipment of every automobile and every automobile truck made in America (with the single exception of the Duesenberg \$15,000 automobile). The respondent's Alemite Hydraulic lubricating system as manufactured and sold under the Butler patent in suit is universally regarded as far and away the best and at the same time the cheapest lubricating apparatus which has ever been devised. The deficiencies and disadvantages of every lubricating system which had been marketed prior to the advent of the Butler invention were generally recognized. There was a general recognition of the need of something better. As soon as the Butler equipment was placed upon the market, it immediately displaced everything which had gone before.

Under such circumstances, it is impossible to advance any substantial reason for a conclusion that the Butler patent is invalid because "no invention was involved."

(3) Counsel for the petitioner urge that the Alemite Hydraulic lubricating equipment manufactured and sold by the Stewart-Warner Corporation does not incorporate the invention which is described and claimed in its own Butler patent. No substantive reason is advanced in support of this contention. The petitioner relies wholly upon an irrelevant dictum of the Eighth Circuit Court of Appeals in which it was said that the respondent's Alemite Hydraulic couplers do not correspond "to the drawings and specification of its Butler patent." Any weight or pertinency which might by any possibility be attributed to the Eighth Circuit idea of the "spring finger" construction and operation of the Butler mechanism, is unavailable to the petitioner in the present case because the petitioner recognized the untenability of the Eighth Circuit idea to the extent of offering evidence to show that the mechanism illustrated and

described in the Butler patent is not such mechanism as must have been assumed by the Eighth Circuit Court of Appeals, but rather just such mechanism as the respondent has invariably offered in evidence as representing the construction illustrated and described in the Butler patent.

We are confident that the Court will, upon the basis of the petitioner's evidence, as also upon the basis of the respondent's evidence, reach the conclusion that the Stewart-Warner Company's "Alemite Hydraulic" lubricating equipment does embody the invention described and claimed in the Butler patent in suit. For the time being, we shall assume that such is the fact and will be the conclusion of the Court.

(4) From first to last, the petitioner's brief insinuates and assumes and contends that the new coaction and co-operation between the "headed nipple" element and the other six elements of the Butler combination, did not entitle Butler to claim the whole of his new combination. Counsel insinuate and assume (they cannot well contend) that the very essential coaction of the headed nipple in resetting and cocking the piston mechanism of the coupler, and in various other ways, had no part in the achievement of Butler's new and unitary result. Counsel for the petitioner insinuate and assume (they cannot well contend) that Butler's grease compressor had no new or different function in bringing about the automatic gripping and the automatic end sealing of the connection between the two halves of the connector mechanism during the injection of grease.

Butler's "machine" is like every other new and patentable machine in that it comprises a new combination of elements,—each of which elements was separately old and well known. In so far as the instant case is concerned, the purposes of counsel for the petitioner are well served by attempting or pretending to concede that the five separately

old elements which make up the coupler part of the whole, constitute a good and valid "combination," whereas the seven separately old elements which make up the complete mechanism necessary to achieve the new and unitary result, do not constitute a valid and patentable combination.

The lower courts have found and explicitly described the new and unitary result which Butler achieved. They have found that each of the seven elements of claim 2 co-operates in new ways and performs new functions in the achievement of this new and unitary result. They have explicitly described the various respects in which the headed nipple part of the Butler combination co-operates with the other six elements of the combination in ways in which no other nipple ever co-operated before. They have explicitly described the new interactions between the parts, including, for example, the necessary coactions of the headed nipple in cocking and resetting the piston mechanism of the coupler. They have made it clear that the five elements comprised within the coupler could not automatically effect a mechanical gripping or automatically effect an end seal, except as a result of the action of the headed nipple in first putting the gripping and sealing mechanism in position and condition for the performance of those functions. They have pointed out that the action of the grease compressor in automatically effecting the operation of the gripping mechanism and automatically effecting the operation of the sealing mechanism, involves a new function never experienced by any grease compressor prior to the advent of the Butler invention.

We are satisfied that this Court will find it necessary under the authorities to join the lower courts in reaching the conclusion that every one of the seven elements of Butler's claim 2 was necessary to the achievement of the new and unitary result. We are satisfied that this Court will join the lower courts in reaching the conclusion that Butler

was entitled under the patent statutes of the United States to claim as his invention the combination of these seven elements,—all of which necessarily participated in the achievement of the one and only new and unitary result which constituted Butler's aim and object.

For the time being, we shall assume that claim 2 of the Butler patent describes a new and patentable combination of seven elements.

(5) Counsel for the petitioner urge that the respondent has violated or attempted to violate the Clayton Act. The authorities agree that violations of the anti-trust laws may not be interposed in defense of patent infringement suits. This defense was never pleaded in answer to the bill of complaint. No one adduced evidence either in support or in denial of the allegation. The allegation was not even urged in the District Court or in the Court of Appeals. It is advanced in this Court for the first time. Even if the Court were to consider the matter upon the basis of all of the evidence which was introduced with respect to all of the questions which really *are* in issue, we are satisfied that it must reach the conclusion that the petitioner has not violated nor attempted to violate the Clayton Act.

The Clayton Act prohibits certain contracts of lease or sale but in no wise affects the subject-matter of this action in tort. Respondent's case in no sense depends upon any contractual relationship, either expressed or implied. On the contrary, it depends solely on its patent rights and upon which rights the petitioner is alleged to have trespassed. If respondent's position as to this trespass is correct, there is nothing in the Clayton Act to prevent relief and recovery. If the respondent is wrong, that is the end of the matter, and the Clayton Act can add nothing of interest.

For the time being, we shall assume that this case in-

volves the patent laws, and that it does not involve the anti-trust laws of the United States.

(6) Counsel for the petitioner urge that the respondent is equitably estopped to assert its patent rights. They urge that the Stewart-Warner Corporation has impliedly licensed the Lincoln Engineering Company to manufacture and sell the headed nipple parts of the combination of Butler's invention. The petitioner's contentions are such, however, as to mean by necessary implication that the Lincoln Engineering Company is impliedly licensed to manufacture and sell every other element and part of Butler's lubricating apparatus.

It is essential to the purchasers of Butler's lubricating apparatus that they be able to buy such assortments of the various parts as will meet their peculiar and variant needs. If, therefore, the Stewart-Warner Corporation is to do any business in manufacturing and selling the Butler invention, it must necessarily sell such assortments of the component parts as will meet the needs of its customers. If by selling such assortments as will enable its customers to grease the bearings of their widely variant machinery, the Stewart-Warner Company has by implication licensed the Lincoln Engineering Company to sell the nipple parts of the machine, then by the same procedure the Stewart-Warner Company has impliedly licensed the Lincoln Engineering Company and every one else to manufacture and sell the compressor, the cylinder, the piston and its aperture, the sealing seat, the locking jaws—all of the parts—all of the mechanism which constitutes Mr. Butler's invention. If the manufacture and sale of the Butler invention in the only way in which it can be sold at all, necessarily licenses the Lincoln Engineering Company and all of the world to join competitively in the manufacture and sale of all of the several parts of the Butler lubricating apparatus,

precisely as does the owner of the Butler patent, then indeed the "patent protection" of a meritorious invention has become a poor sham.

The law, as authoritatively stated, is that defenses of estoppel and of implied license cannot be urged unless they have been pleaded. The reason is clear: If a plaintiff is to meet the defense of estoppel or of license, he is entitled to be apprised of that fact, in order that he may adduce the evidence with which to meet and avoid these defenses. In the present case the defendant's answer did not plead any estoppel; the defendant's answer did not plead any license, either express or implied. No one directed any evidence to the facts which would tend, either to establish, or to refute, the charges of estoppel and license. Neither of these defenses was urged in the District Court or in the Court of Appeals. They are here and now advanced to this Court for the first time.

For the time being, we shall assume that these defenses can neither be sustained nor entertained.

Assuming that all of the foregoing defenses should be and will be rejected, we are left with what the inventors of the United States regard as the question of paramount importance in this law suit: Is there now any such thing as contributory infringement?

If so, what constitutes a contributory infringement?

We have assumed that Mr. Butler made an invention. We have assumed that the Stewart-Warner Company purchased Mr. Butler's patent and has engaged simply in putting his invention upon the market,—simply in manufacturing and selling it. We have assumed that Mr. Butler's invention is "useful" in accordance with the statutory requirement. We have assumed that the Stewart-Warner Company's patent rights have not been abrogated by some

newly asserted but never pleaded or proven violation of the anti-trust laws. We have assumed that the Stewart-Warner Company has not impliedly, and for no consideration whatsoever, licensed the Lincoln Engineering Company and all of the world to duplicate its every act in the manufacture and sale of the Butler invention.

Even if all of these assumptions are well-founded,—as we believe them to be,—the petitioner's brief and argument still raise a question which in its essence is simply this: whether there may be any such thing as a contributory infringement of a United States patent. A correct decision of this question is of course of far wider and more general importance than a decision as to the validity or scope of any particular patent.

If, even upon all of our assumptions, there has been, as counsel for the petitioner contend, no contributory infringement of the Butler patent in suit, then the inventors of the United States will be interested to learn what, if anything, would or could constitute a contributory infringement of any patent whatsoever.

The Petitioner's Theory Would Abolish All of the Law of Joint Liability for the Tort of Patent Infringement, and Would Destroy the Practical Value of the Vast Majority of Patents.

The patent statutes promise the protection of the patent laws to any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter.

The vast majority of patents fall under the classification of "machine."

Section 4888 of the statutes (U. S. C. Title 35, Sec. 33) requires that the patentee "shall particularly point out and distinctly claim the part, improvement, or combination

which he claims as his invention or discovery." Almost every new and patentable machine comprises simply a new "combination" of separately old elements,—old levers, old cams, old gears, old cranks, old connecting rods, old spindles, old plates, old what-nots. The vast majority of patents, therefore, necessarily claim simply new "combinations" of old elements. (Can any one think of any new and patentable machine which in its final analysis comprises anything other than a new combination of old elements?)

If the Lincoln Engineering Company is free to sell the headed nipple of the Butler combination, then why should not the Lincoln Sales Company be free to sell the cylinder of the coupler? Why should not the Lincoln Manufacturing Company be free to sell the piston? Why should not the Lincoln Products Company be free to sell the sealing seat? Why should not the Lincoln Lubrication Corporation be free to sell the locking jaws? Why should not the Lincoln Grease Gun Company be free to sell the lubricant compressor? Each of these elements as thus described by appropriate words of the English language, is separately old and well-known!

If seven different concerns may each engage in the sale of one of the seven parts of Butler's machine, why may not a galaxy of other concerns engage in the sale of all of the separately unpatented parts of every other patented machine,—leaving it only to the ultimate purchaser to fasten them together and enjoy the use of the assembled whole,—in complete disregard of the patentee?

The position which counsel for the petitioner take relative to this paramount question of contributory infringement, raises still further questions.

Why divide the sale of any patented machine into the sale of seven parts? Why not divide the machine into two halves? Neither half is or can be separately patentable!

Is John Doe free to sell the one unpatented and unpatentable half of the machine? Is Richard Roe free to sell the other unpatented and unpatentable ~~half of this machine?~~ Is John Doe free to sell his half of the complete machine with the knowledge and intent that the purchaser will combine it in use with the other half which he acquires from Richard Roe? Is Richard Roe free to sell his half with like knowledge and intent? Is the purchaser of the two halves free to fasten them together and then to use the complete machine of the patent?

Is there any remedy available to the patentee? May he proceed against John Doe? Against Richard Roe?

Or must he proceed only against the ultimate user, who for the first time joins together the two halves to make the complete whole which is necessarily described in the patent claim?

The petitioner's contentions necessarily mean that quite regardless of the patentee's conduct in the use which he attempts to make of his patent, John Doe and Richard Roe are free to do these things and the patentee may never, under any circumstances, have any relief against them.

Let us assume that the ultimate user can purchase all of the several parts of the complete machine for \$1.38. Let us assume that the ultimate purchasers have brought together 6,306,000 of the complete machines. (The record shows that in three years the Stewart-Warner Company sold 6,306,000 complete installations of the Butler lubricating equipment. R. p. 40.) Is it the sole remedy of the patentee, quite regardless of his own conduct in and about his business under his patent, to proceed against the ultimate user who buys and assembles the requisite parts of a complete machine at a total cost of \$1.38? Is the patentee relegated to recovery of profits or damages in separate proceedings against 6,306,000 ultimate users of his invention?

These are some of the questions which plague the minds of the patentees who await the decision of this Court in answer to the main contention of the petitioner herein.

The reason is that counsel for the Lincoln Engineering Company are asking this Court to tell the petitioner and all of the world that the Lincoln Engineering Company is not guilty of contributory infringement.

The Stewart-Warner Corporation first put the invention of the Butler patent upon the market in April, 1933. From that time to this, its sole business has been to manufacture and sell the whole of the invention of the Butler patent in suit. There have been no attempted license restrictions, no tying clauses, no understandings, no limiting contracts, no license notices, no sales of materials or supplies or parts involving either express or implied licenses. There has been nothing other than the plain, old-fashioned, and straightforward making and selling of the whole of the very thing described and claimed in the patent in suit.

Shortly prior to the advent of the Butler invention upon the market in April, 1933, the Lincoln Engineering Company had embarked upon an effort to devise a complete lubricating apparatus of its own.

There is no contention that this apparatus, first devised and sought to be sold by the Lincoln Company involved any infringement of the Butler patent. For eighteen months after the commercial advent of the plaintiff's Alemite Hydraulic equipment of the Butler patent, the Lincoln Company struggled to sell its wholly different and non-infringing lubricating apparatus,—but without success. Finally, in November, 1934, eighteen months after the advent of the Butler invention upon the market, the Lincoln Company made such changes as to incorporate a nipple having a head and a shoulder appropriate to coact and to cooperate perfectly and particularly with the other parts

of the Butler apparatus as manufactured and sold by the Stewart-Warner Company. These changes were made for the very purpose of adapting the Lincoln nipple for use in the Butler combination.

This new "headed nipple" of the Lincoln Company never existed in all of the history of the world until eighteen months after the apparatus of the Butler patent had first been put on the market in April, 1933. It was not an old thing. It was a new thing. It was a new thing designed, manufactured, and sold especially for the very purpose of becoming a part of the Butler combination as described in claim 2 of the Butler patent, and as manufactured and sold by the Stewart-Warner Corporation.

It had all of the details of precise shape, form, and dimensions requisite to bring about the necessary coactions with the other parts of the complete combination as manufactured and sold by Stewart-Warner.

Neither the precise shape nor form nor dimensions which the Lincoln Company gave to these headed nipples did have or could have any utility in connection with any of the other possible uses which the Lincoln Company began industriously to pretend to concoct for it. The Lincoln Company's headed nipples never had any existence whatsoever,—never had any utility whatsoever—until eighteen months after the advent of the Butler invention upon the market. It was a wholly new thing especially devised for the sole purpose of becoming a part of the Butler invention as theretofore manufactured and sold by the Stewart-Warner Company.

It is all well and good for the petitioner to assert that "headed nipples" were old and well-known. The fact remains that never in the history of the world prior to the commercial advent of the lubricating apparatus of the Butler patent in April, 1933, was there a headed nipple or a nipple

of any kind whatsoever which ever has been used or which ever can be used as one of the seven component elements of the Stewart-Warner Company's version of the Butler invention.

Other patentees have put and will put their inventions on the market. What will happen to them after they have enjoyed eighteen months of successful manufacture and sale of these other inventions? Will the Lincoln Engineering Company step in and begin the manufacture and sale of any or all of the special component parts of these other inventions? Is the Lincoln Engineering Company free to ruin the business of every patentee simply because the several special parts of the complete inventions of these other patentees, when described by appropriate words, may be asserted by the Lincoln Engineering Company to be, in some remote and generic sense, "separately old and unpatentable"?

Such questions as these are raised by the interpretation which counsel for the petitioner put upon the decisions of this Court in the more or less recent Dry Ice case, the Barber Asphalt case, and the case of *Rogers v. Alemite*.

The inventors of the United States are interested to learn whether the petitioner correctly interprets and applies these decisions.

In Each of the Following Cases, the Defendant's Sale of an Unpatented Article, With the Knowledge and Intention That It Be Employed in the Construction of a Patented Combination or in the Use of a Patented Process, Was Held to Constitute a Contributory Infringement.

Obviously, if the articles sold by these defendants had been separately patented, then the defendants would have been liable as direct infringers. There would have been

no opportunity or occasion for the charge of contributory infringement.

- Wallace et al. v. Holmes et al.*, 9 Blatchf., 65; 29 Fed. Cas. No. 17,100. (C. C. D. Conn., Sept. 19, 1871, Woodruff, D. J.)
- Richardson v. Noyes*, 20 Fed. Cas., No. 11, 792. (C. C. D. Mass., Sept. 1, 1876, Lowell, D. J.)
- Bowker v. Dows*, 3 Fed. Cas., No. 1,734. (C. C. D. Mass., Oct. 9, 1878, Lowell, D. J.)
- Holly v. Vergennes Machine Co.*, 4 Fed. 74, 77, 82. (C. C. D. Vet., Oct. 5, 1880, Wheeler, D. J.)
- American Cotton Tie Co. v. Simmons*, 106 U. S. 89, 93-95; 27 L. Ed. 79, 80, 81. (Appeal from C. C. D. R. I. reversing 1 Fed. Cas. No. 293—Nov. 6, 1882, Blatchford, Justice.)
- Schneider v. Pountney*, 21 Fed. 399, 402, 403. (C. C. D. N. J., Aug. 30, 1884, Nixon, D. J.)
- Travers v. Beyer, et al.*, 26 Fed. 450. (C. C. N. D. N. Y., Jan. 28, 1886, Wallace, D. J.)
- Schneider v. Missouri Glass Co.*, 36 Fed. 582, 583, 584. (C. C. E. D. Mo., Oct. 31, 1888, Thayer, D. J.)
- Stearns et al. v. Phillips et al.*, 43 Fed. 792, 795. (C. C. E. D. Mich., July 7, 1890, Brown, D. J.)
- Thomson-Houston Electric Co. v. Kelsey Electric Railway Specialty Co.*, 75 Fed. 1005, 1007, 1008, 1010. (C. C. A. 2, July 29, 1896, Shipman, C. J.)
- Thomson-Houston Electric Co. v. Ohio Brass Co., et al.*, 80 Fed. 712, 713, 720-722, 730. (C. C. A. 6—May 17, 1897—Taft, C. J.)
- New York Filter Mfg. Co. v. Jackson*, 91 Fed. 422, 425, 426. (C. C. E. D. Mo., E. D., Dec. 27, 1898, Adams, D. J.)
- German-American Filter Co. of New York v. Loew Filter Co., et al.*, 103 Fed. 303. (C. C. N. D. Ohio, E. D., June 30, 1900, Day, C. J.)

- John R. Williams Co. v. Miller, DuBrul & Peters Co.*, 107 Fed. 290, 293. (C. C. S. D. N. Y., Feb. 4, 1901, Wheeler, D. J.)
- Rumford Chemical Works v. New York Baking Powder Co. et al.*, 136 Fed. 873. (C. C. S. D. N. Y., Jan. 3, 1905, Lacombe, C. J.)
- Johnson, et al. v. Foos Mfg. Co.*, 141 Fed. 73-75, 85, 87, 88. (C. C. A. 6, Nov. 29, 1905, Lurton, C. J.)
- Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co.*, 147 Fed. 266, 274-275. (C. C. E. D. Wis., June 2, 1906, Quarles, D. J.)
- Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 325, 332, 333, 337; 53 L. Ed. 816, 819, 820, April 19, 1909, McKenna, Justice. (On certiorari to C. C. A. 2, affirming 154 Fed. 58.)
- Victor Talking Mach. Co. v. Duplex Phonograph Co.*, 177 Fed. 248. (C. C. W. D. Mich., S. D., May 27, 1909, Knappen, D. J.)
- Parsons Non-Skid Co. v. Seneca Chain Co.*, 192 Fed. 46. (C. C. S. D. N. Y., Nov. 18, 1911, Lacombe, C. J.)
- Acme Acetylene Appliance Co. v. Commercial Acetylene Co.*, 192 Fed. 321-323, 329. (C. C. A. 6, Dec. 5, 1911, Warrington, C. J.)
- Woodward Co. v. Hurd, et al.*, 232 U. S. 428; 58 L. Ed. 671, 672. (Feb. 24, 1914, Hughes, Justice.)
- Consolidated Rubber Tire Co. v. Diamond Rubber Co.*, 226 Fed. 455, 461, 462. (D. C. S. D. N. Y., July 22, 1915, L. Hand, D. J.) Affirmed, 232 Fed. 475.
- Solva Waterproof Glue Co. et al. v. Perkins Glue Co.*, 251 Fed. 64, 73. (C. C. A. 7, Jan. 2, 1918, Kohlsaat, C. J.)
- Barrett, et al. v. Sheaffer*, 251 Fed. 74, 79. (C. C. A. 7, Jan. 2, 1918, Kohlsaat, C. J.)

- Dental Co. of America v. S. S. White Dental Mfg. Co.*, 266 Fed. 524. (C. C. A. 3, July 10, 1920, Woolley, C. J.) Affirming 263 Fed. 719.
- Jockmus v. Gale & Co.*, 295 Fed. 208, 212. (D. C. D. Conn., Dec. 14, 1923, Thomas, D. J.)
- Belknap et al. v. Wallace Addressing Mach. Co., Inc.*, 12 Fed. (2d) 597. (C. C. A. 2, Apr. 5, 1926, Per curiam.)
- American Stainless Steel Co. v. Ludlum Steel Co.*, 16 Fed. (2d) 823, 824. (D. C. S. D. N. Y., Feb. 4, 1926, Thacher, D. J.)
- Westinghouse Electric & Mfg. Co. v. Precise Mfg. Corp.*, 11 Fed. (2d) 209, 212. (C. C. A. 2, March 8, 1926, Manton, C. J.)
- Electro Bleaching Gas Co. et al. v. Paradon Engineering Co., Inc.*, 12 Fed. (2d) 511, 512, 513. (C. C. A. 2, May 17, 1926, Hough, C. J.)
- General Electric Co. v. De Forest Radio Co.*, 28 Fed. (2d) 641, 648. (C. C. A. 3, Sept. 18, 1928, Woolley, C. J.)
- Trico Products Corporation v. Apco-Mossberg Corporation*, 45 Fed. (2d) 594, 599. (C. C. A. 1, Nov. 26, 1930, Wilson, C. J.)
- Graham Paper Co. v. International Paper Co.*, 46 Fed. (2d) 881, 882, 885, 886, 887. (C. C. A. 8, Feb. 17, 1931, Kenyon, C. J.)
- Naivette, Inc. v. Bishinger, et al.*, 61 Fed. (2d) 433. (C. C. A. 6, Oct. 12, 1932, Simons, C. J.)
- Activated Sludge v. Filtros, Inc.*, 10 Fed. Supp. 241. (D. C. W. D. N. Y., Mar. 23, 1935, Rippey, D. J.)
- Philad Company v. Modernistic Permanent Wave Mach. Co.*, 31 U. S. P. Q., 13. (Apr. 9, 1936, Molyneaux, D. J.)

Fehr, et al. v. Activated Sludge, Inc., 84 Fed. (2d) 948, 949, 957. (C. C. A. 7, June 24, 1936, Sparks, C. J.)

Bundy Incubator Co. v. George Cugley, et al., 30 U. S. P. Q., 340. (Aug. 12, 1936, Raymond, D. J.)

Aero Neck-Band & Collar Co., Inc., et al. v. Fenway Fabrics, Inc., 19 Fed. Supp. 846, 849, 850, 851. (D. C. S. D. N. Y., June 22, 1937, Woolsey, D. J.)

If the petitioner's interpretation of the recent decisions of the Supreme Court are correct, then all of the Courts in all of the foregoing cases were wrong in holding the defendants liable as contributory infringers.

The Four Supreme Court Cases Out of Which the Petitioner Endeavors to Spell a Practical Abolishment of the Law of Joint Torts as Applied to the Tort of Patent Infringement.

On page 58 of their brief, counsel for the petitioner list the decisions of this Court in the *Leeds & Catlin* case, the *Dry Ice* case, the *Barber* case, and the *Rogers* case, and then formulate the conclusion based upon their understanding of these cases that,

"While the theory of contributory infringement may be applicable to prevent a defendant from appropriating the patentee's actual contribution to the art, as in the *Leeds & Catlin* case, it is entirely inapplicable to prevent a defendant from using things long old in the art as in the *Carbice, Leitch and Rogers* cases."*

* Even if this sentence correctly summarized these recent decisions of the Supreme Court, it would not serve to overrule the concurring decisions of the lower courts in the instant case, (1) partly because the defendant, Lincoln Engineering Company, does not "use" the things complained of—it sells for use by others in the combination which constitutes Mr. Butler's invention; and (2) partly because the particular headed nipples sold by the defendant were not "long old in the art"—they never existed until more than a year after the Butler invention was put on the market, whereupon they were then first especially designed and made with the definite knowledge and intention that they were to be used in the Butler combination, and with the knowledge that their special details had no other utility, no other reason for being.

Quite aside from the fact that counsel's stated summary of the law to be derived from these recent decisions of the Supreme Court would not relieve the defendant from the charge of contributory infringement in the instant case, still it will be well worth while, we think, to determine whether or not counsel for the petitioner have correctly understood and interpreted these recent decisions.*

The Petitioner's Theory Means Necessarily That Every Infringement Must Be a Complete and Direct Infringement,—That There Can Be No Such Thing as a Contributory Infringement.

If counsel for the petitioner do correctly interpret the recent decisions of this Court, there cannot be such a thing as contributory infringement,—in any practical or realistic sense. This is for the reason that if "the patentee's actual contribution to the art" is to be determined in the manner in which counsel for the petitioner would determine it, there would not ordinarily be any particular piece or part of the whole invention which could be designated as that in which the crux or essence of the invention specially inhered. Almost all inventions, more particularly all machine or apparatus inventions, necessarily involve merely new combinations of old elements. The classic definitions of a patentable combination are those of *Leeds & Catlin v. Victor*. In 213 U. S. 301, 318, this Court said, by Mr. Justice McKenna:

"A combination is a union of elements, which may be partly old and partly new or wholly old or wholly new. But, whether new or old, the combination is a means—an invention—distinct from them. They, if

* The Court is doubtless aware of the many different and conflicting views which lawyers and courts have expressed relative to the real ground and meaning of your Honors' decision in the Carbice case. The more recent decision in the case of *Leitch v. Barber* has engendered further controversy and discussion.

new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same patent with the combination.

"But whether put in the same patent with the combination or made the subjects of separate patents, they are not identical with the combination. To become that they must be united under some corporative law. Certainly, one element is not the combination, nor, in any proper sense, can it be regarded as a substantive part" (i. e., the essential part, or, as it is sometimes called, the "gist") "of the invention represented by the combination, and it can make no difference whether the element was always free or becomes free by the expiration of a prior patent, foreign or domestic. In making a combination, an inventor has the whole field of mechanics to draw from. This view is in accordance with the principles of the patent laws. It is in accordance with the policy of Section 4887 of the Revised Statutes; which is urged against it."

Perhaps even more pointed in respect of the present discussion is the definition of a patentable combination as stated in the opinion of the Court in the second *Leeds & Catlin* case, 213 U. S. 325, 332, where Mr. Justice McKenna said:

"A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or noncomposite instrument. Whoever uses it without permission is an infringer of it. Whoever contributes to such use is an infringer of it. It may be well here to get rid of a misleading consideration. It can make no difference as to the infringement or non-infringement of a combination that one of its elements or all of its elements are unpatented. * * * In other words, the fact that the disc sold by petitioner is unpatented does not affect the questions involved except to give an appearance of a limitation of the rights of an owner of a Victor machine other than those which attach to him as a purchaser."

Section 4888 of the Revised Statutes (U. S. C. Title 35, Sec. 33) expressly provides that the patentee shall claim the "combination which he claims as his invention."

If now an inventor may patent and thus claim his new combination, and if his new combination is a union of elements each of which is separately old, then the only thing which the patentee can contribute to the art is the whole of that combination of old elements. To use the language of petitioner's counsel, "the patentee's actual contribution to the art," in any such case as this, is necessarily a combination of old elements. The invention cannot inhere in some one of the old parts. It cannot inhere in some two or three of the old elements. It must necessarily inhere in the whole of the new combination.

When, therefore, the patentee has invented a new combination of old elements, he cannot procure any patent except by claiming just what the statute requires him to claim as his invention, namely, the "combination." The Patent Office will not permit him to claim less. If he attempts to do so, he will be met with a rejection upon the ground that his claim is incomplete. As was said by Patent Commissioner Thatcher in *In re Farrow*, 2 O. G. 57, 1872 C. D. 148:

"If there are parts which may be optionally omitted in the construction of the device, they may also be omitted in the claim. It is only necessary that such elements be named as will constitute an operative whole, unless the novelty of the device depends upon the presence of the additional elements."

In *Ex parte Jones*, 343 O. G. 4, 1926 C. D. 100, the Commissioner of Patents said:

"The proposed claim 3 as rewritten is incomplete by reason of the inclusion of the expression—'means comprising contacts mounted on the walls of the cylindrical casing, whereby said lamp is connected to a source of energy when said platform is pushed into position.' Obviously, the means for connecting the lamp with the source of energy comprises something more than the contacts mounted on the walls of the cylindrical casing. It is uncertain whether the whereby clause refers to the means or to the contact. The claim is not for means for doing something, but for means for permitting something to be done. The claim is therefore indefinite or incomplete."

In *Loggie v. Puget Sound*, 194 Fed. 158, 164, the Court held

"that the first five claims of the complainant's patent are void for lack of utility, because, without the first section of the guide including the down presser, which is omitted from said claims, the apparatus is inefficient and impractical."

In *Rapp v. Central*, 158 Fed. 440, 442, the Court said:

"The elements of claim 1, without the lips or other means for engaging the parts and connecting them together, would be an incomplete and inoperative (ive) and useless structure. In fact, no structure at all, but simply pieces of metal. We must read into it some means for connecting the various parts. Should they be nailed to the core or filler in the usual manner of nailing, we would not have a fireproof door."

In *Bliss v. Brooklyn*, 3 Fed. Cas. 707 (Federal Case No. 1546), the Court said:

"In the one combination, no lug appears, and no practical result is attained. The introduction of the lug, for the first time, produced a combination which accomplished any useful result. An added element, which increases the efficiency of a combination, of itself effective, is of the nature of an improvement; but, when the added element is essential to the production of any useful result, such an addition is not an improvement, but its use gives birth to the only patentable, because the first useful, combination. Notwithstanding, then, the conceded fact, that the combination which includes the lug with other elements which are described in the reissue of 1869, is useful, it is, nevertheless, necessary, in order to sustain the reissue, that it should appear that the device there described, which does not contain the lug, is of some utility. As before stated, the contrary here appears, and, for this reason, the patent must be declared invalid."

There is no logical sense in which it can be said that something less than the whole of a new and patentable combination constitutes the "gist" of the invention. As was said in the opinion of the Sixth Circuit Court of Appeals in

the case of *Automotive Parts Co. v. Wisconsin Axle Co.*, 81 Fed. (2d) 125, 126:

"The invention is for a composite thing, embracing several elements or parts, all of which are necessary to and co-operate in the operation of the patented unit. We cannot subscribe to the view that the test of contributory infringement in the furnishing of parts for a combination invention is whether the parts furnished constitute the gist or essence of the invention; indeed, we cannot see how it may be said that any one element or another marks the advance step or is the essence of such an invention. There are cases, it is true, in which the phrase 'essence of the invention' is used; but in our view, when the facts in those cases are considered, it cannot be said that the conclusions reached were the result of a logical selection of one or more elements of the combination as the gist or essence of the invention."

In the case, therefore, of any patentable invention comprising a new combination of old elements, "the patentee's actual contribution to the art" is that very combination,—the whole of it,—nothing less.

According to the petitioner's interpretation of the recent decisions of this Court, there could therefore never be any such thing as a contributory infringement of such a patent. The making or using or selling of "the patentee's actual contribution to the art" would necessarily involve the making or the using or the selling of the complete union or composition or combination of old elements. The making or the using or the selling of any one of the old elements would not involve the making or the using or the selling of "the patentee's actual contribution to the art." The same would be true of the making or using or selling of any two or three of the elements of the complete combination. The making or selling of any number of old elements less than the total number of the elements of the composite whole, would not involve the sale of "the patentee's actual contribution to the art."

If any defendant were to make or to use or to sell the entire combination, *i. e.*, "the patentee's actual contribution to the art," then he would be guilty of complete and direct infringement. He could be prosecuted as "an infringer." There would be no occasion to proceed against him as "a contributory infringer." He would not indeed be a contributory infringer. He would be simply an infringer.

Whenever a person sells one (or some only) of the several elements of a combination claim with the knowledge and intention that the purchaser will combine them for use with the other elements of the combination, he is engaged in what may be stated to be merely the sale of unpatented parts or elements. When these parts or elements are described as they necessarily must be described in a patent claim by the use of mere words, then it can generally be said that each of the parts of elements is in and of itself not only unpatentable but "old". The connecting rod of a new combination must have certain length and breadth and various details of conformation,—otherwise it will not co-operate with the cross head and the crank,—it will not fit into the combination of which it is a part. Nevertheless, the mere words of a patent claim may appropriately describe it as a connecting rod. Counsel for the petitioner would say in such a case that the connecting rod is merely a "thing long old in the art."

It is their contention that when each and every element of a combination patent claim is capable in the above sense of being described as something separately unpatentable,—something "long old in the art," then anybody and everybody is free to make and to sell it. They say that anybody and everybody is free to make and sell it with the knowledge and intent that the purchaser will combine it with the other "old" elements of the new and patented combination, thereby leaving it for the purchaser merely to bolt or otherwise

fasten the parts together. Counsel for the petitioner say that this is the position of this Court, as announced in its recent decisions. The criterion, according to counsel for the petitioner, is whether or not the party who manufactures and sells one or more of the several parts of the whole has furnished what may be termed "the patentee's actual contribution to the art."

This cannot be the test.

This cannot be the criterion.

We do not believe that this Court is attempting to say in any one decision or in all of its decisions, that such is the criterion. Certainly this Court has not as yet said that the test of contributory infringement is to be found simply in an answer to the question whether those words of a patent claim which describe the defendant's contribution to the whole, can be said to describe also some other thing which in and of itself is unpatented or which can be found in the prior art.

We cannot believe that it is the purpose or desire of this Court to accept and apply the petitioner's formula for determining a defendant's liability or non-liability as a contributory infringer. It was with respect to this formula as urged by counsel for the petitioner that the Seventh Circuit Court of Appeals said in its opinion in the instant suit:

"While going no further than is necessary to defeat the patent in the present case, the conclusion from appellant's brief is unavoidable, that *Bassick Mfg. Co. v. R. M. Hollingshead, supra*, revolutionized the law of patents and repudiated the position of courts, including many decisions in this circuit, long accepted as the law in patent cases. * * * If the court announced a rule in the Bassick case, as contended by appellant's counsel, or if all of its implications (the substitution of a new element for an old element does not afford the basis of a valid patent) be accepted as the present law respecting the

validity of patents, then *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 301, is overruled. However, instead of stating that the Leeds & Catlin opinion is overruled, the court distinguished it and thereby impliedly recognized the soundness of the rule there announced.

"Until and unless there is an express repudiation of the *Leeds & Catlin Co. v. Victor Talking Machine Co.* case, we cannot accept the *Bassick Mfg. Co. v. R. M. Hollingshead* opinion as being inconsistent with the views stated in the former opinion." (91 Fed. (2d) 757, 760, 761; R. p. 633, 634, 635.)

There are two reasons why the test of contributory infringement as formulated by counsel for the petitioner, allegedly upon the basis of the recent decisions of this Court, would revolutionize and practically destroy the law of patents:

(1) If anybody and everybody is free to make and sell one element or two elements or anything less than all of the elements of a patented combination, without regard to the intention or purpose with which these separately old and unpatented elements are thus sold, then anybody and everybody else will be equally free to sell each and all of the other parts of that combination. If no such contributor can be held liable as a contributory infringer, then the patentee's remedy will necessarily be limited to suits or actions against the ultimate users who bring the several parts together to form the unitary whole of "the patentee's actual contribution to the art."

As was said by Odin B. Roberts in his article on "Contributory Infringement of Patent Rights," in Vol. XII, No. 1, of the April, 1898 issue of the Harvard Law Review, page 35,

"There is always, nominally at least, a clear remedy for the patentee by suit against the immediate infringers whose acts are punishable by injunction, whether or not any actual intent to infringe existed.

In many cases, however, such a remedy is wholly inadequate. A manufacturer who distributes thousands of infringing machines is the only defendant against whom the patentee can obtain real relief; for, as against the purchaser and user, a suit in equity could not reimburse the patentee for the unavoidable expenses of his suit; the courts recognize the existence of this state of things, and in cases of contributory infringement assist the patentee, so far as possible and proper, in his attempt to stop the trespass at its origin rather than compel him to take a course which practically opposes an impossibility to his effort toward establishing or enforcing his right."

- (2) If a valid and enforceable patent cannot be had upon a new combination of old elements, all of which co-operate and coact in new ways to effect the accomplishment of a new and unitary result, then there are few valid patents in existence, there can be but few valid patents in the future. The reason is that almost every new invention involves simply a new combination of old elements. In the case of such a new combination of old elements, it is logically and practically impossible to select any one element or any smaller group of elements and to say that "the patentee's actual contribution to the art" inhered in this one element or in this lesser group of elements. If a patentee attempted to select and claim any one element of his combination, he would be met by the fatal objection that in and of itself the one element was old and well-known, and by the objection that he had failed to claim anything which would meet the test of usefulness. If it were possible to select and to claim in a patent, the one element or the lesser group of elements representing, as petitioner's counsel would have it, "the patentee's actual contribution to the art," then there would indeed be no need of any doctrine of contributory infringement, because, forsooth, the making or selling of the one supposedly gist-like element would constitute a complete and direct infringement.

We respectfully submit that if there is any such thing as contributory infringement, then the criterion of such contributory infringement is not to be found in the formula which counsel for the petitioner say that they have derived from the recent decisions of this Court.

Counsel for the petitioner do not, of course, say in so many words that there is no such thing as contributory infringement. Nevertheless, as we have seen, their proposed test of contributory infringement is such that there cannot be any such thing as contributory infringement, either logically or practically.

It Is Impossible to Derive the Petitioner's Formula of So-Called Contributory Infringement From Anything and Everything Which the Supreme Court Has Said.

We are not, however, satisfied to rest the matter upon the demonstrated impossibility of applying any such formula as that advanced by counsel for the petitioner. We should like in the first place to show that the decisions of this Court do not state or rely upon any such formula as that advanced by the petitioner. We should like to show that it is impossible to derive the petitioner's formula from anything and everything which the Supreme Court has said.

We hope that we may without presumption indicate what we believe to be the law under the very decisions to which counsel for the petitioner refer, and upon which the defendant claims freedom from liability.

The Very Decisions of This Court Upon Which the Petitioner Relies, Expressly Recognize That There Still Is Such a Thing as Contributory Patent Infringement.

In the *Carbice Case*, 283 U. S. 27, 34, this Court said:

"The case at bar is wholly unlike *Leeds & C. Co. v. Victor Talking Mach. Co.*, 213 U. S. 325, 333, 53 L. ed.

816, 819, 29 S. Ct. 503, on which plaintiffs rely. *That was an ordinary case of contributory infringement.* The Victor Company sold machines embodying a patent for a combination. Leeds & Catlin were held to be infringers because the intended incorporation in the Victor machines of the article which they sold, did not constitute a repair of the machine and hence was not within the license implied on sale. *Heyer v. Duplicator Mfg. Co.*, 263 U. S. 100, 68 L. ed. 189, 44 S. Ct. 31. There was no suggestion that the Victor Company, which itself manufactured and sold the patented product, sought 'to derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies with which it is used.' In the case at bar the plaintiffs neither sell nor license others to sell complete transportation packages. They supply merely one of the several materials entering into the combination; and on that commodity they have not been granted a monopoly. Their attempt to secure one cannot be sanctioned."

Again, in the case of *Bassick v. Hollingshead*, 298 U. S. 415, 425, this Court again recognized and distinguished the contributory infringement of the Leeds & Catlin case, saying:

"*Leeds & C. Co. v. Victor Talking Mach. Co.* 213 U. S. 301, 325, 53 L. ed. 805, 815, 29 S. Ct. 495, on which the respondent relies, is not in point. There the patent was a pioneer patent and the combination was of elements which were novel and neither of which possessed utility without the other. Each element was necessary to the operation of the other. The invention did not, as here, consist of the mere improvement of one element of an old combination."

In *Leitch v. Barber*, 82 L. Ed. 276, 278, the Court said again that

"Nothing in *Leeds & C. Co. v. Victor Talking Mach. Co.* 213 U. S. 325, 53 L. ed. 816, 29 S. Ct. 503, limits it," i. e., the rule declared in the Carbice case.

The *Dick Case*, 224 U. S. 1, 56 L. Ed. 645, 32 Sup. Ct. Rep. 364, was expressly overruled in the *Motion Picture Patents Case*, 243 U. S. 502, 61 L. Ed. 871.

If it has been the intention of the Court to overrule the Leeds & Catlin Case, we believe that the Court would have said so. No one contends that the Leeds & Catlin case has been expressly overruled. Nevertheless, counsel for the petitioner take the position that the principles of the Leeds & Catlin case have in effect been overruled.

We do not think so.

The Infringement of a Patent Is a Tort; a Contributory Infringer Is a Joint Tort Feasor.

Section 4884 of the Revised Statutes, U. S. C. Title 35, Patents, Sec. 40, provides that

"Every patent * * * shall contain * * * a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention * * * throughout the United States and the territories thereof * * *."

Any violation of this exclusive right is a tort. It will probably be conceded that patent infringement is a tort. It was so regarded in the opinion in the *Carbice Case*, 283 U. S. 27, 33. There Mr. Justice Brandeis said:

"Infringement, whether direct or contributory, is essentially a tort, and implies invasion of some right of the patentee."

The same view was applied by the Seventh Circuit Court of Appeals in the instant case. In his opinion, Judge Evans said:

"In dealing with this subject of contributory infringement, it might be observed that we are dealing with a phase of the general subject of torts. An infringer is a tort feasor. A contributory infringer is one whose action contributes to the infringement." (91 Fed. (2d) 757, 763.) (R. p. 638.)

Contributory infringers have always been regarded as joint tort feasors. In discussing the matter of joint tort

feasors, Professor Cooley, in his work on torts, says, in Vol. I, sec. 75, page 238 (4th Ed.):

"What Constitutes Participation. Most wrongs may be committed either by one person or by several. When several participate, they may do so in different ways, at different times, and in very unequal proportions. One may plan, another may procure the men to execute, others may be the actual instruments in accomplishing the mischief, but the legal blame will rest upon all as joint actors."

"What Constitutes a Joint Wrong or Joint Liability. All who actively participate in any manner in the commission of a tort, or who command, direct, advise, encourage, aid or abet its commission, are jointly and severally liable therefor. 'All who aid, advise, command or countenance the commission of a tort by another, or who approve of it after it is done, are liable, if done for their benefit, in the same manner as if they had done the act with their own hands; * * * ,'"

There is no good reason why joint tort feasors should not be held liable in connection with the tort of patent infringement, just as in the case of all other torts, such, for example, as trade-mark infringement, unfair competition, copyright infringement, misappropriation of secret profits in fraud cases, assault and battery, alienation of affections, trespass for the injury of property, etc.

We respectfully submit that in the cases of Leeds & Catlin, Carbice, Leitch, and Rogers (petitioner's brief, page 58) the rule as to the liability of joint tort-feasors was accepted as a matter of course. The question was, whether the plaintiffs, by their conduct in respect of their use of the patents in suit, had disentitled themselves to relief. Relief was denied in two of the cases solely upon the ground that the plaintiffs had forfeited any right to relief because of their misuse or abuse of what otherwise might have been their patent rights.

The Cases of Rogers vs. Alemite and Bassick vs. Hollingshead Turned Upon Questions of Validity and Proof of Direct Infringement, and Did Not, Therefore, Involve the Determination of Any Question of Contributory Infringement.

Let us turn now to the four Supreme Court cases out of which petitioner's counsel endeavor to spell an immunity for the Lincoln Engineering Company.

Rogers v. Alemite and Bassick v. Hollingshead,
298 U. S. 415.

In these cases the plaintiff sought to establish the liability of the defendants as contributory infringers.

In the Hollingshead Case, the Court Found That the Parts Furnished by the Hollingshead Company Did Not Embody the Suction Effect Coupler Claimed in the Gullborg Patent in Suit.

In the Hollingshead case the court found claims 1 to 6 and 8 and 10 of Gullborg patent No. 1,307,734 to be valid because the patent disclosed novelty and invention in the combination which included a movable perforated cup-shaped disk or washer in the barrel of the coupler held by a spring against the orifice of the coupler, which disk on being forced forward by its spring as the coupler was removed, caused a vacuum which drew in any lubricant that would otherwise adhere about the orifices of the fitting and the coupling.

The plaintiff's charge of contributory infringement was based on the contention that the compressor and coupler parts which had been sold by the defendant had this construction and mode of operation.

The opinion of the Supreme Court refers to the decision of the Sixth Circuit Court of Appeals, saying that

"It therefore held that the accused grease gun lacked the only novel feature of the patented combination." (page 422.)

The Supreme Court reached the same conclusion, saying:

"We are satisfied that the Circuit Court of Appeals was correct in its decision that the accused device did not embody the novel feature claimed in the patent." (page 422.)

The decision of the court in respect of these claims 1 to 10 of the Gullborg patent obviated any possible question of contributory infringement. If the defendant, Hollingshead Company, had manufactured and sold the complete combination embracing its own grease gun and coupler and also pin fittings of the kind manufactured and sold by the plaintiff, the decision of the court would have been that there was no infringement of any kind because the defendant's device did not embody the construction and mode of operation which constituted Gullborg's invention as set forth in claims 1 to 6 and 8 and 10 in suit.

The Hollingshead part of this decision by the Supreme Court does not, therefore, throw any light upon any question of contributory infringement.

In the Rogers Case, Claims 14 and 15 of the Gullborg Patent Were Held to Be an Attempted Double Patenting of Gullborg's Earlier Patent No. 1,307,733.

Let us turn now to the part of the decision which dealt with the case of *Rogers v. Alemite Corporation*. Here again we shall find that the decision was upon grounds which did not involve any question of contributory infringement.

The plaintiff's suit against the Rogers Company in-

volved two rather separate and distinct sets of facts and questions. Claims 14 and 15 only were involved in the one situation. Claims 1 to 6 and 8 and 10 alone were involved in the other situation.

The situation involving claims 14 and 15 only was as follows: Mr. Gullborg, the patentee of the patent in suit, had taken out a prior patent, No. 1,307,733, which described and claimed a certain novel pin fitting. This earlier patent contained claims describing this pin fitting in and of itself. In its opinion the court said that "claim 15 may be taken as typical" of claims 14 and 15; and it said that

"It will be noted that this claim describes a combination consisting of the pin-fitting of Gullborg's Patent No. 1,307,733, with any grease pump having a bayonet type coupler." (page 420).

In so far as these claims 14 and 15 were concerned, it was said that the Rogers Company had sold "grease guns having a bayonet slotted coupler, which could be used * * * with the pin fittings of Gullborg's patent No. 1,307,733." (page 423).

Of these grease guns the court said:

"The petitioner's grease guns are of an old unpatented type, having couplers of a different construction from that disclosed in the patent. There is no assertion that they produce the suction effect of Gullborg's invention." (pages 423-424).

As bearing upon the patentability of claims 14 and 15 over the earlier patent No. 1,307,733, which described and claimed the novel pin fitting only, the court found that

"The proofs establish that the prior art embraced the use in combination of a grease gun composed of a chamber or pump, a hose, a hose-coupler, and a spring-closed fitting, the coupling being of the pin and slot or bayonet type."

The question in issue was stated by saying that

"The respondent's position is, nevertheless, that if the petitioners furnish a gun, a part of this old un-

patented and unpatentable combination, for use with the patented pin fitting of Gullborg's No. 1,307,733, they contributorily infringe claims 14 and 15 of the patent in suit because those claims describe the combination of any grease gun with the patented pin fittings."

The court then disposed of the one situation which involved these claims 14 and 15 by holding these claims to be invalid because they attempted to secure a second patent upon the one invention which had already been described and claimed in the earlier patent No. 1,307,733.

In doing so the court said:

"It is plain that Gullborg invented improvements in two of the mechanical elements of an old combination consisting of grease gun, hose, hose-coupler, and a grease cup or pin fitting. First, he contrived an improved pin fitting. This he patented as such. (No. 1,307,733.) Secondly, he invented an improved form of coupler, * * * etc.

After referring to the subject matter of the other group of claims, the court then said that in claims 14 and 15 "he further claimed the combination between his patented pin fitting and any form of grease gun, whether that claimed in his patent or unpatented and old in the art." As stated by the court, the question was whether Gullborg might "in effect, re-patent the old combination by reclaiming it with the improved element substituted for the old element."

In so far as these claims 14 and 15 were concerned, the court answered the question by saying:

"We are of the opinion that the owner of the patents cannot extend the monopoly of its patent for a pin fitting" (i. e., patent No. 1,307,733) "to preclude the use therewith of any grease gun not embodying the improvement in the coupling device evidenced by the patent in suit."

It would seem quite clear, therefore, that the basis of this decision relative to these claims 14 and 15 was that

Gullborg's right to patent protection upon the pin fitting invention had been perfected in and by the earlier patent No. 1,307,733, and that the attempt to re-patent this one invention in a second patent resulted merely in invalid and therefore unenforceable claims. The logic of this part of the decision would mean, therefore, that even if the Rogers Company had sold lubricating apparatus comprising Gullborg's particular form of pin fitting in combination with a prior art type of grease gun and bayonet type coupler, still the plaintiff could not have held Rogers as a direct and complete infringer under claims 14 and 15. (Presumably the plaintiff could, in these circumstances, have held Rogers as a direct infringer of the earlier patent No. 1,307,733.) The reason would be that claims 14 and 15 involved a non-permissible attempt to re-patent the one invention which had already been patented in the earlier patent No. 1,307,733; in other words, that claims 14 and 15 were void for double patenting.

Miller v. Eagle, 151 U. S. 186; 38 L. Ed. 121.

Elishevitz & Sons Co. v. Bronston, 40 F. (2d) 434
(C. C. A. 2—1930).

Lion Fastener, Inc. v. Hookless Fastener Co., 72
F. (2d) 985 (C. C. A. 3—1934).

It was necessarily, of course, part of the court's factual finding in this connection that the construction and operation of the old style grease gun and bayonet coupler of claims 14 and 15 would be unchanged, regardless whether the compressor and coupler parts be used in conjunction with the old style fitting of the pin and slot type, or whether they be used in conjunction with the new pin fitting of Gullborg's invention. The matter was described by the court as "improving one element of an old combination whose construction and operation are otherwise unchanged".
(page 425).

Since the Rogers case under Claims 14 and 15 was decided upon the ground that these claims were invalid, it does not throw any light upon any question of contributory infringement.

In the Rogers Case, Claims 1-6 and 8 and 10 of the Gullborg Patent Did Not Involve a True and Enforceable Combination Because "the Construction and Operation" of the Compressor and Suction Effect Coupler Parts Were Unchanged By the Pin Fitting or the Form of Pin Fitting Associated Therewith.

It was the plaintiff's contention in the Rogers case that the defendant had infringed also claims 1 to 6 and 8 and 10 by selling certain fittings with the knowledge and expectation that the purchasers would use them in conjunction with grease guns and bayonet couplers sold by the plaintiff. As the court put it in its opinion:

"The petitioners did sell pin fittings of a type with which a grease gun of the description of Gullborg's could be used." (page 423)

In this connection it was said that "the petitioners' pin fittings are not of the type described in Gullborg's patent No. 1,307,733." (page 424) The court regarded the defendant's fitting as a "spring-closed fitting * * * for use in a pin and slot or bayonet type" combination embraced in the prior art. (page 424) Relative to the plaintiff's position in respect of these fittings sold by the defendant, the court said:

"The respondent says that as pin fittings made in accordance with the prior art but susceptible of use with a gun covered by the patent in suit were sold by petitioners, these sales constituted contributory infringements of all of the claims of the patent." (i. e. Nos. 1-6, and 8 and 10.)

These claims described by the inclusion of appropriate elements, the details of the so-called "suction effect" coupler.

After saying

"It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler, and grease cup or pin fitting"

the court went on to describe the second of Gullborg's improvements, saying:

"Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting."

But the court criticized the form of Gullborg's attempted patent protection by saying that

"Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler. (No. 1,307,734, the patent in suit; claims 1-6, 8 and 10.)"

With respect to these claims also the court said:

"The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation are otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element."

The court's answer to this question was in the negative. It is important to note, however, that the question which the court answered was whether it was possible to "repaint the old combination by reclaiming it with the improved element substituted for the old element" in a case where the "construction and operation of the old combination are otherwise unchanged." "Otherwise" takes account obviously of any changes which inhere in the new element itself.

We regard the part of the paragraph appearing at the top of page 425 of the official report as relating to the "repaintability" of the old combination with respect particularly to the old style fitting whose "construction and

operation" were said to be "unchanged" by their association with the concededly new and separably patentable suction effect coupler.

The court's conclusion in this regard was that the owner of the Gullborg patents "cannot extend the monopoly of the combination patent in suit to prevent the use of a pin fitting which does not infringe the fitting patent, 1,307,733, with a gun having a coupler such as that claimed in the patent in suit." (Claims 1-6 and 8 and 10 of 1,307,734.)

The reasoning of the court was plainly enough stated to be that all of the actions and coactions, i. e., the "construction and operation" of the pin fitting part of the complete combination of the prior art would be "unchanged" by the association of the old pin fitting with the new coupler instead of the old coupler of the art. As we regard it, this was simply a way of saying that because there was no new operation, no new coaction, no new function for the pin fitting part, there was no true combination in which the old style pin fitting could be properly and enforceably included. The decision passed, therefore, upon the form and enforceability of a certain type of claim in a situation where the "construction and operation" of one element was "unchanged" by its inclusion in the stated combination.

The language of the decision is that under the factual circumstances in this regard the old combination cannot be "repatented" by "reclaiming it with the improved element substituted for the old element."

The Law of Contributory Infringement Is Not Clarified by the Twelve Cases Cited in a Footnote to the Opinion in Rogers vs. Alemite.

The opinion goes on to say this, however:

"That this cannot be done is shown by numerous cases in this and other federal courts."

The index number 4 refers to a footnote listing the following twelve cases. These cases involve such widely disparate circumstances and were decided upon such widely variant grounds that it is difficult to apply them in support of the one rather clearly stated ground of the decision of the court in respect of claims 1-6 and 8 and 10 of the Gullborg patent involved in this case of *Rogers vs. Alemite*.

If these twelve cases were supposed to have been cited in support of any proposition stated in the opinion, it was in support of the proposition that one cannot "in effect, re-patent the old combination by reclaiming it with the improved element substituted for the old element" where the "construction and operation is otherwise unchanged." It will be found, however, that these cited cases were decided against the plaintiffs upon nine separate and distinct grounds, namely:

- (1) Double patenting: *Underwood v. Gerber*, 149 U. S. 224, 227, 229;
- (2) Lack of Invention: *Wall Pump & Compressor Co. v. Gardner Governor Co.*, 28 Fed. (2d) 334, 338, 339; *General Electric Co. v. Ohio Brass Co.*, 277 Fed. 917; *Troy Wagon Works Co. v. Ohio Trailer Co.*, 274 Fed. 612;
- (3) Anticipation by prior art: *Heald v. Rice*, 104 U. S. 737, 753; *Troy Wagon Works Co. v. Ohio Trailer Co.*, 274 Fed. 612;
- (4) That a reissue patent was for a different invention from that of the original patent; *Langan v. Warren Axe & Tool Co.*, 184 Fed. 720; *Heald v. Rice*, 104 U. S. 737, 753;
- (5) Non-infringement because defendant did not sell any part of the thing claimed in the patent in suit: *Harvey Hubbell, Inc. v. General Electric Co.*, 267 Fed. 564;
- (6) That the patentee and purchaser and user of the patentee's machine contemplated that the purchaser might

replace quickly perishable and periodically renewed parts or supplies: *Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co.*, 152 U. S. 425, 431, 432; *Wagner Type-writer Co. v. Webster Co.*, 144 Fed. 405, 409;

(7) That the defendant had been impliedly licensed by the patentee: *Edison Electric Light Co. v. Peninsular Light, P. & H. Co.*, 101 Fed. 831;

(8) That a patentee may not exact as the condition of a license, that unpatented materials used in connection with the invention shall be purchased only from the licensor: *Carbice Corporation v. American Patents Development Corporation*, 283 U. S. 27, 31, 32. (Upon a rehearing the patent in suit was held to be invalid because anticipated, 283 U. S. 420.)

(9) That it was a violation of the Clayton Act for the Radio Corporation to require its licensees to purchase radio tubes from it alone for inclusion in sets licensed under Radio Corporation circuit patents as initial equipment: *Radio Corporation v. Lord*, 28 Fed. (2d) 257.

It would seem clear from everything that is said in the opinion of the court in the Rogers case that the case was decided upon grounds other than that of contributory infringement,—the liability of a joint tort-feasor.

Everyone must concede that one thing at least is clear from the decision of the court in the Rogers case, namely, that it did not attempt to make any exception relative to the tort of patent infringement from the more general and widely recognized law applicable to joint tort-feasors. The tort of patent infringement was not exempted from the more general and widely applied principles.

It is clear that it was not intended to abolish the law relative to contributory infringement, because in referring to the cases of *Leeds & Catlin v. Victor*, 213 U. S. 301 and 325, the court did not say that the decision in *Leeds & Catlin*

Case was overruled. On the contrary, the court distinguished this case and by inference approved and affirmed it, saying:

"Leeds & C. Co. v. Victor Talking Mach. Co., 213 U. S. 301, 325, 53 L. Ed. 805, 815, 29 S. Ct. 495, on which the respondent relies, is not in point. There the patent was a pioneer patent and the combination was of elements which were novel and neither of which possessed utility without the other. Each element was necessary to the operation of the other. The invention did not, as here, consist of the mere improvement of one element of an old combination."

(Emphasis ours.)

We shall come later to a consideration of claim 2 of the Butler patent in respect of its describing a patentable combination as distinguished from an unpatentable aggregation. The District Court and the Court of Appeals have referred to the many reasons why claim 2 of the Butler patent is for a true and patentable combination in which all of the elements, including the headed nipple element, have quite markedly changed operations,—new actions, new coactions, new functions, because of their incorporation in the new combination.

For the purposes of our present discussion of the law of contributory infringement, we have asked the court to assume with us that the Butler patent is not of the Gullborg type in which the patentee "by improving one element of an old combination whose construction and operation are otherwise unchanged" sought to re patent the old combination by reclaiming it with the improved element substituted for the old element. Let us continue our assumption that the new cooperation, the new coactions, the new functions, of all of the elements of the Butler combination, are such as to have given Butler a validly patentable and enforceable claim.

Upon the basis of this assumption, let us examine into the other cases which counsel for the petitioner rely upon at page 58 of their brief.

A Brief History of the Restrictions and Attempted Monopolies in Well-Known and Staple Articles of Commerce Leading Up to the Decisions in the Carbice Case and in the Barber Asphalt Case.

The author of one of the notes at page 298 of the Harvard Law Review, Volume XXXI, No. 2, for December 1917, discusses particularly the then recent decision in the *Motion-Picture Patents Case*, 243 U. S. 502, 61 L. Ed. 871, and in leading up to his consideration of that case says:

"RIGHT OF A PATENTEE TO RESTRICT THE PRICE AND THE USE OF A PATENTED ARTICLE.—At common law any attempt to restrict the use or price of a chattel by notice to the purchaser or sub-purchaser was held void as contravening the public policy in favor of the free alienation of chattels.

"The Patent Act grants to the patentee the exclusive right to 'make, use, and vend' the article patented. It has been contended that this monopoly granted to the patentee takes the patented article out of the general common law rule, and that the exclusive right to use and to vend enables the patentee, indirectly, by a license arrangement to restrict the use and the price of his patented article by a mere notice attached thereto, and that any use or sale of the article in violation of the license constitutes an infringement of the patent. Since a suit for infringement of a patent right is a suit arising under the patent laws of the United States the federal courts have exclusive jurisdiction in these cases."

"Several decisions in the lower federal courts upheld this position as to price restrictions, and the United States Supreme Court in *Bement v. National Harrow Co.* (180 U. S. 70, 22 Sup. Ct. Rep. 747) seemed also to commit itself to this view. But that court definitely decided in *Bauer v. O'Donnell* (229 U. S. 1, 33 Sup. Ct. Rep. 616; affirmed, *Straus v. Victor Talking Machine Co.*, 37 Sup. Ct. Rep. 412) that the mere fact that an article is patented does not give to the patentee the right to restrict its price on resale.

"As to use two general types of restrictions have been submitted to the courts for consideration. The first is a restriction which regards the use of the patented article only. Such restrictions have been upheld

in the lower federal courts, and at least in one case by the Supreme Court. The second type is a restriction on the article primarily with reference to its use with non-patented accessories and seeks to confine its use to accessories specified by the patentee. This sort of restriction was first upheld in the lower federal courts in *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, (77 Fed. 288) which was followed by a long line of decisions in accord. (*Tubular Rivet and Stud Co. v. O'Brien*, 93 Fed. 200; *Cortelyou et al. v. Lowe*, 111 Fed. 1005; *Rupp and Wittgenfeld Co. v. Elliott*, 131 Fed. 730; *A. B. Dick Co. v. Milwaukee Specialty Co.*, 168 Fed. 930; *Crown Cork and Seal Co. v. Brooklyn Bottle Stopper Co.*, 172 Fed. 225). The rule of the Button-Fastener Case was affirmed by the Supreme Court in *Henry v. A. B. Dick & Co.* (224 U. S. 1, 32 Sup. Ct. Rep. 364). The same result has been reached by the English court under a similar statute. *Incandescent Gas Light Co. v. Cantelo*, 12 Pat. L. R. 262; *Incandescent Gas Light Co. v. Brogden*, 16 Pat. L. R. 179; but this decision has recently been overruled in *Motion-Picture Patents Co. v. Universal Film Manufacturing Co.*, (Advance Sheets, 37 Sup. Ct. 416), where the court refused to enforce a restriction imposed by the patentee on his patented motion-picture projecting machine to the effect that it should be used only with films of the patentee's manufacture."

In reaching certain conclusions relative to the policy of the law, the author refers first to the decision by the House of Lords in the case of *Nordenfelt v. Maxim-Nordenfelt Guns and Ammunition Co.*, [1894] A. C. 535, and says that

"The House of Lords, * * * realizing that a rule of law that depends on the balancing of two contrary policies cannot be settled adequately by a fixed and inelastic standard, formulated the principle that the test of the validity of a contract not to engage in a trade is whether or not it is necessary reasonably to protect the property rights of the promisee; and there are decisions in this country which in effect adopt this principle. 1 P. Wms. 181."

The author of the note then goes on to say:

"It is urged that the validity of restrictions on the use and price of chattels should be determined by the

principle of the Nordenfelt Case. Wherever such restrictions are necessary reasonably to protect the property rights of the vendor they should be allowed. But even under this test the Motion-Picture Case can be supported. There the vendor sought in his restriction not to protect his property rights in the patent under which he manufactured and sold the machine, but rather to stimulate his business in an independent and separate commodity."*

A Classification of the Contributory Infringement Cases and the Assertedly Contributory Infringement Cases Which Preceded the Decision in the Carbice Case.

Shortly after the decision of this court in the Carbice Case, Mr. Willis B. Rice, a lecturer on Patent Law at New York University School of Law, contributed an article entitled "The Tangle of Contributory Infringement in the Supreme Court" to the New York University Law Quarterly Review (Vol. 11, page 48, September, 1933).

We do not at all share Mr. Rice's views as to the real meaning or effect of the decision of this court in the Carbice Case. It bears internal evidence that it was decided upon a principle quite different from anything which Mr. Rice discovers or discusses.†

* Note the identity between this outstanding characteristic of the Motion-Picture Patents Case as stated by this author in the Harvard Law Review, with the principle which animated the Supreme Court in its subsequent decisions in the Carbice Case and in the case of *Leitch v. Barber*.

† His reasoning is in part based upon a definite misunderstanding of one of the facts of the Leeds & Catlin Case. Mr. Rice said:

"In the Leeds & Catlin Case the patent in suit was for the combination of a phonograph stylus and a disk record, the needle being free to be propelled over the record by the spiral character of sound groove of the record, in which it rested. This is the now common construction which makes it unnecessary to provide any other mechanism for feeding the needle laterally.

"The Victor Company, who owned that patent, made and sold machines embodying the freely movable stylus or needle and also made and sold records having the sound grooves with which the needle of such a machine could operate."

He then says of "this machine", as distinguished from the record, that it had been patented separately but that the patent had expired. This statement as to the expiration of a separate patent on the machine, at least if Mr. Rice means a machine having "a reproducing stylus . . . free to be vibrated and propelled by the" "record", is, we believe, an error.

His article does, however, present the historical background for the decision in the Carbice Case. In so doing it classifies the preceding cases in which contributory infringement was found and in which the plaintiffs asserted that contributory infringement was involved. We shall, therefore, quote briefly from Mr. Rice's article,—interpolating however only a few of the many citations contained in his footnotes.

"THE TANGLE OF CONTRIBUTORY INFRINGEMENT IN THE SUPREME COURT

Willis B. Rice

"A patent is intended to give an inventor a reward for his invention commensurate with its value to society by giving him a monopoly of it for seventeen years. It is assumed that the value of this monopoly will be measured by the public demand for the invention. There is, however, a very great difference between the theoretical monopoly intended to be given and the practical power of restraint which can be enforced, for no matter how great the inventor's contribution, the patent is of no value if the public may appropriate the invention and get its full benefits without payment to the patent-owner.

"If society is to maintain this system in good faith, it should provide not only a theoretical right of control but a practical means for enforcing that control, otherwise a patent is nothing more than a "will-o-the-wisp." Many inventions, as for example, those which are primarily made or used in large factories or units can be controlled by bringing a few suits against those large organizations which may start to infringe, but there are many inventions with which the task is not so easy.

"For example, the Boyce Motor meter comprised a small thermometer or heat indicator on the radiator cap of an automobile. It was protected by a patent drawn to the combination of the thermometer arranged in the radiator cap on

the car. The thermometer itself, apart from the car, was not and could not have been patented. In the strict sense, therefore, such a patent is not infringed until some individual bores a hole through the cap of his radiator and inserts the instrument. If the patent owner relied on the charge of direct infringement, he could bring suit only against the individual mechanic who installed such a thermometer or the individual car owner, on whose car it was installed.

"Such a doctrine would make it possible for a large company to manufacture devices made and intended especially to be inserted in radiator caps, and to instruct individual mechanics or individual automobile owners how to install them in violation of the patent. Such a company could compete on equal terms with the patent-owner who himself can do little more than that. It is practically impossible to bring a sufficient number of suits against individual owners to produce any appreciable effect. In a practical sense, the intended monopoly would not exist.

"It was in part to remedy such a situation that the courts created the doctrine of contributory infringement as an outgrowth of the common-law doctrine of joint tort-feasors, and it was well expressed in such a case as follows:

"Contributory infringement is "the intentional aiding of one person by another in the unlawful making or selling or using of the patented invention;" and this is usually done by making or selling a part of the patented invention with the intent and purpose of so aiding. The essence of contributory infringement lies in concerting or planning with others in an unlawful invasion of a patentee's rights."²

² *Goodyear v. Jackson*, 112 Fed. 146, 148 (C. C. A. 1st, 1901); see also *General Electric v. Sutter*, 186 Fed. 637, 638 (C. C. W. D. Pa. 1911): "The legal principles governing contributory infringement are clear. Contributory infringement exists where one knowingly concert[s] or acts with another in an unlawful invasion of a patentee's rights. If such assistance is given by furnishing an essential part of an infringing combination and the part furnished is adapted to no other than an infringing use, such contribution makes him a contributory infringer. On the other hand, if the part furnished is adapted to other and lawful uses, in addition to infringing uses, then an intent to furnish for infringing use must be established before the furnisher can be held a contributory infringer."

"Under such a rule the patent owner is permitted to prevent the deliberate manufacture of devices intended solely for infringement or to shut off the source of special materials or the special apparatus which the ultimate infringer requires in making the infringement. He may thus indirectly stop the infringement which he cannot directly prevent, and yet in general, he will be able to control only that business which the patented invention has created.

"This doctrine has been so thoroughly accepted by the bar and by the courts that cases which depended upon it have been decided without serious challenge upon this issue, and many important patents have been enforced through it, which otherwise would have been without practical remedy.

"The Supreme Court's opinion in the first *Carbice* case now leaves this matter in grave uncertainty. It denies relief in what is apparently so typical a case of contributory infringement that it leads Mr. Alfred McCormack to say
 " * * * if the Dryice Corporation had no right to be free from competition in the sale of carbon dioxide, then the law of contributory infringement is abolished," and yet the Court evidently, as Mr. McCormack recognizes, did not intend to abolish it. If it is an abolishment or even a modification of the doctrine of contributory infringement, it is apparently so serious an alteration as to involve readjustment of the patent law.

"Apparently, also, grave modifications of the responsibility of tort-feasors in other fields may be necessary for the Court's statement, that 'relief is denied because the plaintiff is seeking a monopoly not in the patented article, but in an unpatented material' gives a reason for denying relief which transcends the patent law altogether.

"This same patent was declared void on rehearing but

* McCormack, *Restrictive Patent Licenses and Restraint of Trade* (1931)
 31 Col. L. Rev. 773.

the second opinion does not correct or alter any of the statements of the first.

“The cases prior to the *Carbice* case may be classified under the following headings which are intended to express the doctrines which each has been considered to represent:

“I. The general selling of ordinary materials and supplies to a party does not make the seller liable for any patent infringement of which that party may be guilty, even if the seller knows of it, unless there is a very intimate relation between the material or article furnished and the actual infringement.

“II. The sale by a patent-owner of a device having as a part of the patented combination a transient element or one requiring frequent replacement or repair to keep the device in condition for use, implies the right to make that necessary replacement or repair, even though this involves the combining of the elements which constitute the patented combination. It is probably assumed that the purchase of the device carried with it the right to keep it in condition for use for its intended purpose, in order that the purchaser may get that for which he paid. This license to repair is a license from the patent-owner implied from the very nature of the original sale. (Citing and discussing *Heyer v. Duplicator Co.*, 263 U. S. 100, 44 Sup. Ct. 31 (1923); *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425, 14 S. Ct. 627 (1894).)

“III. A person who furnishes a critical part or a critical material or a critical apparatus for the unlawful making or remaking of the invention with knowledge and intention that it is to be used by another in making an infringing device is guilty of contributory infringement if it is in fact

so used.¹⁶ Thus, in the case of *Symington v. The National Castings Company*, the Castings Company was making certain special castings which were used by a third party to make car couplings which infringed the plaintiff's patent. These castings were made for the express purpose of being used in the patented coupling and the court sustained the charge of infringement. The decision of this case in the Supreme Court does not discuss the question of contributory infringement but this issue was raised in the lower court.¹⁷

"IV. The validity of license restrictions was sustained generally in the *Bement* case,¹⁸ provided in any particular case that the restrictions are not contrary to law, and a breach of such contract by violating the conditions will support an action in a state court for breach of contract. As decided in *Henry v. Dick*,¹⁹ however, the licensor may elect to treat any act of the licensee in excess of his license, and this includes any act in violation of a valid restriction, as an unlicensed act and hence as an infringement. The reasoning of the *Bement* case was criticized and the *Henry v. Dick* case was overruled in the *Motion Picture Patents* case,²⁰ but only as to the validity of certain types of restrictions and not on the particular doctrines here stated.²¹

"Ordinarily in a contract, if an important condition is void, the entire contract may be declared void, but a dif-

¹⁶ *Symington v. National Castings*, *supra* note 8; *Leeds and Catlin v. Victor*, 213 U. S. 325, 29 Sup. Ct. 503 (1909); *Union Tool Co. v. Wilson; Field v. De Gomeau; Geneva Furn. v. Karpen*, all *supra* note 11; *Cotton Tie v. Simmons*, 106 U. S. 89, 1 Sup. Ct. 52 (1882).

¹⁷ *National Castings v. Symington*, 234 Fed. 343 (C. C. A. 1st, 1916).

¹⁸ *Bement v. National Harrow*, 186 U. S. 70, 22 Sup. Ct. 747 (1902).

¹⁹ 224 U. S. 1, 82 Sup. Ct. 384 (1912).

²⁰ *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U. S. 502, 37 Sup. Ct. 416 (1917).

²¹ See *Healy v. Sea Gull Specialty Co.*, 237 U. S. 479, 35 Sup. Ct. 658 (1915); *Luckett v. Delpark*, 270 U. S. 496, 46 Sup. Ct. 897 (1926); *DeForest v. United States*, 273 U. S. 236, 47 Sup. Ct. 388 (1927).

ferent situation arises as to license restrictions. If a licensor violates a license condition which the court believes void, a holding that the license is thereby cancelled, would in effect enforce the very restriction of which the Court disapproved. In such case, therefore, the license must be sustained as though the restriction had not been imposed; if the disapproval of the restriction is to be effective.

"Cases of this kind have formed an important part of the doctrine of contributory infringement because of the extent to which patent-owners endeavored to employ the license restrictions to exploit their inventions and because of the open and extensive manner in which third parties endeavored to profit from the violation of these restrictions. In such cases, the actions of the third party have been frequently intentional and flagrant, so that the third party who was the defendant could not with good grace plead that he was not responsible for the acts committed, but rather tacitly admitting his responsibility, claim justification on the ground that the acts complained of were lawful. Such cases, therefore, have turned upon the validity of the license restrictions.

"This subject of what license restrictions may be imposed is in itself a large one and it is not within the scope of this study. But the *Carbice* case does not turn upon the validity of license restrictions, and we need not go into it here except as to those particular license restrictions referred to by the Court.

"V. When a patented article is sold with a license to resell it, containing a license restriction to limit the price at which the purchaser may resell, the restriction is void and the purchaser is free to resell it for his own price, notwithstanding the restriction. The rule holds regardless of the form which the agreement takes.

• • • • •

"VI. Where a device is sold which itself constitutes the patented article and the sale is accompanied by a license containing restrictions purporting to limit the use of the patented device to a use with supplies or materials purchased from the licensor, the object being to use the patented device to create a partial monopoly in unpatented materials which do not form part of the combination but which are used with it, the restrictions are held to be void and the sale a complete sale free from those restrictions.

"A typical case of this kind is the *Motion Picture Patents* case.²³ In that case the patent concerned a step by step film feeding mechanism for feeding motion picture films through the projecting machine. This feeding mechanism was claimed in the patent as such, and not as a combination between the mechanism and the film. The machines involved in the suit had been made under a license containing restrictions, and were sold bearing the 'restriction and limitation' among others that the machine could be used only with films leased from a 'licensee of the licensor.'

* * * * *

"There was apparently no patent on the combination of the feeding mechanism and the film, and, the patent on the film had expired.

"From the foregoing, it will be clear that the invention was completely embodied in the machine already made and sold by authority of the patent-owners and the patent-owners had at least a chance to obtain their profit upon it. The right asserted by the plaintiff was based upon the validity of this license restriction imposed upon the machine to limit its use in the hands of the purchaser."

Now with this sketch of the historical background as

²³ *Supra* note 20, overruling on this point, *Henry v. Dick*, *supra* note 19. See also *Cortelyou v. Johnson*, 207 U. S. 196, 28 Sup. Ct. 100 (1907) (decided for insufficient notice to defendant of the intended license restriction).

written by Mr. Rice in his Law Review article, we shall turn to the decision of the Court in the *Carbice* case (*Carbice Corporation of America v. American Patents Development Corporation and Dry Ice Corporation of America*, 283 U. S. 420, 51 Sup. Ct. 496).

What Were the Grounds of the Decision in the Carbice Case.

In denying relief to the plaintiff, His Honor Judge Campbell in the District Court put his decision, 25, F. (2d) 730, upon two grounds which could be aligned with authoritative decisions in earlier cases. His first ground is to be gathered from the language in which he said:

"Plaintiff contends that the thing claimed is a package, goods baled, boxed, or otherwise enclosed for transportation, * * *. Defendant contends that the patent is for a container."

"In my opinion the defendant is correct, and no infringement was shown, because at most defendant could only be a contributory infringer, and to sustain such a charge, it would have been necessary to show that defendant contributed materials going into the construction of the container, and such charge would not be sustained by showing that commodities were used in the container." (emphasis ours.)

There is considerable support for this view, since in none of the claims in suit (2, 3, 4, 6, 7 and 9) was the frozen carbon dioxid included positively as an element of the combination.

The second ground upon which Judge Campbell placed his decision was that

"Even if it be held that the patent in suit is for a combination, one element of which is solid carbon dioxid, the defendant did not infringe the patent in suit by furnishing the solid carbon dioxid, as that was a perishable product, consumed in the operation, and the patentee has not patented and could not patent solid carbon dioxid. *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425, 14 S. Ct. 627, 38 L. Ed. 500."

In view of the grounds of the subsequent decision by the Supreme Court, the most striking feature of Judge Campbell's opinion is the fact that he went out of the way of the grounds upon which he formally based his decision to stress this:

"Plaintiff does not make nor sell, nor has it licensed anyone to make, the refrigerating apparatus claimed in the patent in suit. All that plaintiff or defendant does is to manufacture and sell solid or frozen carbon dioxid, the chemical symbol of which is CO₂."

We should like now to quote from the opinion of Mr. Justice Brandeis to show what were the stated grounds of the decision by the Supreme Court. In so doing, we shall take advantage of the opportunity to contrast the facts of the instant suit. Each of the following numbered paragraphs is quoted from the opinion of the Supreme Court beginning on page 29 of 283 U. S.

1. "The sole business of the Dry Ice Corporation" (one of the plaintiffs) "is the manufacture of solid carbon dioxid which it sells under the name of 'Dry Ice'."

In so far as the Butler patent in suit is concerned, the sole business of the Stewart-Warner Corporation is the manufacture and sale of the lubricating apparatus described and claimed in the Butler patent in suit. (The Stewart-Warner Corporation does sell lubricating oil and grease but it has never attempted or even suggested that purchasers of its oil or grease should thereby acquire any license under the patent in suit.) It has never attempted to require that the purchasers of any lubricating apparatus under the Butler patent in suit or under any other patent should purchase the plaintiff's lubricants for use therein.

2. "It (the plaintiff, Dry Ice Corporation) does not make or sell transportation packages in which solid carbon dioxid is used as a refrigerant."

The plaintiff, Stewart-Warner Corporation, does make

and sell all of the parts of the complete lubricating apparatus described and claimed in the Butler patent in suit.

3. "It" (the plaintiff, Dry Ice Corporation) "does not issue to other concerns licenses to make such packages upon payment of a stipulated royalty."

The record herein shows that the Stewart-Warner Corporation has granted just such a license to the Cincinnati Ball Crank Co. (R. p. 37).

4. "Each invoice" (of the plaintiff, Dry Ice Corporation) "for solid dioxid sold by it bears this notice: 'The merchandise herein described is shipped upon the following condition: That DryIce shall not be used except in DryIce Cabinets or other containers or apparatus provided or approved by the Dry Ice Corporation of America;'" etc.

The Stewart-Warner Corporation has never sold or shipped any of its lubricants or any of its lubricating apparatus upon any such condition or upon any condition whatsoever,—except, of course, conditions as to time and terms of payment, etc.

5. The opinion of the Supreme Court points to and quotes the following condition, namely:

"that DryIce Cabinets or other containers or apparatus provided or approved by the Dry Ice Corporation of America shall be refrigerated or used only with Dry-Ice. These uses of DryIce are fully covered by our Basic Method and Apparatus Patent No. 1,511,306, granted October 14, 1924, and other Patents Pending."

The plaintiff, Stewart-Warner Corporation, never sold any of its lubricating apparatus upon the condition that it should be supplied with or used only in conjunction with oil and grease furnished by Stewart-Warner Corporation nor under any other limitation or restriction as to supplies or repairs of any kind whatsoever.

6. "The Dry Ice Corporation extends to each of its customers, buyers of solid carbon dioxid, a license to use the invention without the payment of royalty."

Neither in the sales of its oil or grease nor otherwise has the Stewart-Warner Corporation ever extended to any of its customers a license to use the invention of the Butler patent or of any of its patents without the payment of royalty.

7. "The Carbice Corporation challenges the validity of the patent and denies infringement. Whether the transportation package described is a patentable invention we need not determine. For, even if it is, no relief can be granted."

If the claims of the Slate patent in suit were valid combination claims and included solid carbon dioxid as an element, and if the defendant sold that element with the requisite knowledge and intent, there would be what ordinarily was called an infringement. It is to be noted that the court did not say: "Even if the transportation package described is a patentable invention, *there has been no infringement.*"

What the court did say was that "***no relief can be granted.***" We regard this expression as significant of the fact that the decision of the court was put upon grounds other than those of patent validity or patent infringement. There is much more in support of the same understanding.

As we have seen, and as we shall see, none of the grounds upon which the court said that "***no relief can be granted***" in the Carbice Case can be found in the facts of the instant case.

8. After enumerating many of the patentee's rights, the court said:

"But it" (the plaintiff, Dry Ice Corporation) "may not exact as the condition of a license that unpatented materials used in connection with the invention shall be purchased only from the licensor."

The Stewart-Warner Corporation has never exacted as a condition of any license that grease or other unpatented materials used in connection with its Butler invention or any other invention shall be purchased only from the licensor.

9. The opinion of the court went on to say:

"If it does so, relief against one who supplies such unpatented materials will be denied."

Now let us see what was said in the footnote indexed at this point.

(a) It was pointed out that

"In England the insertion of such a requirement in any license agreement is a complete defense to any defendant charged with infringement." (Citing statutes and cases.)

(b) It was pointed out that

"The need for such legislative measures to prevent the abuse of the patent monopoly has now been recognized by the International Convention for the Protection of Industrial Property." Citing authorities.

(c) It was pointed out that

"In this country the patent statutes similarly provide that an unreasonable delay in formally disavowing patent claims held invalid, and the consequent maintenance of a broader monopoly than warranted, is a complete defense to all infringers, even as to remaining valid claims." (Citing statute and cases.)

This meant that even in the case of infringement of valid claims, relief was to be denied because of the inequity of the patentee in attempting to assert a broader monopoly than was warranted.

Here again the statement that "relief will be denied" was not based upon any contention that the patent in and of itself was invalid or that the defendant had not infringed, but rather upon grounds of broad public policy in view of the inequitable conduct of the patentee.

10. In its opinion the court said:

"The relief here sought is indistinguishable from that denied in the Motion Picture Patents Co. Case. There, it was held that to permit the patent owner to 'derive its profit, not from the invention on which the law gives it a monopoly but from the unpatented supplies with which it is used,' is 'wholly without the scope of the patent monopoly'."

The claims of the patent involved in the Motion Picture Patents Case did not even pretend to include the film as an element of any combination or other claim. In the Motion Picture Patents Case, therefore, relief was denied,—not because of the invalidity of the patent, not because of any direct determination of any question of infringement or non-infringement, but solely upon the ground that the owner of the patent in and by its "license notice" had attempted to make such an inequitable use of its patent as to have forfeited any right to such equitable relief as had theretofore been granted, as, for example, in the case of *Henry v. Dick*, 224 U. S. 1, 56 L. ed. 645, 32 Sup. Ct. Rep. 364.

Some fragments of the opinion in the Motion Picture Patents Case are illuminative of its *raison d'être*.

Thus, for example:

"Plainly this language of the statute and the established rules to which we have referred restrict the patent granted on a machine, such as we have in this case, to the mechanism described in the patent as necessary to produce the described results. It is not concerned with and has nothing to do with the materials with which or on which the machine operates.

"The restrictions of the law relate to the useful and novel features of the machine which are described in the claims of the patent; they have nothing to do with the materials used in the operation of the machine.

"Whatever right the owner may have to control by restriction the materials to be used in operating the machine, must be derived through the general law

from the ownership of the property in the machine, and it cannot be derived from or protected by the patent law.

"A most persuasive expression of the public policy of our country with respect to the question before us.

"Such a restriction is invalid because such a film is obviously not any part of the invention of the patent in suit; because it is an attempt, without statutory warrant, to continue the patent monopoly in this particular character of film after it has expired, and because to enforce it would be to create a monopoly in the manufacture and use of moving picture films, wholly outside of the patent in suit and of the patent law as we have interpreted it."

It is evident that in the Motion Picture Patents Case, relief was denied upon rather broad principles of equity and public policy. It was these grounds which were, therefore, invoked in support of the decision in the Carbice Case.

The respondent, Stewart-Warner Corporation, has not attempted to perpetrate any restraints or restrictions of the kind which were condemned in the Carbice Case or in its so designated prototype, the Motion Picture Patents Case.

11. Referring further to the Motion Picture Patents Case, the court said in its opinion in the Carbice Case that

"If a monopoly could be so expanded, the owner of a patent for a product might conceivably monopolize the commerce in a large part of unpatented materials used in its manufacture."

Unpatented materials as here used refers directly to the fifty-year old commodity, solid carbon dioxid, and indirectly, the old and well-known commodity, motion picture film, upon which the patent had long since expired.

If the Stewart-Warner Corporation were to attempt to use its patent in such a way as measurably to monopolize the commerce in grease, it would run counter to such considera-

tions of public policy and of equitable principles as were here under discussion.

12. "The owner of a patent for a machine might thereby secure a partial monopoly on the unpatented supplies consumed in its operation."

The Stewart-Warner Corporation has never attempted to use any patent in such a way as to secure a partial monopoly on the grease consumed in the operation of its lubricating apparatus.

13. "The owner of a patent for a process might secure a partial monopoly on the unpatented material employed in it."

That is precisely what was subsequently attempted by the Barber Company. The attempt was frustrated by the decision of this court in *Leitch v. Barber*, 82 L. Ed. 276.

The Stewart-Warner Corporation has never made any such attempt.

14. In its opinion in the Carbice Case the court said that

"The owner of the patent in suit might conceivably secure a limited monopoly for the supplying not only of solid carbon dioxide, but also of the ice cream and other foods, as well as of the cartons in which they are shipped."

This suggests a comparable situation in which the respondent in the instant case might attempt to secure a limited monopoly upon the machines whose bearings were greased by the use of the apparatus of the patent in suit. Nothing of the kind has ever been attempted or suggested.

15. The court said in the Carbice Case that

"The attempt to limit the licensee to the use of unpatented materials purchased from the licensor is comparable to the attempt of a patentee to fix the price at which the patented article may be resold."

Obviously, the question of public policy and equity in-

volved in the matter of price fixing was far remote from anything contained in or reasonably deducible from the patent laws.

The Stewart-Warner Corporation has never attempted to fix the price at which its lubricating apparatus may be resold nor to do anything comparable therewith.

16. In its opinion in the Carbice Case the court said:

"In both classes of cases, (*i. e.*, those in which the patentees had attempted to place restrictions upon the use of the patented machines sold by them and those in which the patentees had attempted to fix the resale price of their patented articles) courts deny relief against those who disregard the limitations sought to be imposed by the patentee beyond the legitimate scope of its monopoly."

The most illuminating phase of the statement is perhaps the footnote comments in which it is pointed out that

"The patent grant is inherently limited in other respects."

Thus, for example,

"A patent covering an essential instrumentality does not enable a patentee or its licensee thereby to abridge its obligations as a public utility. * * * Nor does the grant of a United States patent exempt the patented product from limitations imposed by state police statutes. * * * Nor can a patent be made the basis of an unconscionable contract."

These illustrations all relate to matters of common equity or public policy quite outside the range of any patent questions of validity, infringement, etc. They aid in making it clear that the basis of the decision in the Carbice Case was the use or perhaps rather the misuse which the patent owner had attempted to make of its alleged patent rights. Its business was simply the sale of an old and staple commodity. It attempted to enhance the profits of its purely merchandising business by wielding the club of a patent which in reality related to quite another thing.

The respondent, Stewart-Warner Corporation, has attempted to use its patent simply in protecting itself against competition in the manufacture and sale of the very thing which is described and claimed in its patent.

The inapplicability of the real grounds of the decision in the Carbice Case to the facts of the instant case is further emphasized by the distinctions which the opinion in the Carbice Case makes with respect to the Leeds & Catlin Case.

17. The court says of the latter:

"That was an ordinary case of contributory infringement."

So is this.

18. In its opinion in the Carbice Case the court said:

"The Victor Company sold machines embodying a patent for a combination."

So does the Stewart-Warner Corporation.

19. In the Carbice Case the court said:

"Leeds & Catlin were held to be infringers because the intended incorporation in the Victor machines of the article which they sold, did not constitute a repair of the machine and hence was not within the license implied on sale."

There is no contention and could be no successful contention that the headed nipples sold by the Lincoln Engineering Company constitute any "repair of the machine" sold by the Stewart-Warner Corporation.

20. In the Carbice Case the court said:

"There was no suggestion that the Victor Company, which itself manufactured and sold the patented product, sought 'to derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies with which it is used.' "

Similarly, there can be and is no suggestion that the Stewart-Warner Corporation, which itself manufactures

and sells the patented product, seeks to derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies as, for example, the grease with which it is used.

21. In the Carbice Case the court said:

"In the case at bar the plaintiffs neither sell nor license others to sell complete transportation packages."

In the instant case the respondent, Stewart-Warner Corporation, both sells and licenses others to sell complete lubricating apparatus embodying the invention of the Butler patent in suit.

22. In its opinion in the Carbice Case the court said that

"They" (the plaintiffs, American Co. and Dry Ice Corp.) "supply merely one of the several materials entering into the combination."

They merely merchandised an old and well-known commodity, carbon dioxid. In the present case the business of the plaintiff-respondent is to manufacture and sell the whole of the apparatus described and claimed in the patent in suit.

23. In the Carbice Case the court went on to say that

"On that commodity they" (the plaintiffs) "have not been granted a monopoly. Their attempt to secure one cannot be sanctioned."

These phrases would be applicable to the Stewart-Warner Corporation, if it had attempted to secure a monopoly or a partial monopoly on the commodity known as grease. Nothing of the kind has ever been attempted or thought of. The Stewart-Warner Corporation's concern is solely with the protection of the patent laws in the manufacture and sale of the highly specialized combination of elements constituting the subject matter of the patent in suit.

Here again, in this last sentence of the court's opinion in

the Carbice Case, there is a footnote which high-lights the real basis of the decision. It is said that

"Restrictions on the manner of use, essential to prevent unwarranted extension, are inherent in other limited monopolies."

The manner of use!

"The manner of use" in the Carbice Case refers, of course, to the use which was attempted to be made of the patent. The patent was attempted to be used through license restrictions and through the business policy of granting immunity from liabilities for patent infringement to all who would buy the old and well-known carbon dioxid from the Dry Ice merchandising company. The trouble with the Dry Ice Company was that it was not attempting to enjoy and to enforce its patent rights; it was attempting to merchandise an old and staple commodity by wielding a patent club in such a way as to enhance its profits as a commodity merchant.

When, therefore, the court pointed to restrictions on the manner of use of other limited monopolies, it was saying, in effect, that rules of public policy and of equity would be made to supersede the laws of patents whenever the patentee foreswore his more strictly patent rights and sought to make them an ostensible cover for socially indefensible depredations.

The cited instances in which public policy and equitable principles stepped in to estop a plaintiff from the enjoyment of his monopolistic rights because of his misconduct in connection with those rights, were as follows:

"a. A trade mark may not be used as a means of misrepresentation."

"b. Nor a trade name as a means of deception."

We have in the foregoing discussion quoted very considerable parts of the opinion of the court in the Carbice

Case. We have been careful not to omit reference to any point or consideration upon which the conclusion of the court was based.

The striking fact is that from beginning to end the court laid completely aside all considerations of patent validity. It laid completely aside all questions of patent infringement, either direct or contributory.

From beginning to end the opinion deals with the use, or rather the misuse, which the plaintiffs attempted to make of what under other circumstances would have been their patent rights. The opinion makes it clear beyond peradventure that "relief was denied" because the conduct of the plaintiffs was not compatible with broad principles of equity,—because the misuse which the plaintiffs sought to make of their patent rights was contrary to public policy.

Not one of the stated considerations for denying relief in the Carbice Case finds any applicability to any of the facts in the instant case.

Although many courts and many lawyers have expressed widely different views as to the real philosophy of the decision of this Court in the Carbice case, we have been glad to find that we are not alone in our understanding of it. The brief filed on behalf of the petitioner in the more recent case of *Leitch v. Barber*, 82 L. Ed. 276, shows that counsel for the petitioner in that case have the same understanding as do we of the real grounds of the decision in the Carbice Case. It seems to us that those grounds are made quite plainly clear in and by the opinion of the Court by Mr. Justice Brandeis. We put the matter in this way nevertheless, because we are aware, as doubtless the Court is aware, that there are many courts and many counselors who apparently have not understood the grounds of the decision in the Carbice Case, at least as we understand them and as counsel for the petitioner in the Leitch Case understand them.

Under the circumstances, we are taking the liberty of quoting *in extenso* from the brief of counsel for the petitioner in the Leitch *vs.* Barber case. This brief fairly bristles with expressions in confirmation of our understanding of the Carbice Case. We are quoting from the brief of counsel for the petitioner in the Leitch Case without adding to or changing any of their typographical emphasis. Let us therefore stress in advance such phrases as these, which appear in the argument of counsel for Leitch:

"The clearly expressed principle of law" (in the Dry Ice Case) "namely, that contributory infringement does not lie where the primary intent or *purpose* of the plaintiff in bringing the infringement action, as deduced from his acts, is to secure to himself a limited monopoly in an unpatentable material."

"Such an *intent* may be inferred when," etc.

"Its repeated emphasis on these factors in the Dry Ice Case."

"Accordingly, the doctrine of contributory infringement, which is an equitable doctrine originated by the courts to do equity in the appropriate cases, readily lends itself to abuses."

"This Court will not permit the distortion of an equitable principle into an instrument of inequity."

"Nothing in the *Dry Ice Case* can properly be construed to mean that the sale of unpatentable material will not be enjoined where the *sole purpose* is to stop an infringement of a patent which the plaintiff is practicing and from which he derives his profit. And it is respectfully urged that this distinction be repeated in the present case," i. e., in the Leitch Case.

"This Court was clearly saying that the issue is not in the patentability or unpatentability of the material."

"The issue of contributory infringement depends on whether, from the actual business of the plaintiff and the source from which it derives its profit, it is reasonable to infer that the primary object of the plaintiff is to set up an unlawful monopoly on the unpatented material."

"Under such circumstances, no tort has been committed which justifies granting equitable relief."

"When, however, the charge is contributory infringe-

ment, it becomes important to examine whether the Plaintiff is really seeking to prevent such a tort or is instead using the patent as a color of legality for securing a monopoly in unpatentable materials."

"In determining whether contributory infringement lies, the purpose and intent of the plaintiff asking for injunctive relief deducible from the facts may be investigated by the Court."

"There is nothing in such a holding which in any way limits the well-established doctrine of contributory infringement in cases where the Plaintiff's primary and only purpose, deducible from the facts concerning the nature of his business, is to stop actual interference with his granted patent monopoly, even where he seeks to stop the sale of unpatentable materials. In such cases, no doubt, an equity court would be justified in granting injunctive relief."

The Correct Interpretation and Application of the Decision of This Court in the Dry Ice Case as Expressed by Counsel for the Petitioner in Their Brief in the Case of Leitch vs. Barber.

The following paragraphs are quoted (without change in or addition of emphasis) from the brief of counsel for the petitioner in the case of *Leitch v. Barber*, 82 L. Ed. 276:

"The Issue:

"These facts raise the following issue:

"May a patent be employed for the primary, obvious and frank purpose of securing a limited monopoly in an unpatentable material?

"The answer to this was clearly given by this Court in the *Dry Ice case* (283 U. S. 27) but has been misconstrued by many of the patent profession and by the Courts.

"The present case affords an opportunity to stop further misconstruction by reaffirming the clearly expressed principle of law, namely, that contributory infringement does not lie where the primary intent or purpose of the Plaintiff in bringing the infringement

action, as deduced from his acts, is to secure to himself a limited monopoly in an unpatentable material.

"Such an *intent* may be inferred when:

- (1) the Plaintiff's business is primarily in the sale of the unpatentable material, and
- (2) the Plaintiff derives all or substantially all its profit from such sale.

"It would seem that this was made unquestionably clear by this Court in its repeated emphasis on these factors in the *Dry Ice* case where it called attention to the fact that:

- 1) "The sole business of the Dry Ice Corporation is the manufacture of solid carbon dioxide . . . (p. 29);
- 2) "It (the Dry Ice Corporation) does not make or sell transportation packages . . . (p. 30);
- 3) "The Carbice Corporation also manufactures solid carbon dioxide" (p. 30);
- 4) "In the case at bar the plaintiffs *neither sell* nor license others to sell complete transportation packages. They supply merely one of the several materials entering into the combination; *and on that commodity they have not been granted a monopoly*. Their attempt to secure one cannot be sanctioned" (p. 34);
- 5) "The Dry Ice Corporation has no right to be free from competition in the *sale* of solid carbon dioxide" (p. 33);
- 6) "Relief is denied because the Dry Ice Corporation is *attempting*, without sanction of law, to employ the patent to *secure a limited monopoly* of unpatented material used in applying the invention" (pp. 33, 34).

"To Petitioner, these statements culled from that decision clearly indicate that in a suit for contributory infringement as distinguished from an ordinary infringement suit, the Court may properly inquire into the business of the Plaintiff to determine the actual relief he is seeking.

"Is it really to secure to the patentee the undisturbed enjoyment of his actually granted patent monopoly or is it primarily to secure some other monopoly not granted him by the patent?

"Such an inquiry is proper because in contributory infringement relief is usually sought, not for the thing patented, but for an unpatentable part thereof which a third party will use in accordance with the patent. Accordingly, the doctrine of contributory infringement which is an equitable doctrine originated by the Courts to do equity in the proper cases, readily lends itself to abuses.

"The *Dry Ice* case merely reaffirmed an obviously sound principle of law, namely, that where the Plaintiff's *intent* in bringing the action, clearly deducible from the Plaintiff's and Defendant's business is to extend his monopoly to unpatentable supplies, no such grant will be given. In other words, this Court will not permit the distortion of an equitable principle into an instrument of inequity.

"Nothing in the *Dry Ice* case can properly be construed to mean that the sale of unpatentable material will not be enjoined where the *sole purpose* is to stop an infringement of a patent *which the Plaintiff is practicing* and from which he derives his profit. And it is respectfully urged that this distinction be repeated in the present case as was done in the *Dry Ice* case when this Court said in distinguishing from the *Leeds & Catlin v. Victor Talking Machine Co.* case, 213 U. S. 325:

"That was an ordinary case of contributory infringement. The Victor Company *sold* machines embodying a patent for a combination. • • •

There was no suggestion that the Victor Company, *which itself manufactured and sold* the patented product, sought '*to derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies with which it is used.*' " (p. 34).

"It would seem to the present Defendant that this Court was clearly saying the issue is not in the patentability or unpatentability of the material. In fact, this Court in the *Dry Ice* case rejected such specious distinctions in comparing the *Dry Ice* case with the *Victor* case, *supra*. Rather, as appears from the *Dry Ice* case, the issue of contributory infringement depends on whether, from the actual business of the Plaintiff and the source from which it derives its profit, it is reasonable to infer that the primary object of the

Plaintiff is to set up an unlawful monopoly on the unpatented material, thereby obtaining larger financial returns than is obtainable from a mere enforcement of the actual patent grant. Obviously, under such circumstances, no tort has been committed which justifies granting equitable relief.

"This Court in refusing to be diverted from the true issue in the *Dry Ice* case by subtle differences over cases such as the *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U. S. 425, where no contributory infringement was found because of the "passivity" of the paper with respect to the combination of paper and a dispensing mechanism said:

"These distinctions are without legal significance. Infringement, whether direct or contributory, is essentially a tort and implies invasion of some right of the patentee" (p. 33).

"Now, that invasion is clear and unequivocal when a charge of direct infringement is involved. When, however, the charge is contributory infringement, it becomes important to examine whether the Plaintiff is really seeking to prevent such a tort or is instead using the patent as a color of legality for securing a monopoly in unpatentable materials. And that is determined by the Plaintiff's own business.

"The sociological dangers involved in any different application of the doctrine of contributory infringement are manifest in the particularly flagrant character of the present case.

"Thus we have a process patent in which the invention, according to the Circuit Court of Appeals, resides not in the process *per se* but in using the process for roadways and we have a Plaintiff who would use such a patent to hamper its competitor and thereby prevent him from selling *any* asphalt emulsion to road contractors, although both Plaintiff and Defendant had been carrying on such sale for years before the present patent was filed.

"That the proposed injunction will have this effect will be evident from the following:

"The Leitch Company has been selling asphalt emulsion in large drums to road contractors for many years before the present patent was filed. Even now only

about 5% of the sold product is used by the road contractors in carrying out the patented process, the remainder being used for road repair, construction, etc. Inasmuch as the Leitch Company or any manufacturer of asphalt knows of the likelihood that a road contractor may use some asphalt emulsion in accordance with the patented process, he would always have the heavy responsibility that some subordinate might sell emulsion with knowledge of infringement. Accordingly, to avoid the risk of being brought up for contempt of court, the Leitch Company would necessarily have to stop selling *any* asphalt to road contractors, although this has been its business for many years.

"Thus a patent probably invalid for new matter, and in view of prior art, becomes a means for creating a substantial monopoly in the sale of an old asphalt emulsion. It is much more flagrant than the *Henry v. A. B. Dick Co.*, case, 224 U. S. 1, or the *Motion Picture Patents Co. v. Universal Film Mfg. Co.* case, 243 U. S. 502, 515, where conditional sales requiring purchase of unpatentable supplies with the purchased machine were held by the Court to be contrary to public policy and the Clayton Act. In those cases the limited monopoly sought, while in principle as bad as in the present case, was at least restricted to a sale of unpatentable supplies to purchasers of machines. In the *Dry Ice* case, this attempt at an illegal monopoly was "inched" a little further to cover Dry Ice sold to *anyone* but still limited to those who used it in a patented container. In the present case all restraint is thrown aside and the Plaintiff for all practical purposes is asking for a monopoly in the sale of asphalt emulsion to road contractors and that Defendant's business which has been conducted for years prior to the alleged Hayden invention be so hampered with restrictions and danger of contempt actions, as to prevent Defendant from proceeding in his regular lawful business.

"Conclusions.

"It is respectfully submitted that the equitable Doctrine of Contributory Infringement does not warrant its extension to secure by direct or indirect means a limited monopoly in the sale of unpatentable materials, and, therefore, in determining whether contributory

infringement lies, the purpose and intent of the Plaintiff asking for injunctive relief deducible from the facts may be investigated by the Court. If the Plaintiff's business from which he derives his profit is in the sale of the unpatentable materials the Court may properly infer that its primary intent is to obtain a limited monopoly in these old and unpatentable supplies, and the case should be dismissed.

"There is nothing in such a holding which in any way limits the well-established doctrine of contributory infringement in cases where the Plaintiff's primary and only purpose, deducible from the facts concerning the nature of his business, is to stop actual interference with his granted patent monopoly, even where he seeks to stop the sale of unpatentable materials. In such cases, no doubt, an equity court would be justified in granting injunctive relief.

"In the present case, The Barber Company, manufacturers of asphalt emulsion, from which product (rather than from the practice of the patented process) they derive their profits, should not be permitted to secure a monopoly in this sale through an improper use of their patent, and the Circuit Court of Appeals for the Third Circuit should be reversed and this case returned with an order of dismissal."

The Opinion of the Supreme Court in the Case of Leitch v. Barber, 82 L. Ed. 276, Further Emphasizes the Broad Equitable Principle Upon Which the Dry Ice Case Was Decided.

In our discussion of the Carbice Case, we endeavored, point by point, to contrast the facts of the instant case. We shall in our discussion of the opinion of the Court in the case of *Leitch vs. Barber*, refrain from thus contrastingly interlarding the facts of the present case. They are precisely of the character to which counsel for the petitioner in the *Leitch* case referred when they said:

"Nothing in the **Dry Ice** case can properly be construed to mean that the sale of unpatentable material will not be enjoined where the sole purpose is to stop

an infringement of a patent which the plaintiff is practicing and from which he derives his profit. And it is respectfully urged that this distinction be repeated in the present case as was done in the Dry Ice Case * * *." (The emphasis is that of counsel for Leitch.)

In considering the grounds upon which the decision was based in the case of *Leitch vs. Barber*, it is to be borne in mind throughout that the Stewart-Warner Corporation purchased the Butler patent and then began in April, 1933, to manufacture and sell the lubricating apparatus described and claimed in the Butler patent. Stewart-Warner has sold all of the parts, *i. e.*, the complete combination claimed in the patent in suit. It has done so in precisely the same way that any other manufacturer would normally and rightly engage in the manufacture and sale of any patented machine or apparatus. (If there is any difference, it is a purely superficial difference arising from the fact that the real value of the Butler invention resides in the intermittent severability of the two halves of the connector mechanism, thereby making it necessary for Stewart-Warner to sell the invention in its component parts and assortments rather than as a permanently integrated whole.) The Stewart-Warner Corporation has never engaged in any attempt to fix resale prices. It has never proposed or used any tying clauses. It never has imposed any restrictions or conditions. It never has incorporated any license or other notices in invoices or on labels or otherwise. Neither the headed nipple parts nor the compressor and coupler parts of the lubricating apparatus sold by Stewart-Warner, had any existence or market or use prior to the time when the invention of the Butler patent was first put on the market in April, 1933. No nipple which had ever been manufactured or sold or illustrated or described prior to the commercial advent of the Butler lubricating apparatus, can be used as a part of or in lieu of any part of the Butler invention as manufactured and sold by the plaintiff-respond-

ent. At the time when Stewart-Warner first put the Butler invention on the market in 1933, no one else had ever manufactured or sold or used any part of any connector mechanism which could be used as any part of the Butler mechanism as then first manufactured and sold by Stewart-Warner.

It was not until a year and a half later that the defendant-petitioner first began the manufacture and sale of headed nipples specially contrived and adapted for the sole purpose of being incorporated as parts of the Butler invention as manufactured and sold by his assignee.

As contrasted with such a simple and straightforward effort to profit from the manufacture and sale of the whole of the invention of the patent in suit, and in no other way whatsoever, let us observe what considerations were expressed in Mr. Justice Brandeis' opinion as the basis for the conclusion reached in the case of *Leitch vs. Barber*.

(1) At the outset, the Court points out in its opinion that Barber and Leitch "are competing manufacturers of bituminous emulsion."

Road contractors had been purchasing such bituminous emulsion from these concerns and from other concerns for a period of thirty or forty years.

(2) The Court points out that this bituminous emulsion is "an unpatented staple article of commerce produced in the United States."

(3) It points out that it was produced "by many concerns."

(4) The Court points out that this bituminous emulsion was "in common use by their customers for many purposes."

(5) It is said that "By builders of macadam roads, the emulsion has long been used as a coating for crushed stone and otherwise."

(6) The Hayden patent in suit was for a process of concrete road building in which the concrete was to be sprayed on the surface of the roadway to retard evaporation of moisture from the concrete during its curing. But the Barber Company, having acquired the Hayden patent, never once used the patented process in its own business. Never once did it sell any product produced in and by the use of the process. As the Court points out in its opinion, "The company does not itself engage in road building."

(7) "The company does not * * * compete with road contractors."

(8) "It does not seek to make road builders pay a royalty for employing the patented method."

(9) "It does not grant to road builders a written license to use the process." (A footnote says that the Barber Asphalt Company, the predecessor of the plaintiff, Barber Company, Inc., had granted a written license to Johnson-Marsh Corporation. The consideration was not, however, the payment of any royalties but rather an obligation or expectation that the Johnson-Marsh Corporation would buy "from the Barber Asphalt Company 'Cutback material' for use in the east, and 'Trinidad or Bermudez asphalt' for use in the west.")

(10) "But it adopts a method of doing the business which is the practical equivalent of granting a written license with a condition that the patented method may be practiced only with emulsion purchased from it."

(11) "Thus, the sole purpose to which the patent is put is thereby to suppress competition in the production and sale of staple unpatented material for this use in road building."

We believe that this sentence was intended to contrast and highlight the use and purpose to which the Barber Company put its patent as compared with such a statutorily

intended use and purpose as that to which the Stewart-Warner Corporation has put its patent, i. e., to practice the invention of the patent by the manufacture, use or sale of it.

(12) There is significance, we think, in the manner in which Mr. Justice Brandeis' opinion describes the action of the Third Circuit Court of Appeals. He says that the Court of Appeals "sustained the validity of the patent." This question of validity was not even brought up by the writ of certiorari. He says that the Court of Appeals "concluded that there was contributory infringement." Neither of these conclusions was disturbed in any customary sense by the Supreme Court. The significant phrase in Mr. Justice Brandeis' description of the action of the Court of Appeals is that in which he said that the Court

"held that maintenance of the suit was not forbidden by the rule declared in *Carbice Corp. v. American Patents Development Corp.*, 283 U. S. 27, 75 L. Ed. 819, 51 S. Ct. 334."

The conclusion of the Supreme Court was, of course, that "maintenance of the suit was forbidden" by the rule declared in the Carbice case. A consideration, therefore, of the controlling factors in the Carbice decision as they are enumerated in the decision in the Leitch case, will be further illuminative of the real grounds of the decisions in both cases, and of the fundamental principle upon which both were based.

The following are, then, the facts and the only facts of the Dry Ice case which are set forth in Mr. Justice Brandeis' opinion in the Leitch case, as determinative of the conclusion in the Dry Ice case.

(1) "The sole business of the Dry Ice Corporation was to make and sell Dry Ice—which is an unpatented material."

(2) "It did not make or sell transportation packages in which Dry Ice was used as a refrigerant." The Slate patent in suit claimed such a transportation package as the invention which was sought to be covered.

(3) "It did not issue to other concerns licenses to make such packages upon payment of a stipulated royalty."

(4) "It did not formally license buyers of its Dry Ice to use the invention in suit."

(5) "But each invoice for Dry Ice bore a notice in effect that the patented container could be used only with Dry Ice purchased from the corporation."

In its opinion in the Leitch case the Court pointed out that in declaring that relief must be denied in the Dry Ice case, it said certain things;—more particularly that: "Control over the supply of such unpatented material is beyond the scope of the patentee's monopoly." It said that "this limitation" was "inherent in the patent grant." It said that "this limitation" "is not dependent upon the peculiar function or character of the unpatented material or on the way in which it is used." This means, we think, that it was unimportant whether the material had or did not have peculiar functions or characteristics dependent upon the way in which it cooperated in the combination, or the alleged combination, of the patent.

We think that our understanding in this regard is confirmed by the immediately succeeding sentence in which it was said that

"Relief is denied because the Dry Ice Corporation is attempting, without sanction of law, to employ the patent to secure a limited monopoly of unpatented material used in applying the invention."

In its opinion in the Leitch case, the Court went on to quote further from its opinion in the Dry Ice case. The quotation comprises a reiteration of the salient facts that,

"The plaintiffs neither sell nor license others to sell complete transportation packages. They supply merely one of several materials entering into the combination." The passage quoted from the opinion in the Carbice case then goes on to say that the plaintiff's "attempt to secure" "a monopoly" "on that commodity" "cannot be sanctioned." The reason lay in the conduct of the plaintiffs in their misuse or abuse of their rights of inherently limited monopoly as conferred upon them by the patent statutes. Having misused and abused what might have been their right to a limited monopoly under the patent statutes, they could not, as the Court elsewhere phrased it, "maintain a suit" in equity for an alleged contributory infringement.

The opinion in the Leitch case next refers to the Barber Company's contentions that the rule of the Carbice case was not applicable to the situation in the Leitch case.

In view of the controlling facts which had been previously enumerated and as we have just quoted them in full, the Court swept aside these contentions and attempted distinctions, with the statement that they were "without legal significance."

In Its Opinion in the Case of Leitch vs. Barber the Supreme Court Explained Why the Barber Company's Attempted Distinctions Were of No Legal Significance.

We stress now the Court's explanation of the reasons why the Barber Company's attempted distinctions were of no legal significance.

The First Reason.

(1) It was said "that the Court held in the Carbice Corp. case that the limitation upon the scope or use of the patent which it applied was 'inherent in the patent grant.'" Obviously, the "use of the patent" and the "scope" of the

patent were limited by the patent grant, and were, as the Court said, "inherent in the patent grant." According to the patent grant, the limited and permissible "use of the patent" was to exclude others from making or using or selling the invention of the patent. It was because of the plaintiff's attempt to use the patent in furthering their purpose to suppress competition in the merchandising of a staple and unpatented commodity or material, that they were held to have lost any right to ask a court of equity to enforce what might otherwise have been their limited patent monopoly. The fundamental principle of the decision is, as we see it, such that the plaintiffs had forfeited their right to relief either against an alleged complete and direct infringer or against an alleged contributory infringer.

Judge Wilkerson's Understanding of the Decision in Leitch vs. Barber as Expressed in His Opinion of February 16, 1938 in the Case of Lecithin vs. Warfield.

Such was the understanding and conclusion of his Honor Judge Wilkerson, sitting in the District Court for the Northern District of Illinois, in the very recent case of American Lecithin *vs.* Warfield Company (February 16, 1938,—not yet reported). Judge Wilkerson refused to grant relief to the plaintiff under a bill alleging direct and complete infringement as distinguished from so-called contributory infringement. In so doing, Justice Wilkerson said in his opinion:

"Plaintiff's method of doing business is as follows: It does not issue any formal license to anyone to use its patent. It does not itself make chocolate and does not collect royalties from others for the use of its process. Upon the purchase from it of lecithin, the plaintiff acquiesces in the use of its patent. When the lecithin thus sold by plaintiff has been used up by the customer, this acquiescence, as well as the permissive use of the patent, allegedly ceases. See *American Lecithin Co. v. Ferguson*, 19 F. Supp. 294, 300.

"I am of the opinion that this method of doing business falls within the condemnation of the recent case of *Leitch Mfg. Co., Inc., v. Barber Co.* (82 L. Ed. 276—1938) as the 'practical equivalent of granting a written license with a condition that the patented method may be practiced only with' lecithin purchased from it. To use the language of the Leitch case, 'the sole purpose of which the patent is put is thereby to suppress competition in the production and sale of staple unpatented material for' use in chocolate making.

"In the Leitch case, the plaintiff and the defendant were competing manufacturers of bituminous emulsion, an unpatented article of commerce. Builders of cement concrete roads had come to use emulsion as a film on the surface of the roadway to retard evaporation during curing. The plaintiff acquired the process patent sued upon, which covered a method of retarding this evaporation. The company did not itself build roads, it did not require royalties, and it did not issue licenses. Any road builder who bought emulsion from it received, by implication of law, authority to practice the invention. The defendant was a competing manufacturer of the unpatented material, who sold it to a road builder for use with the patented process. The Supreme Court held that the patent did not confer upon the plaintiff the right to be free from competition in supplying unpatented material to be used in practicing the invention.

"While the Leitch case involved a contributory infringer, I believe that its doctrine is applicable in the present suit against the alleged direct infringer. The doctrine so clearly formulated in the Leitch case grows out of the case of *Carbice Corp v. American Patents Development Corp.*, 283 U. S. 27, 75 L. Ed. 819. While that case also involved a suit against a contributory infringer, it was thought that its doctrine would be extended to direct infringers and that the opinion might be taken to mean that an otherwise valid patent right would not be enforced to prevent even direct infringement when the patent was being utilized to gain a monopoly beyond its legitimate scope. 45 Harvard Law Review 1119 (1932). The Supreme Court itself in the Carbice case (p. 31) took cognizance of the fact that in some jurisdictions it had been held (*Hunton Co.*

v. *Lolynos* (1930) 1 Chancery 528) that the insertion of a condition in a license agreement that unpatented materials used in connection with the invention should be purchased only from the licensor, established a complete defense to a charge of infringement.

"The language in the Leitch case indicates that the reasons for denying relief in this type of case rest upon broad policy grounds and not upon narrow legal distinctions. The court in the Carbice as well as in the Leitch case denied relief because the owner of the patent monopoly sought by its method of doing business to extend its monopoly to unpatented material, in contravention of the limitations inherent in its patent grant. By the rule declared in those cases, 'every use of a patent as a means of obtaining a limited monopoly of unpatented material is prohibited. It applies whether the patent be for a machine, a product, or a process. It applies whatever the nature of the device by which the owner of the patent seeks to effect such unauthorized extension of the monopoly.' *Leitch Mfg. Corp., Inc., v. Barber Co.*, 82 L. Ed. 276, 278 (1938). In my opinion, the doctrines also apply whether the person sued be a direct or a contributory infringer. The operation of the principle of public policy does not distinguish between the two.

"I accordingly find that the plaintiff is not in a position to maintain this suit. In view of the foregoing conclusion, it is not necessary to pass upon the validity of the patent or defendant's claim to a shop license for the life of plaintiff's patent. The bill should, therefore, be dismissed."

The Second Reason.

(2) The reason as secondly given why this Court in the Leitch case swept aside the insignificant distinctions attempted to be advanced by the Barber Company, was that the Dry Ice Company was

"denied relief, not because there was a contract or notice held to be inoperative, but on the broad ground that the owner of the patent monopoly, ignoring the limitation 'inherent in the patent grant,' sought by this method of doing business to extend the monopoly to unpatented material used in practicing the invention."

The Third Reason.

(3) Referring further to its decision in the Carbice case, Mr. Justice Brandeis said in his opinion in the Leitch case: "By the rule there declared, every use of a patent as a means of obtaining a limited monopoly of unpatented material, is prohibited."

It would seem to be clear beyond question that this prohibition would apply to every patentee who attempted any such misuse or abuse of his limited patent monopoly, and regardless whether he attempted to proceed against an alleged complete and direct infringer or against an alleged contributory infringer. If, in other words, the patentee violates or disregards the prohibition, he cannot secure any kind of relief in equity based upon what otherwise might have been his inherent right to a limited monopoly.

The Fourth Reason.

(4) The Court went on to make it clear that this rule of prohibition (and obviously its necessary corollaries) "applies whether the patent be for a machine, a product, or a process." The patentee's every attempt to extend his monopoly beyond the purview of the monopoly inherent in the patent grant, is to be met by a denial of relief in equity, regardless whether the patent be for a machine, a product, or a process.

The Fifth Reason.

(5) Finally, it was said that the rule "applies whatever the nature of the device by which the owner of the patent seeks to effect such unauthorized extension of the monopoly."

Thus, even to the Court's final statement in explanation of the rule and the reason for the rule of the Carbice case,

it is the inequitable and contra-public-policy conduct of the plaintiff in and about his patent, which constitutes the test of the applicability of the rule. The conduct of the defendant in a patent suit brought by such a disqualified plaintiff, can be of no consequence. It can have no bearing whatsoever upon the outcome.

With respect to such a rule as this, it is obvious that nothing in *Leeds & Catlin vs. Victor* could modify or affect it. "That was an ordinary case of contributory infringement" (Carbice opinion). The Victor Company had not attempted by any device whatsoever to use its patent or to adopt a method of doing business such as would unmercifully extend its monopoly, and as corollary forfeit its right to the relief which it might otherwise have had in a court of equity. In the concluding sentence of his opinion, Mr. Justice Brandeis said as much:

"Nothing in *Leeds & C. Co. v. Victor Talking Mach. Co.*, 213 U. S. 325, 53 L. ed. 816, 29 S. Ct. 503, limits it."

Summarizing Then, Relative to the Decisions in the Carbice Case and in the Case of Leitch vs. Barber: Nothing in These Decisions Can Properly Be Interpreted as Granting Immunity to a Joint Participant in the Tort of Patent Infringement,—Provided, of Course, That the Conduct of the Patentee Has Not Been Such as to Deprive Him of the Right to Any Relief in a Court of Chancery.

We have canvassed almost word by word every paragraph of the opinions in the Carbice and Leitch *vs.* Barber cases. If we understand what they say and what they mean, they can have no applicability whatsoever to the present case. They can have no applicability to any case in which the patentee simply goes about the business of making or using or selling the whole of the invention described and claimed in his patent.

Not one of the considerations described by the Court as constituting the reasons why relief was denied in the Carbice and Barber cases, is applicable to any feature of the Stewart-Warner Company's conduct in respect of the Butler patent in suit.

Now, in concluding our long discussion of the case of *Leitch vs. Barber*, it may be well to recall the fact that we have been examining the case to see whether it supports the contention that it abolished all of the accumulated and long-enforced law of contributory patent infringement.

This much is certain: The Carbice case did not in words overrule the law of contributory infringement as set forth in *Leeds & Catlin vs. Victor* (and in scores of other cases in all of the federal courts for a period of more than sixty years); in the subsequent case of *Rogers vs. Alemite*, the Court still recognized "an ordinary case of contributory infringement" as represented by *Leeds & Catlin vs. Victor*; in the still later case of *Leitch vs. Barber*, the Court did not expressly overrule the *Leeds & Catlin* case; it did not expressly abolish the doctrine of contributory infringement.

Despite the opinions which various lawyers have written and expressed, any reasonably careful study and analysis of these recent decisions by the Supreme Court will make it clear beyond peradventure that the Court has not by implication or inference, attempted to abolish the doctrine or the law of contributory infringement. There is nothing in any of these cases which, in a case having the requisite background of equity, precludes the application of the long-established law of contributory infringement. Nothing in these decisions can properly be interpreted as granting immunity to a joint participant in the tort of patent infringement,—provided, of course, that the conduct of the patentee has not been such as to deprive him of the right to any relief in a court of chancery.

The Facts of the Instant Case Exactly Parallel the Facts of *Leeds & Catlin v. Victor*, 213 U. S. 301 and 325,—from Which the Supreme Court Distinguished the Carbice Case and the Leitch Case.

We turn now to the fourth case upon which the petitioner seeks to place its reliance, namely, the case of *Leeds & Catlin v. Victor*, 213 U. S. 301 and 325.

In this instance, of course, the petitioner's reliance must necessarily take the form of an effort to distinguish the present case from the case of *Leeds & Catlin v. Victor*.

If our understanding of the Carbice and Leitch decisions is substantially correct, they do not afford any avenue of escape to the defendant petitioner,—because the Stewart-Warner Corporation's methods and policies of doing business,—its use of the patent in suit, have been such as to entitle it to such protection as a court of equity can and will afford. None of the reasons for "denying relief" in the Carbice and Leitch cases can be found in the instant case.

On the other hand, the facts of the present case parallel so exactly the facts of *Leeds & Catlin v. Victor*, that unless that case has been overruled, it would seem to control the present case in so far as the law and the application of the law of contributory infringement are concerned.

Under the circumstances, counsel for the petitioner have evolved and urged upon the court a novel doctrine which they would like to have regarded as the authoritative present and future doctrine of contributory infringement. They propose that every patented combination shall be dissected into its several elements and that each of the several elements be rated as separately new or separately old. Their proposal is that anyone and everyone shall have the right to furnish any or all of the old elements with knowledge and intent that the purchaser will in-

corporate them into the combination of the patent in suit. Their proposal is that in the case of any element which is separately new and patentable, then third parties shall not have the right to supply that particular element with corresponding knowledge and intent.

It is obvious, as was pointed out in the opinion of the Seventh Circuit Court of Appeals in this case, that any such rule would revolutionize the law of patents. The reason is that almost every invention, great or small, involves simply a new combination of elements, each of which is separately old. If, with appropriate knowledge and intent, anyone and everyone is free to contribute all of the separately old elements of a new combination, then a patentee would be left with no practically useful remedy against the most wholesale invasion of his patent rights. It would be possible for every contributor to the ultimate making or using or selling of the invention of the patent in suit to show that his elements, broadly and generally considered, was an old element. Every contributor would point to someone else as the contributor of the new and patentable element,—if any.

The petitioner's theory would, of course, destroy, in effect, approximately eighty-one per cent of all patent claims. The reason is that the very assumption that the real invention of a new combination must inhere in some one element or in some minor group of elements means that the patent should be taken out upon the one new and patentable element or minor group of elements. The very suggestion that the invention could always or often be found to inhere in some one element presupposes that there is always some one element of a new combination which in and by itself can withstand the necessary tests of novelty, utility, invention, etc.

The theory proposed by counsel for the petitioner is rendered completely untenable by a hundred years of experi-

ence in the analysis and definition of patentable inventions. It is rendered untenable by the classic definitions of patentable combinations as set forth in the *Leeds & Catlin* cases (and in other earlier but less successful statements of the matter).

Nevertheless, counsel for the petitioner feel the need of adapting their proposed new theory to the decisions of the Supreme Court in the cases of Carbice, Leitch, Rogers, and *Leeds & Catlin*. So they proceed to find that in the cases of Carbice, Rogers, and Leitch the defendants were engaged in the sale of old and separately unpatented elements or commodities. If true, this may or may not have been a coincidence. The fact, if true, would lack significance unless counsel can find that in the *Leeds & Catlin* case the defendant was engaged in furnishing an element which in and of itself was separately new and patentable. (The acceptance of their new theory would require also a demonstration that the liability of the defendant in the one case and the immunity of the defendants in the other three cases was, in fact, based upon an examination and determination of the novelty and patentability or the antiquity and unpatentability of the element supplied by each defendant. We have seen that no such examination or determination was a factor in the reasoning of the opinions either in the *Carbice* case, or the *Rogers* case, or the *Leitch* case.) We shall see also, that it was not a factor in the *Leeds* and *Catlin* case,

Nevertheless, counsel for the petitioner direct their attention to the *Leeds & Catlin* case in the hope of finding that the disk record with its spiral groove of even depth and with laterally undulating side walls was a separately new and patentable element at the date of the application for the Berliner patent in suit No. 534,543.

In so doing, they quote certain phrases from the opinion of the court in 213 U. S. 325 and then jump to the utterly

erroneous conclusion that the court was describing these particular forms of record as new and patentable in and of themselves and as indeed constituting something which might appropriately be regarded as the real heart and soul, the so-called gist or essence of the invention of the claim in suit.

A simple test will show the unwarrantability of counsel's conclusions: We say that disk records with spiral sound grooves of even depth and laterally undulatory side walls were old and well known long prior to the application for Berliner patent No. 534,543. We say that Berliner did not and could not at that date have secured a valid patent upon this element for the reason that it was separately old and well known at that time. We say that the only structural novelty in the Berliner combination inhered in the phonograph machine, *i. e.*, in such pivotal mounting of the reproducing stylus as would make it free to be propelled across the face of the record by the spiral groove of the record (the fact being that in all of the prior art the phonograph machine had always been provided with a feed device,—usually in the form of a lead screw, for conveying the stylus across the face of the record or for laterally conveying the record relative to the stylus).

For the moment we pause simply to inquire whether the two fragments of the opinion as quoted by counsel for the petitioner on pages 58 and 59 of their brief would not be entirely consistent with such a factual situation as we have stated it to have been.

In the first place, the claim in suit of the Berliner patent read as follows:

"35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described."

It is obvious that the language in which the record part of the combination was here described is broad enough to cover any and every form of phonograph record, i. e., cylindrical tablets as well as disk tablets,—and tablets having hill and dale grooves of varying depth as well as records having sound grooves of more or less even depth and with laterally undulatory side walls.

The fact of the matter is further that

“a reproducing stylus shaped for engagement with its associated record and free to be vibrated and propelled by the same”

would be caused to travel across the face of the record or tablet, regardless of the particular style of tablet or sound groove.

Any of the old and well-known records or tablets would cause the stylus and its associated diaphragm to vibrate and any of the old and well-known records would cause the stylus and its associated sound box and pivoted tone arm to be propelled by the groove of the record,—provided, of course, that the stylus be pivotably mounted so as to be free for such propulsion.

When under these circumstances the court said, as quoted and stressed by counsel for the petitioner, that

• “It will be observed how important the record is to the invention embodied in the claims”,

the court was stressing the importance of the new co-operative relationship between the record and the stylus. As a result of Berliner's new combination, the record groove acquired the new function of “propelling” the stylus across the face of the record.

It was true of the phonographs of the art prior to the Berliner patent in suit that, as stated by the court in its opinion,

“the undulations in the side walls of the spiral groove

vibrate the stylus back and forth, transmitting the recorded sound waves to the diaphragm."

All of that was old and well-known. The court went on, however, to point out the new function which was acquired by the sound groove of the tablet because of its new association with a stylus which was freed from any feed device and which was pivotally mounted in such a way as to swing across the record in response to the new propelling action of the sound grooves. It was with this new function in mind that the court went on to say that in the new combination the spiral groove of the record had the function at the same time of "propelling the stylus as it engages with the record." Having in mind this new function of the sound groove of the tablet, the court said that as high a degree (if not a higher degree) of *importance* (not, of novelty!) "must be awarded to the disk" as to the stylus. The incidental reference to the "lateral undulations" of the groove was simply descriptive of one form of sound groove coming within the broad language of the claim in suit. The court said:

"It is the disk that serves to distinguish the invention,—to mark the advance upon the prior art."

The advance upon the prior art was the automatic propulsion of the stylus and its tone arm by the sound groove of the record itself, as distinguished from the prior propulsion by the mechanically driven feed device. The distinction of the invention of the Berliner patent in suit No. 534,543 was, therefore, the propulsion of the stylus by the disk or tablet,—as contrasted with the propulsion of the stylus by a feed screw.

Certainly, therefore, when the court said that

"It is the disk that serves to distinguish the invention,—to mark the advance upon the prior art"

it was not saying, as counsel for the petitioner would have it say, that the disk record with a spiral groove of even

depth and lateral undulations in the side walls, was in and of itself a new thing or something which was separately patentable.

Furthermore, the court was certainly not attempting to say that the broadly stated "traveling tablet having a sound record formed thereon", as it appeared in Berliner's claim, was for any purpose whatsoever to be construed as limited to a disk form record or to a record having a spiral sound groove of even depth or to a sound groove with laterally undulating side walls. The whole of the broad, and all-inclusive descriptive language of the claim was, "a traveling tablet having a sound record formed thereon."

Counsel for the petitioner refer to another phrase picked from the opinion of the court in the second Leeds & Catlin case.

"Indeed, as we have seen, it is the distinction of the invention, constituting by its laterally undulating line of even depth **and the effect thereof**, the advance upon the prior art."

"And the effect thereof!"

The distinction of the invention was, indeed, **the effect of the sound groove in automatically propelling the stylus and its associated sound box and tone arm across the face of the record**. That was the one new and unitary result of the invention! In referring to the new function or effect of the sound groove in propelling the stylus across the face of the record, the court did speak of the sound groove as having a "laterally undulating line of even depth". This specificity relative to a particular form of groove was, however, quite irrelevant to the real point of the court's statement. As we have seen, the claim of the patent was not limited to this or any other particular type of sound groove. Furthermore, a tablet or record having this particular type of sound groove had become a part of the

prior art many years before Berliner's invention of his patent in suit No. 534,543.

The opinions of the lower courts in the instant case particularly state the facts of the Leeds & Catlin case to be as we have here stated them to be. At a later point we shall refer Your Honors to the parts of the record which confirm the accuracy of our factual statements and those of the District Court and of the Court of Appeals herein.

For the moment we say simply that the new theory,—the new test of contributory infringement, as now proposed by counsel for the petitioner, cannot be reconciled with the facts of the Leeds & Catlin case. Regardless whether it be called "a travelling tablet having a sound record formed thereon", as stated in Berliner's claim, or a disk record having a spiral groove of even depth and laterally undulating side walls, as counsel for the petitioner would have it,—the fact of the matter is that that record was both broadly and specifically as old as "old" need be, in so far as the invention of Berliner's patent No. 534,543 is concerned. Such phonograph records with such specific grooves, as well as other records with other kinds of grooves, antedated Berliner's invention by several years.

Upon the basis of the real facts it is entirely impossible, therefore, to find any distinction whatsoever between the Leeds & Catlin case on the one hand, and the Carbice, Rogers, and Leitch cases on the other hand, in so far as the novelty or antiquity of the element supplied by the defendant is concerned. There is no such distinction as that which counsel for the petitioner formulate and rely upon.

In attempting to determine the real meaning of the three cases (Carbice, Leitch, and Leeds & Catlin)* which we have been discussing as a result of the petitioner's cita-

* As we have seen, the *Rogers v. Alemite* case went off on grounds other than those now under consideration.

tions, it is essential to know that in each and every one of these cases, the thing furnished by the defendant was separately old and unpatentable.

The real distinction of the Leeds & Catlin case was and is that the Victor Talking Machine Company simply went about the business of making and selling the whole of the invention of the Berliner patent. It did not do any of the things which caused the court to refuse to grant relief to the plaintiffs in the Carbice, and Leitch vs. Barber cases.

Furthermore, the manner in which the Victor Talking Machine Company went about its business of making and selling the whole of the invention of the Berliner patent is paralleled in a remarkable degree by the manner in which the Stewart-Warner Corporation went about its business of making and selling the whole of the invention of the Butler patent in suit.

It is evident, of course, that in a lubricating system of the kind described in the Butler patent, the complete combination of all of the seven elements of claim 2 is brought together only periodically and temporarily,—and then too, only in the hands of the ultimate user.

The manufacturer cannot sell the completed combination intact. No one wants to buy the completed combination intact. What the ultimate user of the lubricating equipment of the Butler patent desires is to buy from the manufacturer such a number and such an assortment of nipples as may be required for permanent association with each of the bearings of his automobile or other machinery. He wishes then to have the use of a single compressor and coupler which he may connect periodically with each of his many nipples.

Some automobile owners wish to grease their own cars; others wish to have this greasing done at more or less public service stations and garages.

What the purchaser desires to buy and what the manufacturer necessarily makes, is therefore an assortment of nipples having interconnecting parts of identically the same form and dimensions but whose shanks are provided with various different lengths, angles, and thread sizes. The sale of this kind of lubricating equipment requires, therefore, that the manufacturer separately list and price each of the various kinds of nipples and that he separately list and price each of the various sizes of compressor which may be interconnected and thus temporarily combined with any one of the assorted nipples. This leaves the purchaser free to purchase the particular assortment of nipples best adapted to the lubrication of his own particular automobile or machine.

An automobile owner who invariably has his car greased at a public service station or garage, has no use whatsoever for the compressor and coupler parts of the complete combination. On the other hand, a garage man who greases nothing but other people's automobiles, has no need to buy the nipple parts of the combination for his own use.

Speaking by and large, it is only at the moment of greasing a bearing that the complete combination is ever brought together. This may be at the hands of the ultimate user or it may be at the hands of the garage man.

All of these characteristics parallel in a remarkable degree those involved in the phonograph litigation.

Speaking generally, the Berliner patent No. 534,543 covered the combination of a phonograph machine and a phonograph record. The Victor Company, the owner of the phonograph patent, necessarily met the desires and needs of its customers by separately listing and pricing the phonograph machines and by separately listing and pricing the phonograph records.

Each of the component parts of the complete combina-

tion was made in the variety of styles and sizes adapted to the needs and tastes of the ultimate users. Each purchaser could select the particular assortment which would strike his needs or his fancy.

The close parallelism between the methods employed by the Stewart-Warner Corporation in conducting its business of manufacturing and selling the complete combination of the Butler patent in suit, and the methods by which the Victor Company engaged in the manufacture and sale of the complete combination of the Berliner patent, is matched by a similarly close parallelism between the activities of the Lincoln Engineering Company in the one case and the Leeds & Catlin Company in the other case.

The Leeds & Catlin Company engaged in the manufacture and sale of disc records having spiral sound grooves essentially like those of the Victor records. The purchaser of a Leeds & Catlin record could combine it with the phonograph machine which he had purchased from the Victor Company, thereby organizing and enjoying the complete combination of the Victor Company's Berliner patent. The suit against Leeds & Catlin alleged contributory infringement of the Berliner patent in and by the sale of records which their purchasers would thus combine with the Victor Company's talking machines. In addition to various defenses going to the validity of the patent in suit, the Leeds & Catlin Company defended upon two grounds;

(1) that when the Victor Company sold the phonograph machine parts of the combination, the purchaser was impliedly licensed to make for himself or to buy from Leeds & Catlin the record parts necessary to the enjoyment of the phonograph machine; and

(2) that Leeds & Catlin had made and sold a phonograph machine with which the Leeds & Catlin Company's records might be combined and used, and in which a feed screw was provided for moving the needle across the face of the revolving disc record,—thereby avoiding that feature of the Berliner combination which

called for a reproducing stylus so mounted as to be free to be propelled by the sound groove of the record, not by any extraneous feed screw but by the coaction of the spiral sound groove of the disc itself with the stylus needle and its associated diaphragm and tone arm.

Despite the pretense of innocence provided by the Leeds & Catlin Company's feed screw machine, and despite the fact that the use of the Leeds & Catlin Company's records in combination with the Leeds & Catlin Company's phonograph machine of the feed screw type, would not, as was conceded by the courts, embody or contribute to the infringement of the Berliner patent, the Supreme Court sustained the Second Circuit Court of Appeals in enjoining the Leeds & Catlin Company against the further sale of its disc records for use in the combination of the Berliner patent. The ground of the decision was of course that the sale of these records, which were so completely and perfectly adapted for use with the hundreds of thousands of Victor phonographs already in the field, and which were manufactured and sold with the knowledge and intention that the purchasers would so combine and use them, was a contributory infringement,—and this despite the fact that there was a possible way in which the Leeds & Catlin records could have been used—in conjunction with the feed screw machine—without involving any infringement of the Berliner patent.

In the instant case the petitioner, Lincoln Engineering Company, like the Leeds & Catlin Company, endeavored to develop some similar pretense of innocence as to the knowledge, purpose, and intent with which it sold the headed nipple parts of the Butler combination. Upon the trial in the District Court, the Lincoln Company devoted much effort to an attempt to show that its headed nipples were made and sold for innocent use in connection with "needle nozzles,"—or at

any rate, that the plaintiff had not been able to prove that the Lincoln nipples were sold with knowledge and intent, that the purchasers would and should combine them in use with the other parts of the Butler combination as manufactured and sold by the Stewart-Warner Corporation. This pretense was completely swept aside by evidence showing that the Lincoln Company had first made up some samples of nipples which did not have the groove and head of the Butler patent, and which could not, therefore, be combined in use with the compressor and coupler parts manufactured and sold by the plaintiff under the Butler patent in suit. These round-headed and straight-sided fittings were, however, perfectly adapted to all of the innocent uses proclaimed by the Lincoln Company. The Lincoln Company endeavored to sell these round-headed and straight-sided nipples to the General Motors Corporation, but without success. Finally, in the fall of 1934, a groove and a head were added to the Lincoln nipples in such perfect form, location, and dimensions that they could be incorporated as perfectly coacting parts of the Butler combination as sold by the Stewart-Warner Corporation. Then, and then only, did the General Motors Corporation and others begin to buy and to use the nipple parts as sold by the petitioner.

All of the facts in this regard were presented to the District Court. Both the District Court and the Court of Appeals are agreed upon the basis of rather overwhelming evidence, that the Lincoln Company did, some eighteen months after the advent of the Butler invention upon the market, design, manufacture, and sell its headed nipples with the knowledge and intent that the purchasers would incorporate them as parts of the invention of the Butler patent in suit.

Now, in this Court, the petitioner does not even advance

the contention that its headed nipples were designed or manufactured or sold with any such innocent purpose or intent as was claimed in the District Court.

The only essential difference, then, between the Leeds & Catlin Company and the Lincoln Engineering Compay in this Court, is that the Lincoln Company has now dropped its camouflage, whereas the Leeds & Catlin Company relied to the end upon its camouflage.

In Our Previous Discussion of the Leeds & Catlin Case, We Have Asserted the Fact to Be That In and Of Itself the Record Disc Was Not a Novel Element of the Combination of the Berliner Patent in Suit No. 534,543. We Propose Now to Show in Some Detail That It Was In and Of Itself An Old and Well-Known Element.

In our previous discussion, we have stated the fact to be that in and of itself the record disc of the Leeds & Catlin case was not a novel element of the combination of Berliner patent No. 534,543. In and of itself it was an old and well-known element.

The petitioner's contentions in this Court hinge largely upon the assertion that the disc record of the Berliner patent No. 534,543, was in and of itself a novel and separately patentable element. They make this contention the basis of their attempted distinction between the Leeds & Catlin case on the one hand and the Carbice and Barber Asphalt cases on the other hand.

Despite the conclusions of the lower courts that counsel for the petitioner were all wrong in the factual basis for their argument, it may be worth while to outline briefly the reasons which the lower courts had for deciding the instant case upon the understanding that the disc record of the Leeds & Catlin case was in and of itself an old and well-known element.

It is first to be observed that at the very outset of his patent 534,543, Berliner says that

"My invention has reference to improvements in the method of and apparatus for recording and reproducing sounds, the improvements being more particularly directed to the construction of that kind of sound recording and reproducing apparatus which I have called 'gramophone,' and for which Letters Patent of the United States No. 382,790, dated May 15, 1888, have been granted to me." (Page 1, lines 8 to 16.)

(This and the other early Berliner patents were issued more than two years prior to Berliner's application for patent 534,543 and are therefore of the "prior art" as against Berliner, in so far as patent 534,543 is concerned.)

One of the features of Berliner patent 534,543 was the use of a constantly flowing bath of alcohol over the face of the disc record or its proto-type during the operation of recording. With this matter, we are not here particularly concerned, but the language used by Berliner in describing this alcoholic detail in connection with the engraving of the initial or master record, makes it clear in several ways that disc records with laterally undulatory sound grooves were acknowledged by Berliner to be old and well-known in and by patents long antedating the application for patent No. 534,543.

If now we turn to page 2, line 77 of the Berliner patent No. 534,543, we find that

"When a sound record is to be made, a record tablet of the kind described in my aforesaid Letters Patent, is placed upon the rotary table 4, and this record tablet is represented in the drawings as a circular disk 44 which has a central perforation passing over the upper end of the shaft 2.")

The "aforesaid Letters Patent" are this same number 382,790, as previously mentioned on line 16 of page 1. It is to be noted that the record tablet of the early patent is described as having the form of a "circular disk."

In further describing the formation of the record, Berliner says at page 4, line 39 of his patent 534,543:

"The vibrations of the diaphragm thus produced will cause the stylus to make a tracing of an undulatory line, corresponding to the sound waves directed against the diaphragm; *all as described in my aforesaid Letters Patent.*"

This refers again to the same early Patent 382,790.

Berliner then points out that

"In accordance with the said (early) patent, alcohol is poured once for all over the tablet, and is allowed to evaporate during the process of recording." (page 4, line 53.)

This is contrasted with the new detail of the new patent, relative to which Berliner says:

"During this whole time a thin stream of alcohol is delivered upon the plate 46 and the alcohol spreading out in all directions is maintained as a uniform and constantly renewed film upon the tablet. In this manner every part of the record is made under alcohol, and *in this respect* my present invention differs from the process set forth in my aforesaid Letters Patent." (page 4, line 44)

It was this constantly flowing bath as contrasted with the once and for all dose of alcohol which distinguished the process of patent 534,543, from Berliner's earlier and previously patented method. Obviously the resulting disc records would not differ from one another in the slightest degree except as the flowing bath might aid in producing a less scratchy and therefore more perfect record of the same identical character as that of the earlier patent.

In other words, Berliner's patent 534,543 presented the record disc or tablet itself as being just what it was—a disc or tablet identical with that disclosed in his earlier patent. This early disc-record was described by Berliner himself as having all of the characteristics which counsel for

the petitioner ascribe to the allegedly new disc-record of patent 534,543.

Berliner himself says in effect, in the 1892 application for his 1895 patent No. 534,543, that the record of his earlier patent, issued in 1888, was a disc record with a spiral sound groove of uniform depth having lateral undulations therein. In 1888 the sound groove of this disc record had the sole function of vibrating the stylus of the reproducing phonograph, in which of course the stylus was fed across the face of the record by an appropriate lead screw geared to the turntable of the machine. This old and well-known disc record never, of course, had the experience of meeting a phonograph machine with a free swinging stylus, until there was a phonograph machine with a free swinging stylus. (We use the picturesque language employed by counsel for the petitioner on page 24 of their brief in discussing the Butler combination.) The meeting (and mating) occurred in 1892. Then it was that Berliner combined the old disc record with a phonograph machine having a stylus so pivotally mounted that it could swing freely across the face of the disc record. Thereupon, the spiral sound groove of the record acquired a new function and participated in a new coaction whereby the sound groove now, not only vibrated the stylus to produce sound waves, but also propelled the stylus and its associated reproducing diaphragm and tone arm across the face of the record. In this way the old disc record participated in accomplishing the real aim and result of the invention, i. e., the elimination of the lead screw mechanism which theretofore had always been required.

The Berliner patent 534,543 contains much more than we have quoted in confirmation of Judge Lindley's understanding of the Berliner patent.

One of the confirmatory facts is the claims of patent 534,543. Some of them are for methods involving the continuous flow of the alcohol bath. Others are, however, for various parts of the gramophone apparatus. There is no reason in the world why Berliner should not and would not in his patent 534,543 have claimed the disc record or tablet in and of itself, if indeed this disc record or tablet were new, as asserted by counsel for the appellant, rather than old, as stated in the Berliner patent itself.

Furthermore, however, an examination of Berliner patent No. 372,786 of November 8, 1887, shows that

"This invention has reference to a novel method of and apparatus for recording and reproducing all kinds of sounds, including spoken words, and is designed to overcome the defects inherent in that art as now practiced and in the apparatus used therefor." (page 1, line 8.)

The very thing which Berliner claimed in this early patent of 1887, was:

"The method or process of recording and reproducing spoken words and other sounds, which consists in first drawing an undulatory line of even depth in a traveling layer of non-resisting material by and in accordance with sound vibrations, then producing the record thus obtained in solid resisting material, and finally imparting vibrations to a sonorous body by and in accordance with the resisting record, substantially as described."

This obviously was the method of producing records or tablets having precisely the characteristics of the disc records or tablets employed in the eight-year later patent No. 534,543. In other words, this patent No. 372,786 of 1887 was claiming the method of producing a disc record with a spiral groove of uniform depth and lateral undulations therein. It was capable, when the time came, of performing the two functions of vibrating and propelling the reproducing stylus of the 1895 patent No. 534,543,—which later patent was alone involved in the *Leeds & Catlin v. Victor* cases.

The disc or tablet was not in and of itself, therefore, a novel element.

In the Court of Appeals the petitioner advanced certain reasons for disputing the correctness of Judge Lindley's conclusions. In their brief in this Court, counsel for the petitioner have not directly disputed the conclusions of the District Court and of the Court of Appeals. They have simply assumed the fact to be quite contrary to that which was determined in the lower courts. Thus far, counsel have let the matter rest upon their wholly unwarranted assumption.

We fear that if we do not pursue the matter further, we may be met at the argument by some such contention as that which the petitioner advanced in the Court of Appeals. We desire, therefore, to answer a little more fully the erroneous assumption of counsel for the petitioner that the disc record of Berliner's patent No. 534,543 was in and of itself a novel and patentable element at the date, 1892, when Berliner applied for his patent No. 534,543.

In the Court of Appeals, counsel for the petitioner sought to upset Judge Lindley's conclusions by advancing the contention that the drawings and specifications of Berliner's early patent No. 372,786 showed a cylindrical record having but a single sound groove which was closed upon itself, and which therefore was claimed to be incapable of feeding or propelling the reproducing stylus across the face of the record. The contention was that the undulating sound groove of even depth, as shown in this early patent of 1887, had the capability of vibrating the stylus but not of advancing or propelling it.

Berliner's early 1887 patent, No. 372,786, involved the disclosure and the claiming of a very broad fundamental method,—a method of undulatory sound groove formation (as distinguished from a sound groove of hill

and dale formation) which could be applied equally as well in the case of cylindrical records as in the case of disc records. It so happened (and it was only a happening) that in the simple diagrams with which Berliner sought to explain his broadly new method of sound groove formation, he illustrated a cylindrical carrier and a correspondingly cylindrical record. Reference to the drawings of this Berliner patent will show that the apparatus was simplified to the nth degree,—quite consistently with the principle that a truly patentable method is a concept quite independent of any particular form of apparatus.

Consistently with Berliner's very commendable presentation of his method or process, he cut the apparatus down to a point at which the cylinder was to be rotated by a little hand crank L at the end of the cylinder shaft. The cylinder shaft was not even screw-threaded so as to provide a longitudinal travel of the cylinder with respect to the graving stylus. So also, the stylus and its diaphragm were shown in fixed position, and incapable, therefore, of any longitudinal travel with respect to the cylinder,—and indeed without even a mouthpiece or speaking tube.

All that Berliner endeavored to show was that his method would produce a sound groove of uniform depth but with lateral undulations corresponding with the music or with the spoken sounds which were to be recorded and reproduced. In this early method patent, he did not even show a helical groove which would make more than one circuit around the periphery of the cylinder. He showed merely a single circuit of the cylinder. The result is that, as illustrated in this early patent, No. 372,786, the groove makes but one turn around the circumference of the cylinder, and then returns upon itself (rather than moving along with each revolution to a new position, as in the case of a screw thread).

This disclosure was, however, of course made to "those skilled in the art," i. e., to those who had for ten years been familiar with Edison's phonographs as shown in his still earlier patents No. 200,521 and 227,679. These still earlier Edison patents of 1878 and 1880, disclose sound grooves running helically like a screw thread around the periphery of cylindrical records. Correspondingly, of course, there were feed screws for feeding the stylus along the cylinder, or conversely, for feeding the cylinder longitudinally with respect to the stylus.

It is inconceivable that any one skilled in the art as of the date of Berliner's 1887 patent, No. 372,786, could have thought that Berliner was limiting himself to a cylindrical record having only a single circumferential groove returning upon itself.

"Good morning—Good morning—Good morning—Good morning—Good morning * * *." This would be the sum total of the capabilities of Berliner's record as counsel for the petitioner claimed before the Court of Appeals to understand it.

Counsel attempted to excuse such an understanding and presentation of the matter by pointing to a sentence appearing at page 3, line 4, of Berliner's specification of patent 372,786, in which he says:

"Care must be taken that the two ends of the undulatory groove *y* meet exactly, as will be readily understood."

The reason for this caution was quite different, however, from that ascribed to it by petitioner's counsel. Reference to this Berliner patent 372,786 will show that the record was in the form of a flexible ribbon, which was to be wound upon and later unwound from the metal cylinder upon which it was to be carried when in use. The caution meant merely, therefore, that when this flexible ribbon-like record was re-

wound upon the cylinder, it must be wound "straight,"—so that the groove (or grooves, in the case of a helical sound record) would align itself in accordance with the alignment employed at the time of making the original record; otherwise the stylus would be led into non-consecutive parts of the sound groove in such a way as to produce a disjointed and non-consecutive rendition.

In the foregoing discussion of the disclosure of Berliner's patent 372,786, we have given ourselves a little latitude,—by attempting to apply a little common sense involving the teachings of the phonograph art, which at the date of Berliner's earliest patent was already ten years old. It is not necessary, however, to rely upon even a grain of common sense in order to arrive at the same conclusion. This is for the reason that there was still another Berliner patent, No. 382,790, which also is referred to in Judge Lindley's opinion in this case. This patent 382,790 was granted to Berliner in 1888. In his specification, he says,

"In a patent granted to me November 8, 1887, No. 372,786, I have described a method of recording and reproducing spoken words and other sounds; and in connection therewith and as a part thereof, I have described a process of producing a record of sound waves in solid resisting material by photo-engraving, the phonautographic record of such sound waves having first been produced as an undulatory line of even depth in a traveling layer of non-resisting material." (Page 1, line 8.)

In this second patent, Berliner then goes on to say:

"My present invention is an improvement upon that described in my aforesaid patent; and it has for its object the production of a record of sound waves in solid resisting material, principally, metal, by the process of direct etching," etc.

He then points out that this improved process may be applied "either upon a flat or upon a curved surface" (page 1, lines 19 to 27), i. e., upon either a disc tablet or upon a

cylindrical tablet. Indeed, he goes on to refer expressly and repeatedly to these two forms of tablets, saying, for example:

“The surface which is intended to receive this ground, which may be a flat disc or a cylinder of metal or glass, should be smoothly polished, and must be cleansed and dried,” etc. (Page 1, lines 70 to 73.)

He refers repeatedly also to the “grooves” (plural) of the record, and to “the lines” upon the record, and to “the progress of the record,”—all making it perfectly clear that he was concerned with a continuing helical or screw-thread-like groove in the case of a cylindrical record, and with a continuous spiral groove in the case of a disc record. (Page 2, column 2, of patent No. 382,790.)

Let us turn for a moment now to another patent, more or less contemporaneous with these earlier Berliner patents, namely, that of Bell and Tainter, No. 241,214, issued on May 4, 1886. Let us look, for example, at Figure 2 on Sheet 1 of the drawings, or at Figure 18 on Sheet 2. Here there are clear and unmistakable disclosures of phonographs employing disc records with spiral grooves. The sound grooves in this case were formed by

“cutting or engraving the record in the form of a groove with sloping walls, the sound waves being represented by elevations and depressions at the bottom of the groove or otherwise. *The advantage of this form of record is that it forms an efficient guide to the reproducing style.*” (Page 1, lines 76 to 83.)

The word “otherwise” of the above quotation would of course include the laterally undulatory groove of Berliner as well as the vertically undulating groove which Bell and Tainter more particularly disclosed. For the moment, we are stressing Bell and Tainter to the effect merely that they described and elaborately pictured disc records having spiral sound grooves. The language of Berliner’s claim No. 35, which was involved in the Leeds & Catlin suit, reads

squarely and unequivocally upon the record which is illustrated and described in the Bell and Tainter patent, for the reason that Berliner's claim makes no distinction between lateral undulations and vertical undulations, or indeed between records of the disc form and records of the cylinder form. It will be remembered in this connection that the language of the claim is, "a traveling tablet having a sound record formed thereon." It is impossible in the light of the Bell and Tainter patent to maintain the position taken by counsel for the petitioner, to the effect that the record part of the Berliner patent involved in the Leeds & Catlin case was a separately new and patentable element.

The above quotation from the Bell and Tainter patent is interesting, however, in another respect, because it bears upon Judge Lindley's analysis of the scope and character of the invention of the later Berliner patent, No. 534,543, which was involved in the Leeds & Catlin case.

As indicated by our emphasis in the last preceding quotation from the Bell and Tainter patent, one of the advantages of the spiral groove disc record which is referred to in the specification and illustrated in the drawings, was that this kind of a record "forms an efficient guide to the reproducing style."

In order to determine just what constituted the advance over the prior art as represented by Berliner's patent 534,543, let us consider a little further the disclosure of the Bell and Tainter patent.

The graving or record cutting stylus 11 is shown in association with diaphragm H in the mounting 20 (Figures 1 and 2).

The reproducing diaphragm and stylus (K, Figure 8 or Figure 13, Sheet 2) are adapted to be substituted in the mounting 20 for the graving stylus.

The rotating table for the record disc was associated with

a feed screw, geared to the record table in such a way that when the record tablet was rotated, its axis was also moved slowly and steadily in a lateral direction. The result was that the graving stylus cut a spiral groove in the face of the record.

So, also, when the sounds were to be reproduced, the disc or tablet was not only rotated but was also slowly moved sidewise in such a way that it would have maintained a fixed stylus within the spiral sound groove.

However, as said by Bell and Tainter (page 1, line 84, *et seq.*):

"The invention consists, fourthly, in loosely mounting the reproducing-style so that it can readily be guided by the record. Preferably the reproducing style, or rather what may be called the 'head' of the reproducing instrument is mounted on an universal joint, and the style is pressed against the record by the yielding pressure of a spring or weight. Practically in the instruments made by us the pressure is due to the weight of the instrument, modified by the elasticity of a section of soft-rubber tube, which supports the same and constitutes a universal joint; but evidently there are many devices which can be used to mount the reproducer, so that it is free to follow the sound record or phonogram, and which, therefore, would be within the spirit of the invention. The reproducing-style, mounted as just explained, is specially adapted for use in connection with a record in the form of a groove with sloping walls, and this combination is specially claimed; but it may also be usefully employed in connection with other forms of record."

And relative to the reproducer K (Page 4, line 55, *et seq.*):

"For use the tube 33 is slipped into the tube 19 in the manner shown for the tube 18 of the recorder.

"The reproducer K when so placed is mounted upon a hollow standard composed of the tubes or tubing 31, 32, 33, and 19, and in consequence of the flexibility of the rubber tubing 32 it is free to follow the record. No special care is necessary to insure its adjustment, for

if the reproducer K be allowed to rest against the record with the style upon the engraved line the style will of itself gravitate to the bottom of the groove.

"There exists always a liability to disarrangement in some part of the machine either in the recorder or the support therefor or the recording-tablet or its support, or if there be no disarrangement it would be difficult to insure that the reproducing-style should touch the record precisely at the proper point if the reproducer be held rigidly. Difficulties on these accounts are avoided by the loose or flexible mounting of the reproducer, the style automatically adjusting itself to the proper place on the record. It will be seen that the reproducer is mounted on a universal joint, so that it can move in any direction. The movement parallel with the face of the tablet, would, however, by itself allow the style to follow and adjust itself to the record to a useful extent."

Relative to Figure 13, Bell and Tainter say (page 5, lines 57-65) :

"In this machine the reproducer K, instead of being mounted on the same bracket as the recorder when the latter has been removed, is carried by a separate bracket, 72, the tube 33 being hinged thereto, so that the recorder and reproducer remain, or may remain, always attached to the machine, it only being necessary to turn one or the other into position, as may be required."

As shown in this Figure 13, the reproducer K is mounted upon a pivoted tone arm in such a way that its stylus could follow the groove in the record tablet to some extent. However, in the machine as disclosed, the record tablet supporting plate has its axis shifted laterally as the record is being played, so that the only function of this mounting as actually used, was to permit the stylus automatically to follow the groove to the extent necessary to compensate for minor irregularities or eccentricities in the groove.

Now, as compared with Bell and Tainter, the Berliner invention of patent 534,543, which was involved in the Leeds

& Catlin case, consisted in permitting the stylus of the reproducer to be propelled by and along the sound groove of the record tablet all the way from its outer periphery to its inner end. For accomplishing this purpose the required mechanical structure was a mounting for the reproducer which would permit it to travel freely throughout the necessary distance from the periphery to the center of the record tablet. In the light, therefore, of the Bell and Tainter patent, Berliner's invention, as defined in claims 5 and 35, resided in giving the reproducer a greater degree of freedom of movement to follow the groove in the record tablet, and by this, eliminating the necessity of providing means (i. e. the screw feed) for relatively shifting the record tablet and reproducer.

It is inescapably clear, therefore, that in and of itself, there was nothing new in or about the disc record or tablet described in the specification of the Berliner patent 534,543.

Even the precise form of the laterally undulating sound groove was several years old in and by the issue of the earlier Berliner patents to which we have referred. Claim 35 of the Berliner patent, which was involved in the suit of *Leeds & Catlin v. Victor*, did not, however, contain any limitation to the laterally undulating groove. The claim was very definitely broad enough to include disc records or tablets having sound records formed thereon, either by a spiral groove of the laterally undulatory type or of the vertically undulatory type. The broad language of the claim in respect of the disc record was merely "a traveling tablet having a sound record formed thereon." In and of itself, such a disc record or tablet was old and well known in two different forms, long prior to the application for the Berliner patent involved in the *Leeds & Catlin* suit. It was old and well-known also in the form of a cylindrical tablet.

The claims in suit against Leeds & Catlin read directly upon Bell and Tainter patent No. 341,214 in everything except the unrestricted pivotal mounting, and therefore the freedom of the reproducer stylus to be propelled all the way across the face of the record disc solely by the spiral sound groove in the face of the record.

That the above is a full and correct statement of the invention of claims 5 and 35 of the Berliner patent No. 534,543 is shown by the opinions of the various courts which passed upon the matter.

We invite your Honors' attention particularly to the opinion of Judge Hazel in the original case in the Circuit Court, 140 Fed. 860, 863. We invite your Honors' attention to Judge Hough's majority opinion for the Second Circuit Court of Appeals in *Leeds & Catlin v. Victor*, 154 Fed. 58, and particularly to his description of the invention of claims 5 and 35 of the Berliner patent.

The Supreme Court of course affirmed Judge Hough's majority opinion. The precise point and effect of the Supreme Court's affirmance cannot, however, be more clearly brought to light than by reading the brisk opinion in which his Honor Judge Wallace dissented from the majority in the Second Circuit Court of Appeals. The unanimous opinion of the Supreme Court overruled the dissenting opinion of Judge Wallace and affirmed the majority opinion of Judge Hough and Judge Coxe. Judge Hough's majority opinion, which was affirmed by the Supreme Court, did not leave any room for doubt as to the nature of the question which the Circuit Court had decided (154 Fed. 60). Judge Hough's opinion had made it clear that the Leeds & Catlin records were capable of use in a non-infringing way with feed screw machines (154 Fed. 59).

A thorough-going study of the record in the Leeds & Catlin case confirms the accuracy of Judge Lindley's understanding and discussion of it.

The Real Distinction Between the Leeds & Catlin Case on the One Hand and the Carbice and Leitch vs. Barber Cases on the Other Hand, Does Not Involve the Distinction Between the Sale of a New and Separately Patentable Element in the One Case and the Sale of an Old and Separately Unpatentable Element in the Other Cases, as Contended by the Petitioner. It Depends Wholly Upon the Radical Difference Between the Business Methods Which the Victor Company Employed in the Use of Its Patent and the Business Methods Employed by the Dry Ice Company and by the Barber Company in the Use of Their Patents.

The Business Methods Employed by the Stewart-Warner Corporation in the Use of Its Patent Are Identical With Those Employed by the Victor Company.

Our excuse for this long discussion of the facts of the Leeds & Catlin case is that it leads inevitably to the conclusion that the record or tablet element as described in Berliner's claim and as sold by Leeds & Catlin, was a thoroughly "old" element in and of itself for several years prior to the application for the Berliner patent 534,543, which was involved in the Leeds & Catlin case.

It is impossible, therefore, to agree with counsel for the petitioner as to the distinction between the Carbice and Barber cases on the one hand, and the Leeds & Catlin case on the other hand.

In all of these cases, the defendant was engaged in the sale of an element or thing which was separately old and unpatentable.

We have heretofore sufficiently indicated the real distinction between the Leeds & Catlin case and the Carbice and Barber Asphalt cases. It lay in the wholly different methods by which the patent owners attempted to "use their patents."

There was nothing in or about the Victor Company's conduct of its business of manufacturing and selling the whole of the invention of the Berliner patent, which could have caused the Court to refuse relief upon such grounds as were invoked in the Carbice and Barber Asphalt cases.

There is nothing in or about the Stewart-Warner Company's conduct of its business of manufacturing and selling the whole of the invention of the Butler patent, which should cause the Court to refuse relief upon such grounds as were invoked in the Carbice and Barber Asphalt cases.

Leeds & Catlin were enjoined against the further sale of records which in and of themselves were old and unpatentable. Counsel for the petitioner say that the headed nipples manufactured and sold by the Lincoln Engineering Company are in and of themselves old and unpatentable. Even if we were to accept this contention, without any reservations whatsoever, there is still nothing in or about the law of the Carbice and Barber Asphalt cases which would warrant a refusal to relieve the respondent of the competition of the Lincoln Company.

Our long discussion of the Leeds & Catlin case brings us to a point at which we may advantageously consider the petitioner's contention that the present case is ruled by the decision of this Court in the case of *Rogers vs. Alemite*.

II.

THE HEADED NIPPLE IS A NECESSARY AND PROPER ELEMENT OF THE COMBINATION INVENTED BY MR. BUTLER. WHEN COMBINED WITH THE OTHER ELEMENTS OF BUTLER'S COMBINATION, THE HEADED NIPPLE HAS NEW FUNCTIONS AND NEW COACTIONS WHICH NO HEADED NIPPLE EVER HAD HAD BEFORE THE DATE OF BUTLER'S INVENTION. THE HEADED NIPPLE CONTRIBUTES ITS NEW AND ESSENTIAL FACTOR OF COOPERATION TOWARD THE ACCOMPLISHMENT OF A WHOLLY NEW AND UNITARY AND ADVANTAGEOUS RESULT.

Why was it that the separately old and unpatentable phonograph record of the combination claim of Berliner's patent No. 534,543 could be included as an element of the combination claim which was held to be valid and enforceable in the Leeds & Catlin case?

It was because of the fact that when the old record was combined with a phonograph machine having a stylus which was mounted in such a way as to be free to be swung or propelled across the face of the record by the sound groove of the record, that record took on a new function which it never before had had. This new function was that of propelling the stylus and its associated diaphragm and tone arm. There was a new mode of operation, a new coaction, a new and unitary result.

Why is it that Butler's headed nipple may properly be included as an element of his combination?

It is for identically similar reasons. The headed nipples of the petitioner, like the headed nipples of the respondent, were specially designed, formed and dimensioned for precise and exact cooperation with the other parts of the Butler

combination as manufactured and sold by the respondent. They differed in all of these details from any headed nipple which had previously been known. But even if the headed nipples manufactured and sold by the petitioner could be considered as separately old and unpatentable, (and we agree that they were separately unpatentable because they would have had no new functions except in, and as a part of, the new combination) still they were properly and necessarily included as an element of the new combination. This is for the reason that the other parts of the combination required the presence and the coaction of the nipple in order to enable them to work at all, and more particularly because the headed nipple, when included as an element of Butler's new combination, had new functions, new coactions, new results, different from anything which any headed nipple had ever before experienced.

We have previously described some of these new coactions and results.

This new mode of operation, these new coactions, these new functions, were rather fully stressed and described in Judge Lindley's several opinions. Judge Lindley's opinions were in turn adopted and stressed in the opinion of the Court of Appeals.

As we have previously pointed out, the coupler mechanism of Butler's patent cannot respond to the grease pumping action of the associated compressor in such a way as automatically to establish a mechanical grip and a grease-tight seal between the two halves of the connector mechanism, except as the headed nipple has brought about a cocking or pre-setting of the coupler mechanism. This cocking operation, this pre-setting function, were things in which no headed nipple had theretofore participated. No headed nipple had previously cooperated in these ways or had contributed any such part in the accomplishment of any result whatsoever.

In our opinion it never would have occurred to anyone to question the propriety of including the headed nipple as one element of Butler's combination claim, except for the fact that the exigencies of the business of selling lubricating equipment of this type make it necessary for the manufacturer to price and sell the nipple parts separately from the compressor and coupler parts. (Indeed, it is only the need of supplying such assortments of the several parts as required by the respondent's customers which provides the opportunity for such contributory infringement as has been engaged in by the petitioner.)

In presenting many of their arguments, counsel for the petitioner entirely disregard claim 2 of Butler's patent as it really is, and assert that the Butler patent in suit claims the combination of

"the patentee's assertedly improved coupler and the old-style grease-cup and old-style pump". (Petitioner's brief p. 66)

What the petitioner does is to segregate and lump together five of the seven elements of the claim, and then to "concede" for their own purposes, that novelty (and, by inference, patentability) are to be found only within the confines of this five-element group, *i. e.*, within the confines of the coupler only.

Why, however, should there be any such division between, and regrouping of, the seven elements of the claim? All of the elements cooperate in new ways in producing one single and unitary result. Each contributes its part in the accomplishment of that result. Each element acts and reacts in such a way as to modify and affect the operation of every other element.

The reason why petitioner's counsel split off a sub-group of five elements and assert that the novelty and patentability of the Butler invention, if any, inheres in this lesser

group of elements, is that petitioner's counsel are anxious to have the court believe that Butler is attempting to appropriate and "monopolize" some allegedly old prior art device,—contrary, as they appear to believe, to the rules of the Carbice and Barber cases. Throughout their brief petitioner's counsel refer to the plaintiff's attempted "monopoly" of old-style nipples, and to the attempt of the respondent to "monopolize" such devices. It is for this reason only that the petitioner segregates the one element which it wishes to make and sell and then asserts that the "headed nipple" of claim 2 is any "old-style headed nipple",—whereas the real invention of the Butler patent inheres in the five elements of the coupler. And this, despite the fact that the coupler parts cannot begin to do their work until after the headed nipple has cocked and set them for that work.

Counsel would then have it appear that it is any and every "old-style nipple" which the plaintiff is seeking to "monopolize". Counsel would have it appear that this would-be "monopoly", has no relationship to the use of a very special and particular nipple which was never made or sold at all until the advent of the Butler invention upon the market and which was specially adapted for coaction and cooperation with the other six elements of Butler's claim, but that the proposed monopoly shall preclude the public from the free use of any old-style headed nipple in any of the situations or relationships in which "headed nipples" of various other kinds and forms have been freely used for decades.

This is a novel and ludicrous way of reading patent claims. The "headed nipple" of Butler is not just "any old headed nipple" any more than it is the nipple of a cow. The other parts of Butler's claim make it quite clear that Butler does not mean the nipple of a cow. The other parts of the claim tell us inferentially but clearly and defi-

nitely how Butler's nipple is to be formed and constructed so as to cooperate with the remaining six elements of the claim. The petitioner apparently is willing to agree that the remaining language of claim 2 is sufficient to indicate that Butler did not have in mind a bovine nipple or a "headed nipple" for feeding a baby. Petitioner's counsel do insist, however, upon stopping short of the logical conclusion which flows from their attempted reading of Butler's claim. They do not wish the absurdity of their argument to be made too apparent by carrying it to its ultimate conclusion. To avoid any *reductio ad absurdum* they are forced to concede that Butler does not mean literally "any old" nipple, but rather some more or less specific kind of a "headed nipple."

If, however, the petitioner's reasoning and analysis were to be followed consistently, it could be equally well urged that Butler included in his claim not only "any old-style headed nipple" and "any old-style compressor" but also "any old-style cylinder," "any old-style piston," "any old-style aperture," and any "old-style jaws". If the petitioner were seeking to exculpate itself from a charge of contributory infringement by manufacturing parts other than the headed nipples of Butler's claim 2, it would then make the same argument as to any of these other parts. Thus, if the defendant chose to make the cylinder, it would say that Butler's claim 2 does not specify any particular kind of a cylinder,—all that it specifies is "any old-style cylinder". Then the defendant would point to the cylinders of locomotives, ice cream freezers and tin cans generally, and say,

"Butler did not specify any particular kind of cylinder; Butler didn't invent cylinders; cylinders were old in the art; what Butler has done is to attempt to achieve an illegal monopoly of cylinders by the inclusion of 'any old cylinder' in his claim."

Under such circumstances, petitioner's counsel would

urge that the "asserted novelty" of Butler resided somewhere in or among the remaining elements of the combination,—that the old cylinder remains simply an old cylinder,—"a part of the public domain" etc.

Or again, the defendant-petitioner might manufacture the piston. Under such circumstances, the petitioner would excuse itself by saying that the only description of the piston is that it be "movable within the cylinder"; that "any old piston" is, of course, movable in its cylinder; that pistons are old in all sorts of mechanical appliances; that the plaintiff is seeking an illegal monopoly of pistons; that the novelty resides elsewhere; and that the respondent's patent must fall.

This analysis of the petitioner's position is not far-fetched,—it is simply the logical conclusion which results from the petitioner's erroneous assumption that when Butler says "headed nipple", he means "any old-style headed nipple", whereas what he really means by any customary or accepted method of reading or interpreting patent claims, is just such a "headed nipple" as will operate and cooperate with the six remaining elements of the combination,—and no other.

The opinions of the lower courts describe the characteristics and attributes of *the "headed nipple"* of Butler's claim. These attributes and characteristics of the "headed nipple for receiving lubricant" of Butler's claim 2 permeate the entire claim. They do not leave the distinctions in co-operative action wholly to inference (as, indeed, however, would be amply sufficient). Let us quote the claim and indicate by bold face emphasis how completely the special characteristics of the "headed nipple" do permeate the entire claim:

"The combination with a headed nipple for receiving lubricant, of a lubricant compressor having a cou-

pling member for connecting said compressor and nipple comprising a cylinder, a piston movable within the cylinder, and having an aperture for the discharge of lubricant thereof (therethrough), an apertured sealing seat carried by said piston for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple, radially movable locking elements carried by the cylinder coacting with the nipple and actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts."

The petitioner's brief is pervaded with the inferences and assertions that it is the respondent's purpose in some substantive way to monopolize really prior art devices because of the use in Butler's patent claim of words which can be applied to devices of the prior art. The respondent does not, of course, have any such purpose or intention. The respondent's position and contention does not ask for any such ruling or result at the hands of the court.

Opposite page 16 of their brief, petitioner's counsel parade a multiplicity of fragments of prior art machines and devices of various kinds, all snatched out of their mechanical contexts and then enlarged or diminished in size in such various ways as will make them have the appearance of being similar in some respects to the nipple of the Butler combination, and similar in some respects, therefore, to the nipples sold by the petitioner for (now admitted) use with the other parts of the Butler combination as incorporated in the respondent's "Alemite Hydraulic" equipment of the Butler patent. These are the "old-style headed nipples" which it is said that the respondent proposes now to "monopolize".

Some of these prior art fragments are essentially like the mine car oil cups shown to have been manufactured and sold by the Lincoln Engineering Company itself as

early as 1922 and more or less continuously from that date down to the present time (R. p. 77).

It is an interesting commentary upon the brief of petitioner's counsel that while the defendant protests vehemently against the suppositious evil intentions and legal claims of the respondent to monopolize such prior art nipples, still the petitioner has been manufacturing and selling, and will continue to manufacture and sell with impunity, headed nipples essentially like some of those shown in the parade chart opposite page 16,—for use, of course, in other situations and in other combinations. And the defendant will, of course, continue to do so. These mine car fittings thus long manufactured and sold by the petitioner could not conceivably be used with an Alemite Hydraulic coupler, nor with any other form of Butler's coupler. Obviously, there was no intention when the petitioner made and sold such fittings that they should be used in this or in any other infringing way. They are so constructed and so formed that they are not the "headed nipples" called for in claim 2 of the Butler patent.

The manufacture and sale of these obviously immune mine car "headed nipples" is something quite different and aside from the petitioner's manufacture and sale of the "headed nipples" of claim 2 of the Butler patent against which the respondent does complain.

The Essence of the Distinction Between the True Combination of Butler's Claim 2 in the Instant Suit, and the Unenforceable Aggregations of the Gullborg Patent as Determined in *Rogers v. Alemite*, 298 U. S. 415.

The petitioner's arguments bring us now again to the decision of the Supreme Court in the cases of *Rogers v. Alemite* and *Bassick v. Hollingshead* (298 U. S. 415, 80 L. Ed. 782).

We have previously discussed this case with respect to

the petitioner's attempt to show that the Supreme Court has recently and in effect abolished the long-established and applied rule and law of contributory infringement. We found, however, that this case went off on grounds which did not involve any consideration of the law or attributes of contributory infringement.

We come back now to this case of *Rogers v. Alemite* in connection with the petitioner's attempt to convince your Honors that claim 2 of the Butler patent is invalid or unenforceable for the same reasons as those which were applied by the Court in deciding the case of *Rogers v. Alemite*.

We have shown that the "headed nipple" was a proper and necessary element of Butler's combination claim for reasons substantially identical with those why the phonograph record was a proper and necessary part of Berliner's combination claim involved in *Leeds & Catlin v. Victor*.

It is to be recalled at the outset that the opinion of the Court in the Rogers case practically reaffirmed the law of the Leeds & Catlin case. This was done by citing and distinguishing it. In his opinion in the instant case, his Honor Judge Lindley referred categorically to the distinctions of the Leeds & Catlin case as enumerated in the opinion by Mr. Justice Roberts, and then categorically applied these distinctions to the facts of this suit upon the Butler patent.

There is one phrase in Mr. Justice Roberts' opinion in the Rogers and Hollingshead cases which reconciles the opinion in those cases with the re-affirmation of the decision in the Leeds & Catlin case. It is a phrase which belies the use which counsel for the petitioner seek to make of the Supreme Court's opinion. It is a phrase which counsel for the petitioner do not dare to discuss,—and yet it is *the* phrase which provides the key to the entire situation.

We refer to the phrase which we now emphasize in our repetition of the question posed in the opinion by Mr. Justice Roberts in the Hollingshead and Rogers cases:

"The question then is whether, by this method, the patentee by improving one element of an old combination *whose construction and operation is otherwise unchanged*, may, in effect, re-patent the old combination by reclaiming it with the improved element substituted for the old element."

"Whose construction and operation is otherwise unchanged"!

In the Rogers case the Court had found the fact to be that the combination of a compressor, a bayonet coupler, and some kind of a bayonet pin fitting, was old and well-known in the art. The finding of fact was that in this combination Gullborg had merely substituted an improved form of pin fitting, *i. e.*, a pin fitting having a cross pin, in lieu of a fitting having pin-like lugs projecting from opposite sides of the fitting. The fact was, furthermore, that Gullborg's improved pin fitting had been separately described and claimed in his earlier patent No. 1,307,733. The question then was whether the substitution of Gullborg's improved pin fitting in the old combination gave rise to any new construction or operation of the old coupler and compressor parts.

The Court held that the operation of the compressor and coupler parts was identically the same when used with Gullborg's improved pin fitting as when used with the older lug-type fitting.

In the present case we have a very different situation. In testing the applicability of the rule of the Rogers case, we are to assume (rightly or wrongly) that the headed nipple of Butler's combination is old. We are to assume, perhaps, that this headed nipple had previously been used with some coupler mechanism, as, for example, that of the

Seng patent (R. p. 542). In the coupler of the Seng patent the engagement and disengagement as between the nipple and the coupler parts was effected wholly by a manual operation of the coupler mechanism. The nipple had no part in the operation of the coupler mechanism. Its manual operation could be effected in precisely the same way regardless whether the nipple was associated with the coupler mechanism or whether it was laid completely to one side. When in Seng's coupler the sleeve *b* is manually pushed upwardly, the balls *i* will be moved inwardly. When, on the other hand, the sleeve *b* is manually pulled downwardly, the balls *i* will move outwardly. The presence or absence of the nipple has nothing whatsoever to do with these operations. The nipple does not contribute in any way to the operation.

In the invention of the Butler patent, the coupler mechanism does not require any manual actuation whatsoever. Its operation is entirely automatic. That automatic operation is utterly dependent, however, upon a certain action and coaction by the headed nipple. The automatic gripping cannot occur at all unless the piston mechanism has first been cocked or set, *i. e.*, returned to its innermost position. This is for the reason that the piston cannot be moved forwardly to effect the gripping operation unless it has first been brought back to its starting position. This cocking or resetting of the piston mechanism is automatically effected by the headed nipple during its disengagement from the coupler half of the combination. Furthermore, if the coupling mechanism has lost its "preset," during the interval between its disconnection from one nipple and its connection with another, then the second nipple will bring about this cocking or presetting of the piston mechanism of the coupler during the initial engagement between the coupler parts and the nipple parts,—that is to say, during the slipping of the head of the nipple into the space between

the jaws of the coupler prior to the subsequent operation of the compressor while in the act of forcing grease into the coupler and thence on into the interstices of the bearing to be lubricated.

The combination was a new one. The operation was new. The automatic gripping and automatic and more or less independent end sealing were new. The result was new. The new mode of operation and the new result were accomplished by the appropriate coactions of all of the parts. In all of these new coactions, the nipple played just as prominent and just as important a part as did any or all of the elements of the complete combination. The headed nipple contributed just as much to the new result as did any other part.

Such things as these are the test of a true and patentable combination as distinguished from an unpatentable aggregation, all as elaborately and effectively set forth in the convincingly clear opinion of his Honor Judge Evans, speaking for the Seventh Circuit Court of Appeals in the instant case.

The books afforded numerous illustrations of such mere aggregations as this Court held to have been described in claims 14 and 15 of the Gullborg patent which was involved in the case of *Rogers v. Alemite*. The Supreme Court held, relative to claims 14 and 15 of the Gullborg patent, that they involved such a mere aggregation;—indeed such an extreme case of aggregation as to have involved substantially an attempted double patenting in No. 1,307,734 of the real invention which was described in Gullborg's earlier patent No. 1,307,733.

The question formulated by Mr. Justice Roberts in his opinion in the Rogers case, expressly recognizes and inferentially states that when the construction or operation of the old elements of the combination are changed as a

result of their association with other elements (or the addition or substitution of one or more new elements), then the new assembly becomes a true and patentable combination and as such, subject to the rules laid down in Mr. Justice McKenna's famous definitions in the *Leeds & Catlin* cases.

His Honor Judge Thacher, while sitting in the United States District Court for the Southern District of New York in the case of *Bassick v. Adams*, 39 Fed. (2d) 904, had occasion to consider claims 14 and 15 of the Gullborg patent, which was subsequently involved in the case of *Rogers v. Alemite*. He reached the same conclusion as that subsequently reached by this Court, and in so doing, said:

"I am satisfied that claims 14 and 15 cannot be so broadly read as to include any old grease gun connected by any old bayonet coupler to one of the plaintiff's patented pin fittings. This conclusion follows from a consideration of what, if anything, can be said to be novel in such a combination. So far as the coupler and grease gun are concerned, we start with the concession that they are old. Whether they can properly be claimed in combination with the pin fitting must therefore depend upon their functional relation to the pin fitting. If that relation is such that, either in making the detachable connection with the fitting or in delivering the grease, a new function is performed or a new result accomplished, then the combination claims must be construed to include that as part of the invention embodied in the combination, and not merely in one of its members. If, on the other hand, novelty is found only in the specific form of the fitting, and if the function which it performs in making the detachable connection with the coupler and in receiving the grease is old, the combination claims must be limited upon Gullborg's disclosure to a combination including a coupler having the novel features disclosed in his specification."

Judge Thacher went on to reach the conclusion

"that there was no functional novelty in combining such a pin fitting with a bayonet coupler and a grease

gun. The old combination of the gun, the bayonet coupler, and the pin fitting with ball and spring valve, would work as well and accomplish precisely the same result. To extend the combination claims to cover the use of any old gun and any old coupler on a Gullborg fitting, is clearly not permissible in view of the prior art which limits novelty in the pin fitting to a specific form of construction, and deprives the aggregation of elements of all patentable novelty as a combination."

We recur to Judge Thacher's statement of the test. Relative to the coupler and grease gun of the Gullborg patent, he said:

"Whether they can properly be claimed in combination with the pin fitting must therefore depend upon their functional relation to the pin fitting. If that relation is such that either in making the detachable connection with the fitting or in delivering the grease, a new function is performed or a new result is accomplished, then the combination claims must be construed to include that (*i. e.*, the coupler and grease gun) as part of the invention embodied in the combination."

We respectfully submit that Judge Thacher very clearly and effectively stated the rule. This Court subsequently determined that Judge Thacher was right in his application of it to claims 14 and 15 of the Gullborg patent.

We respectfully submit that the assembly of elements enumerated in claim 2 of the Butler patent in suit, exactly and completely meets the test of a true combination as stated by Judge Thacher. Because of its cooperative association with the compressor and coupler mechanism, the headed nipple of the Butler combination performs new functions and participates in the accomplishment of a new result.

The test as formulated and so clearly stated by Judge Thacher, applies to the combination of claim 35 of the Berliner patent, involved in the Leeds & Catlin case. Because

of its association with the phonograph machine having the freely mounted tone arm and stylus, the old record performed the new function of propelling the stylus and its tone arm. It thus participated in the accomplishment of a new result. When measured by this test or by any fair test, the old and well-known disc record was a necessary and appropriate part of Berliner's combination. When measured by this test or by any fair test, the headed nipple (old and well-known, if such it be) was a necessary and appropriate part of Butler's combination. In so far as the inclusion of the record in the one case and the inclusion of the headed nipple in the other case, we can think of no distinction which would appropriately make one a proper part of the one combination without making the other an equally appropriate part of the other combination.

In the case of *Rogers v. Alemite*, it was held that claims 14 and 15 did not, in the light of the prior Gullborg patent No. 1,307,733, describe a true combination which was patentably distinct from the Gullborg pin fitting *per se*. Since claims 14 and 15 were held to be bad, and therefore unenforceable in any aspect, there was no determination which hinged upon any question of contributory infringement.

Claim 2 of the Butler patent does, in accordance with every recognized and authoritative test, meet the requirements of a true and patentable combination. Butler's claim to such a combination is entitled to such enforcement as is accorded to any other claim which describes a true and meritorious invention.

The owner of the Butler patent is entitled to just such protection against contributory infringement as is the owner of any patent containing a claim to a new and true combination. The respondent is entitled to the same protection against the competitive sale of the headed nipple part of the combination as it is against the competitive

sale of the cylinder part or the piston part, or any or all of the so-called "coupler parts" of the combination.

It was the new functions and attributes of the headed nipple part of the Butler combination, when combined with the other parts of the connector mechanism, to which his Honor Judge Lindley referred when, in his first opinion, he said:

"The headed nipple which cooperates with the sealing seat and jaws of the coupler and thus with the piston and cylinder, is just as essential a part of the Butler invention as any of the several elements of the coupler. There is cooperation between the nipple and the jaws which produces the operation of the seal, which in turn effectuates the operation of the gripping jaws, making possible heretofore unachieved pressures. The headed nipple has new functions arising out of direct cooperation with the jaws. The head spreads the jaws of the coupler when the latter is attached and thus prepares the coupler for operation in bringing about a mechanically strong and lubricant tight joint. In detaching the coupler the head of the nipple engages and pushes the jaws outwardly. These in turn push the piston backward, thereby effecting the release of the coupler from the nipple. The presence and the action of the nipple are essential, because the nipple alone makes it possible to build up in the cylinder of the coupler a grease pressure which will force the jaws into gripping enforcement with the nipple. The nipple is not merely a receptacle. It becomes an element which coacts to influence and make possible the desired operation of the coupler mechanism.

"Butler was the first to utilize a headed nipple and a compressor as cooperating elements of a combination whereby a grease tight and mechanically strong connection between compressor and bearing were effected automatically in and by the grease pumping operation of the compressor alone.

"The high pressure delivery of grease from the compressor to the interior of the bearing, due to the strong and grease-tight attachment of the grease gun to the grease passageway of the bearing, was a new, useful and unitary result. It could not be accomplished with

anything less than the combination of all of the elements included in Butler. Each part of the combination performed new functions and operated and co-operated in new ways in order to accomplish the single new result. The invention of Butler resides in the combination and not in one specific element. Every one of the seven old elements' functions became essential factors in the new combination. The situation is not one where the language of the Supreme Court in the Gullborg case is applicable, for in the sense that the Supreme Court used the term pioneer, Butler is equally a pioneer. A completely new unitary result is achieved, — something never accomplished before. Just as the Supreme Court said of the Berliner patent, 'every element is necessary to the operation of the other.' "

(Judge Lindley's Opinion of July 15, 1936,
R. pp. 616-617) 15 Fed. Supp. 571.

III.

THE LUBRICATING APPARATUS MANUFACTURED AND SOLD BY THE RESPONDENT, STEWART-WARNER CORPORATION, DOES EMBODY THE INVENTION OF CLAIM 2 OF THE BUTLER PATENT IN SUIT. THE COMBINATION OF THE PETITIONER'S HEADED NIPPLE WITH THE OTHER PARTS OF THE COMBINATION AS MANUFACTURED AND SOLD BY THE STEWART-WARNER CORPORATION, EMBODIES THE INVENTION OF CLAIM 2 OF THE BUTLER PATENT IN SUBSTANTIALLY THE SAME WAY. THE LINCOLN COMPANY'S SALE OF THE HEADED NIPPLE PART OF THE COMBINATION, WITH THE KNOWLEDGE AND INTENT THAT THE USER SHALL COMBINE IT WITH THE OTHER PARTS AS FURNISHED BY STEWART-WARNER, IS A CONTRIBUTORY INFRINGEMENT OF THE BUTLER PATENT IN SUIT.

Claim 2 of the Butler patent reads clearly and word for word on the combination of the petitioner's nipple part and the respondent's hydraulic compressor and coupler parts. The petitioner seeks to avoid infringement by reading additional limitations into Butler's claim 2 so that the coupler part of this claim does not apply to the Respondent's hydraulic coupler. The evidence in this case persuasively shows that Butler's claim 2 is valid as allowed by the Patent Office, and that there is no justification whatsoever for limiting this claim in the manner contended for by petitioner.

The petitioner does not base its argument for reading additional limitations into the claim in suit upon any evidence adduced in this case. Instead, petitioner claims to rely upon the decision of the Eighth Circuit Court of Appeals in *Stewart-Warner v. Jiffy*, 81 Fed. (2d) 786. The

fact is that petitioner's argument is not even in harmony with the decision in *Stewart-Warner v. Jiffy*. In our answer to the argument advanced by petitioner on this point we propose to show:

- (a) That petitioner's argument is not consistent with the holding of the Eighth Circuit Court of Appeals in *Stewart-Warner v. Jiffy*;
- (b) That the decision in *Stewart-Warner v. Jiffy* was based upon a conceded misunderstanding of the Butler invention;
- (c) That the decision of the Eighth Circuit Court of Appeals in *Stewart-Warner v. Jiffy* is in conflict with the views of the Patent Office experts, whereas the decision of the Seventh Circuit Court of Appeals in the instant case conforms to the views of the Patent Office; and
- (d) That the petitioner's own evidence in this case practically estops the petitioner from urging the correctness of what is claimed to have been the decision of the Eighth Circuit Court of Appeals in *Stewart-Warner v. Jiffy*. The decisions of the Seventh Circuit Court of Appeals and of the Patent Office are correct.

The decision of the Eighth Circuit Court of Appeals in *Stewart-Warner v. Jiffy* held that claim 1 of the Butler patent, which was the only claim there in suit, must be limited to a coupler having spring fingers. The claim itself is not so limited. Claim 2 of the Butler patent, which is here in suit, differs from claim 1 in being directed to a headed nipple, and its co-operative relationship with the other elements of the combination. Claim 2 is not limited to a coupler having spring fingers. We shall first discuss the structure and function of that part of the Butler coupler which is referred to in Butler's specification as "spring fingers," and the erroneous conclusions reached by the Eighth Circuit Court of Appeals with respect thereto.

The Structure and Function of Butler's Mechanism for Compressively Actuating the Locking Jaws.

In the Jiffy case the plaintiff offered in evidence a sample of the coupler shown in Figure 2 of the Butler patent. In the instant case respondent offered in evidence, as its Exhibit 63, a sample embodying its own understanding of Figure 2 of the Butler patent. The two samples or versions are just alike. In each of these samples the part marked 42 in Figure 2 of the Butler patent is represented as being cylindrical, the left-hand end as viewed in the patent drawing forming a true cylinder in which the sealing member 51 is free to slide, and the right-hand end being longitudinally slitted to form three spring fingers which engage the locking segments 40 to clutch them about the throat of the nipple 35. A study of the specification of the Butler patent establishes the fidelity of these two samples, both as to the function performed by the spring fingers and as to the form and shape assumed by the spring fingers.

The Function of the Spring Fingers.

The specification of the Butler patent describes "the spring fingers 42" as having the following functions: of "being forced forwardly, maintaining the segments 40 in close engagement with 39" (p. 2, l. 124); of "maintaining the segments 40 in engagement" "with the throat" of the nipple "by the pressure being greater on the piston within the coupling than any relief of the pressure that will be possible through the passage of the lubricant through 48" (p. 3, l. 18). "The shoulder 41 on 38 prevents the retraction of these segments 40 due to the fact that *they are held in position on the throat by the spring fingers 42*" (p. 2, l. 104).

The function of the spring fingers 42 in forcing the jaws

or "segments 40" into engagement with the nipple, is implicit in the statement of what occurs upon the relief of grease pressure:

"As soon as the pressure is relieved it is then possible to withdraw the coupling from the member 35 as the pressure on the fingers 42 will be relieved and the spaced segments 40 will slip over the shoulders 41 due to the pressure of 33 against the ends of the several segments 40."—(p. 3, l. 23.)

The "spring fingers 42" must be strong enough and stiff enough to perform these functions.

In claim 2 the radially movable locking elements are described as, "actuated by said piston for compressively clutching the elements upon the nipple, whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts."

In claim 1 the gripping jaws and their associated mechanism are described as, "means carried by the cylinder for compressively engaging about the nipple for locking said parts together against longitudinal displacement and actuated by said piston whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said means, while the lubricant is passing through said connecting parts."

The compressive engagement of the locking jaws about the nipple must be such as to resist the very considerable disruptive force due to the pressure of the grease. At the outset of the specification Butler says:

"My invention relates to lubricating apparatus and in particular to a force feed lubrication for bearings and the like in automotive equipment."—(p. 1, l. 1.)

In the second paragraph of his specification, he says:

"It is my object to provide a means of forcing under high pressure fluid and semi-fluid lubricating compounds into bearings."—(p. 1, l. 6.)

The pressure with which the lubricating compound must be forced into the bearings is indicated by the requirement, "that foreign material and used lubricant therein may be forced out of the bearing." (p. 1, l. 10.)

Referring to the particular form of grease gun shown in the patent drawings, Butler says:

"By maintaining such a seal and by the use of the worm, I am enabled to secure pressure up to 1,500 pounds within this gun."

Butler was, therefore, dealing with very high grease pressures. He was dealing with tremendous forces tending to disrupt the coupler from the nipple. The inescapable inference is that he was providing a coupler mechanism which would "forcibly compress" the gripping jaws about the nipple with a power sufficient to prevent disruption under the tremendously high grease pressure which the associated grease gun would develop.

The form of these clutching segments in a plane through the axis of the coupler, is clearly shown in Figure 2. It is to be noted that the upper jaw 40 is shown in cross-hatched outline. The lower jaw is not cross-hatched. This is in accordance with the universal convention employed in making mechanical drawings. The assumption is that the coupler and nipple shown in Figure 2 have been sawn through the middle on a plane coincident with the axis (except that the spring and valve member 36, since they are the innermost parts, are not sawn through the middle). The hypothetical saw cut is supposed to have passed through the "slight space" (p. 2, l. 102) between the two adjacent segments. The end of the segment is, therefore, seen in elevation and no cross-hatching is employed. The hypothetical saw cut has passed through the middle of the upper segment 40. The saw cut through this segment is, therefore, indicated by the cross-hatching.

Unmistakably, therefore, the drawing indicates an odd number of slightly spaced gripping segments or jaws. Presumably the number of jaws is three. This is for the reason that the other figures (which show manually actuated couplers rather than automatically actuated couplers), also indicate the presence of three jaws. Figure 9 is a cross-sectional view showing one of three jaws 76 at the top of the figure. The lower jaw 76 is shown in precisely the position which it would occupy if there were three equally spaced jaws. The third of the three jaws has been removed by the hypothetical saw cut through the axis of the coupler. Figure 3 shows an odd number of jaws, the upper jaw 40 being cross-hatched and the lower jaw 40 being not cross-hatched, because the section is taken between two jaws.

Similarly, in Figure 4, the upper jaw 73 is shown in cross-hatching, the lower jaw 73 is shown in elevation. Three jaws is the natural, reasonable and almost universal practice where the jaws are to be actuated from a single source. The reason is that three jaws will all grip equally upon a cylindrical object. Some other number (*e. g.* 4) might not do so. The jaws 40 must substantially surround the nipple with only "slight spaces" between them. If they did not thus form an almost complete ring around the nipple, then the jaws would drop out through the hole in the forward end of the coupler upon its removal from a nipple.

The obvious way to manufacture the three jaws 40 of the coupler shown in Figure 2 of the Butler patent, is to turn up a somewhat conically shaped ring, and then to make three equidistant saw cuts which divide the ring into three "segments 40 slightly spaced from one another" (*p. 2, l. 101*). Each of the segmental jaws 40 is provided with a tapering wedge or cam surface against which the

forward beveled end of a "spring finger 42" presses. When, therefore, the spring finger cylinder 42 moves forward under the pressure of the grease when developed behind the piston 43, 44 and 45, there is an inevitable "wedging action" between the beveled forward end of the spring finger cylinder and the reversely beveled surfaces of the segmental jaws 40.

Now, no matter how stiff or how weak the spring finger parts of the cylinder 42 may be, the inevitable result of the forward movement of the cylinder will be to press or compress the segmental jaws 40 inwardly toward the associated nipple. The flange-like wall 33 at the forward end of the coupler absolutely prevents the jaws 40 from moving to the right. The pressure of the beveled end of the spring finger cylinder upon the beveled surfaces of the jaws must necessarily, therefore, result in a tendency on the part of the segmental jaws 40 to be pressed inwardly toward the nipple.

If the spring fingers are stiff and strong, then the segmental jaws 40 will be pressed inwardly about the nipple with great force. If the spring fingers are weak and flimsy, then the segmental jaws will be pressed inwardly with less force (dependent upon the force required to flex the spring fingers to a point where they have slid all the way up the beveled surfaces of the jaws 40). But in either case, the forward movement of the beveled end of the spring finger cylinder under the force of the grease pressure, behind the piston 43, 44, 45, will inevitably be to compress the segmental jaws radially inward about the nipple.

In claim 1 of the Butler patent the segmental jaws are described as "means carried by the" (large outside) "cylinder for compressively engaging about the nipple for locking said parts together against longitudinal displacement" "whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said means."

In claim 2 the segmental jaws are described as "radially movable locking elements carried by the cylinder coacting with the nipple and actuated by said piston *for compressively clutching* the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston *to forcibly compress* said elements."

It is impossible to understand the details of Butler's specifications and drawings in *any* way which will eliminate the action of the spring fingers in pressing the segmental jaws inwardly "for compressively engaging about the nipple" (claim 1) and "for compressively clutching the elements upon the nipple" (claim 2).

Not only is it undeniable that the beveled forward ends of the spring fingers will inevitably exert some radially inward compressive force upon the segmental jaws;—it is undeniable also that with a nipple shoulder having a 45 degree bevel, as shown in the Butler patent, some radially inward compressive force is required to prevent the disruption of the union between coupler and nipple at the time of applying grease pressure.

What shall be the amount of this radially inward compressive force?

The patent does not, of course, answer this question in ounces or pounds. It does, however, answer it in terms of purpose and function:

"It is my object to provide a means of *forcing under high pressure* fluid and semi-fluid lubricating compounds into bearings and into bearing reservoirs *in order that foreign material and used lubricant therein may be forced out.*"—(p. 1, l. 6.)

"It is a further object of my invention of providing automatic and semi-automatic means of connection between the bearing valve (*i. e.*, the nipple) and the lubricating pressure means or grease gun so-called."—(p. 1, l. 19.)

"It is a further object of my invention to provide

automatic and semi-automatic connections between the grease gun and the bearing valve which may or may not be locked in position as desired by the operator *or may be automatically locked.*"—(p. 1, l. 58.)

"Returning to Fig. 2 and its operation, it will be understood that the coupling on the end of 25 is thus pushed over 35, the segments 40 engage with the throat and are maintained in engagement by the pressure being greater on the piston within the coupling than any relief of the pressure that will be possible through the passage of the lubricant through 48."—(p. 3, l. 14.)

The specification makes it clear that the construction and mode of operation of the parts are such that the pressure of the lubricant shall maintain this engagement until the grease pressure is relieved, for, as Butler says:

"As soon as the pressure is relieved it is then possible to withdraw the coupling from the member 35 as the pressure on the fingers 42 will be relieved and the spaced segments 40 will slip over the shoulders 41 due to the pressure of 33 against the ends of the several segments 40."—(p. 3, l. 23.)

Butler made it clear, furthermore, that the compressive engagement of the segmental jaws 40 about the nipple for locking the parts together against longitudinal displacement, and the maintenance of this engagement until the grease pressure is relieved, is to be accomplished automatically solely by the application of grease pressure; for he contrasts this automaticity with the manual operations of the prior art, saying in this connection:

"It will be seen that this coupling eliminates the necessity for a delicate adjustment by the operator of the coupling to the valve member (*i. e.*, the "headed nipple") which is often times difficult in restricted areas frequently found on automotive vehicles where this type of equipment is especially useful."—(p. 3, l. 30.)

If these functions and results are to be accomplished by the mechanism shown in Fig. 2 of the Butler patent, then

clearly the spring fingers 42 must be strong enough to force and compress the segmental jaws 40 inwardly and compressively about the nipple. If the spring fingers 42 are made too weak, they cannot perform the functions and accomplish the results described in the specification.

The Form and Shape of Butler's Spring Fingers.

There will be no question but what most of the parts shown in Fig. 2 of the Butler patent are round,—*i. e.*, solids of revolution like cylinders or cones. Many of these parts are given names which cannot be applied to anything else. The specification says, for example, “the outer end of this head has internally *threaded* therein a collar 32” (p. 2, l. 91), “a *conical* head proper 38” (p. 2, l. 99), “a *piston head*” (p. 2, l. 109), “a leather sealing washer 45” (p. 2, l. 111), “a *tubular* member 46” (p. 2, l. 113), “it will be understood that 35 is *threaded* into the bearing” (p. 3, l. 6), “the coupling comprising a *cylinder*, a *piston movable within the cylinder*” (p. 4, l. 41), “a coupling member for connecting said compressor and nipple comprising a *cylinder*, a *piston movable within the cylinder*” (p. 4, l. 58). In Fig. 2, all of these conical and cylindrical parts are shown in cross-section in accordance with the usual convention. The showing of the “spring finger” part 42 corresponds with the showing of the outer shell of the coupler into which the collar 32 is screwed, and this part is specifically described and named as a cylinder.

The piston which reciprocates in this outer cylinder is of course round. It is described as follows: “a piston head that consists of 43, a metallic washer 44 embracing between it and 43 a leather sealing washer 45” (p. 2, l. 99. Such a sealing washer is always round, as shown for example in the many prior art patents of record. The

part 51 is described in claim 1 as "an apertured seat for engagement with the end of the nipple," and in claim 2 as "an apertured sealing seat carried by said piston for engagement with the end of the nipple." In the specification it is described as follows: "The *washer* 51 provides a ready means of adjusting the junction of 38 with the remainder of the mechanism, and effectively seals the connection so that the lubricant will pass through 48 into 52 after having pushed back the rivet or stud 36." The name "washer" implies that this apertured sealing seat is round, like the sliding sealing seat 26 of the coupler of Gullborg patent No. 1,307,734 (R. p. 534).

If, as we contend, the sealing washer 51 is a round leather disc, more or less tightly fitting within the bore of a cylinder 42, then these parts would appear in a longitudinal cross-section precisely as they do appear in Fig. 2 of Butler's drawings. An accurate cross-sectional view could not show them in any other way. Even the edge of the hollowed forward face of this washer is shown extending around behind of the left-hand end of the nipple precisely as though it lay within the hollow bore of a cylinder 42.

The dotted hatching of 51 corresponds with the dotted hatching of 45. 45 is expressly described as "a *leather sealing washer*" (p. 2, l. 111). This is the conventional manner of representing leather in accordance with the Patent Office rule book. 51 is therefore a *leather washer*. The sealing discs of the manually operated couplers shown in Fig. 3, Fig. 4, and Fig. 9, are hatched in dots to indicate leather sealing washers. This sealing member in Fig. 3 is described in a sentence saying, "Adjustments in size, wear and position are provided for by the *yielding washer* 71 between 38 and 58" (p. 3, l. 72). In his description of Fig. 9, Butler refers to "the usual washer 71 for the accommodation for the size of the parts and their wear."

In Fig. 3, the leather sealing washer 71 is undoubtedly mounted in a cylindrical bore, since the space in which 71 is mounted is a forward extension of the screw-threaded part 60 which leads to a collar, to which the following reference is made: "The collar has a cup-shaped outer end at 62 adapted to fit the *conical* head of 35, designated 38. 61 is cut away at its outer end to form a cylindrical member of smaller diameter than the rest of the body, which is designated 63" (p. 3, l. 41).

For like reasons, the leather end sealing washers shown in Fig. 4 and in Fig. 9 are obviously located in cylindrical bores.

Fig. 2 is consistent with Figs. 3, 4, and 9 as to the manner in which this leather end sealing washer is mounted within a cylindrical bore.

If 51 is a leather washer within the cylindrical bore of 42, then obviously it is free to slide forward under grease pressure, thereby conforming with Butler's statement that "the washer 51 provides a ready means of adjusting the junction of 38 with the remainder of the mechanism, and effectively seals the connection" (p. 2, l. 126). Similar language is used in describing the sliding sealing washers shown in the other figures. Thus, for example, in connection with the coupler of Fig. 3, Butler says, "Adjustments in size, wear, and position are provided for by the yielding washer 71 between 38 and 58" (p. 3, l. 72). Of the construction shown in Fig. 9, he refers to "the head thereof, in which is located the usual washer 71 for the accommodation for the size of the parts and their wear" (p. 3, l. 91).

These end sealing washers could not serve the purpose of adjusting themselves to size, wear, and position of the parts unless they were slidably mounted within the bores of their respective cylinders. Fig. 3 shows a relatively

short conical head for the nipple. Accordingly, the end sealing washer has been pushed quite far forward. In Fig. 4 the conically cupped end of the coupler is rather short, and accordingly the sealing washer 71 is shown in a somewhat forward position. The conical heads of the nipples as shown in Fig. 2 and in Fig. 4 are somewhat longer. In both of these figures, therefore, the sliding sealing washer is shown in a position at the back end of the bore.

These leather washers are subject to some considerable compression under the force of grease pressure. They could not, therefore, "effectively seal the connection" unless they were mounted to slide forward under the pressure of grease. If the leather sealing washer 51 of Fig. 2 were not mounted to slide forward in the bore of a cylinder 42, it would be squeezed and compacted under grease pressure in such a way that grease would inevitably leak out through any opening at the base or back side of the sealing washer.

The part 42 extends forwardly from the piston part 43 with an internal diameter corresponding with that of the end sealing washer 51. At a point corresponding approximately with the greatest diameter of the head of the nipple, the diameter of 42 is reduced approximately to that of the shoulder of the nipple. If, therefore, 42 is in the form of a cylinder (as we contend it to be), then the end sealing washer 51 is free to slide forward until the forward edge of the sealing washer engages the reduced diameter of the cylinder in which it slides,—in other words, until it engages the shoulder in the cylinder approximately opposite the greatest diameter of the nipple head.

We can think of no way in which these leather sealing washers shown in Figs. 2, 3, 4, and 9 could perform their described functions unless they were slidably mounted to reciprocate in cylindrical bores. These functions are de-

scribed in the phrases, "the washer 51 provides a ready means of adjusting the junction of 38 with the remainder of the mechanism," "adjustments in size, wear, and position are provided for by the yielding washer 71 between 38 and 58," and "the usual washer 71 for the accommodation for the size of the parts and their wear."

If the round leather end sealing washer 51 of Fig. 2 is to function in the manner ascribed to it and to the corresponding end sealing washers of the other figures, showing manually operated couplers, it must be mounted in the bore of a cylinder 42 extending forward from the base 43 of the piston member. If 42 does represent such a hollow cylinder extending forward from 43, then the leather sealing washer 51 will operate perfectly to accomplish its required purpose as described in the specifications. If, on the other hand, 42 be taken to represent completely independent prongs extending forwardly from the base 43 of the piston member, then grease is bound to escape from the space at the back of the leather washer whenever it is pushed forward to the slightest degree. In the opinion of the Eighth Circuit Court of Appeals, it is said at page 793 of 81 Fed. (2d) that "It is not certain that said washer was intended to move away from its seat upon the face of the piston, as it appears that spring fingers mounted upon the piston would not afford a suitable environment for such movement." We agree that if "spring fingers" necessarily means wholly independent prongs extending forward from the face of the piston 43, they would not afford a suitable environment for such movement because such movement would permit all of the grease to ooze out between the base 43 of the piston and the sealing disc 51 in such a way as to destroy the very utility and purpose of the entire mechanism. Furthermore, the mere compression or forward flexing of the periphery of the sealing washer would, in the case of wholly independent and prong-like

"spring fingers," result in the same kind of disastrous escape of all of the grease.

We have heretofore urged that 42 represents what the Eighth Circuit Court of Appeals refers to in its opinion as an "inner cylinder projecting from the forward face of the piston." One of our reasons for asserting that 42 does represent such an "inner cylinder" is that if 42 be taken to mean wholly independent and disassociated prongs, then there would be a fatal escape of all of the grease from underneath the back side of the end sealing washer 51. We respectfully submit that our contention as to the form of the "spring finger" member is not answered by suggesting that the washer 51 may not have been intended to move away from its seat upon the face of the piston, because the "spring fingers mounted upon the piston would not afford a suitable environment for such movement." The fact that they would not afford a suitable environment for such movement is perhaps the most compelling reason for our contention that the spring fingers are not independent prongs but that they are the slotted or slotted ends of an "inner cylinder projecting from the forward face of the piston."

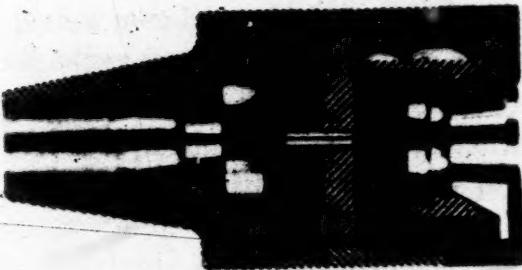
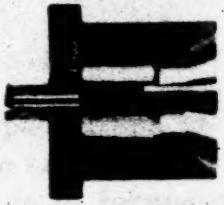
If the base 43 of the piston member be provided with an "inner cylinder projecting from the forward face of the piston," as in the plaintiff's sample of the Butler construction (Plaintiff's Exhibit 63), and if the forward and inwardly beveled end of this inner cylinder be slotted or slotted in accordance with this exhibit sample, then every purpose and function of the entire mechanism as described in the specification of the patent will be perfectly performed. No one has as yet suggested any other construction which will conform with all of the specifications and drawings, and which will perform the functions and accomplish the results described by Butler.

It is true that no slotting or slitting of the forward end of the inner cylinder is revealed in Fig. 2 of the Butler patent. The headed nipple occupies a position such that one cannot see the inside of the small cylinder 42; where the slits would otherwise appear. Whether or not such a slit or slot appeared in such a cross-sectional view as that of Fig. 2 would, however depend solely upon the matter of the angle at which the cross-sectional cut was taken. If the cut were taken through one of the slits or slots, then the slit or slot would appear in Fig. 2 in elevation and without cross-hatching, rather than with such cross-hatching as is shown in Fig. 2.

As a part of this brief, we are submitting a photograph of a half cross-sectional duplicate (Plaintiff's Exhibit 40) of the coupler shown in Fig. 2 of Butler's drawings. The forward end of the inner cylinder 42 is provided with three slits. The section is taken in a plane such that the appearance of the inner cylinder corresponds exactly with that shown in Fig. 2 of Butler's drawings.

The photograph shows also the cut-away half of the piston-member with its "inner cylinder" in which one of the three slits quite clearly appears. (There might, of course, be more than three slits. Since, however, the custom of teaching of the art would be to provide three segmental jaws, it would seem reasonable to provide three spring fingers rather than four or five or six, or any larger number.)

The slitting or slotting of the forward end of an inner cylinder projecting from the face of an actuating piston is in accordance with the teaching and practice of the mechanical arts. Such slits are definitely shown in Fig. 4 of Lavoie patent No. 1,236,453 (R. p. 508), where the lower wedge of the part 42 (see Fig. 3) is shown in elevation, whereas the upper wedge is shown in cross-section.



The respondent made a sample of the Butler coupler in accordance with the respondent's understanding of Figure 2 of the Butler drawings and the accompanying specification. It then sawed this sample into two halves along a longitudinal plane through the axis. It then drew cross-section lines on the parts exposed by the saw cut and then took a photograph of one-half of the coupler. The lower figure is a photograph of one-half of this sample. It corresponds exactly with the showing in Figure 2 of Butler's patent, - except that the headed nipple has been removed from the coupler (Plaintiff's Exhibit 40).

In the upper figure, the piston member has been removed from its association with the other parts in order to show how the forwardly projecting cylinder was slitted into so-called spring fingers.

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In the accompanying photograph of the model (Plaintiff's Exhibit 40) built in exact conformity with Fig. 2 of Butler's drawings, we have, as previously stated, included, in the upper view, the second half of the piston and "inner cylinder" member (Plaintiff's Exhibit 40-A). The third of the three slits appears clearly in this picture. The other two slits of the trio are of course to be found in the second half of the piston member, which in this photograph is in place with the other mechanism.

If, therefore, an inner cylinder projecting forward from the face of Butler's piston 43 be slotted or slotted at its forward end in accordance with the common practice of the art, we have something which is entirely consistent with all of Butler's drawings and specifications, and something which will accomplish all of Butler's purposes and functions. There is nothing in Butler's specifications or drawings which is inconsistent with such an understanding of his structure as exemplified in the Plaintiff's Exhibit 63.

Indeed, Butler himself shows just such a slitting of a forwardly projecting cylindrical member in the manually operated construction of Fig. 4. Here it will be observed that a cylindrical member 72 extends forwardly to the right. The right-hand end of this member is bent inwardly at a 45° angle to provide jaws for gripping underneath the head or shoulder of the nipple. In this case, the hypothetical saw cut provided by the draftsman for making his cross-sectional view, shows the upper cut in full cross-section, and therefore correspondingly cross-hatched from end to end. On the lower side, however, the cross-hatching extends only about a quarter of the distance from the left. Beyond that point, this member 72 is shown in elevation. This means, of course, that in this case the cross-sectional cut was taken through one of an odd number of slits. If this cross-sectional view had been taken in some other plane, it

might have missed all of the slits, as was the case in Fig. 2. This cylinder of Fig. 4, slotted as it is at the forward end, is described as providing "spring fingers",—exactly the same name as that applied to what we very confidently understand to be the same kind of an arrangement in Fig. 2. Of this arrangement as shown in Fig. 4, Butler says, "The fingers 72 are slightly separated from one another, have turned-in ends 73 to engage with 41 of 38, and are adapted when not under compression to spring outwardly. The collar 67 is adapted to compress these *spring fingers* just as in Fig. 3." (P. 3, l. 78.)

One of the reasons given in the opinion of the Eighth Circuit Court of Appeals for believing that Butler did not disclose a construction which would provide any substantial gripping of the nipple, and for believing, therefore, that Butler's spring fingers must be comparatively weak and flexible, was that "Ample room is left in the cylinder for the free play of the spring fingers" (Opinion, p. 793). We do not believe that the space between the "spring fingers" and the outer shell of the coupler can fairly be taken as indicative of any intention on Butler's part to secure or insure any large movement of the spring fingers. In any mechanism, one of the requisites is that it be possible to put the parts together. Another requisite is that it be possible to manufacture each of the several parts.

In order to be able to assemble the mechanism of Fig. 2 of the Butler patent, the outer shell is made in two parts so that the collar part 32, 33 may be unscrewed from the forward end of the cylindrical part of the head 31. When these two parts of the outer shell are separated, the piston 43, 44, and 45 may be inserted into the outer cylinder from the forward end. So also when these parts are separated, the three segmental jaws 40 may be inserted and arranged in a ring within the cylindrical bore of the collar part 32.

If this bore were not of this relatively large diameter, it would be difficult, if not impossible, to insert these parts before screwing the two halves of the coupler shell together. The diameter of the coupler shell must of course be large enough to accommodate the piston 43, 44, and 45. The piston must have large diameter as shown in the patent drawing, in order to provide an area sufficient to enable the grease pressure to exert the requisite force. When this large diameter of the cylinder must be and is provided for this purpose, and when all of the parts must be inserted from one end or the other within the two halves of the coupler shell, it does not seem reasonable to us to ascribe to the diameter of the inner bore of the forward part of this shell the purpose of providing space for any wide movement of weak and easily flexible "spring fingers".

The forward end of the collar 32 must provide an in-turned flange portion 33 against which the segmental jaws 40 may abut. These jaws must be capable of a radially in and out movement sufficient to permit the insertion and withdrawal of the head of the nipple. This screw threaded collar member 32 must be made in some kind of a lathe by turning and boring operations. It is vastly easier and cheaper to bore out the collar 42 at one diameter (comparable with the outermost diameter of the segmental jaws 40) than to bore a small diameter (comparable with that of the "inner cylinder") followed by an internal peripheral groove into which the outer peripheral flanges of the jaws might be inserted. The space between the "inner cylinder" and the bore of the shell 32 is readily explained, therefore, on the mere score of facility and economy in manufacture.

There is no warrant, therefore, for ascribing any particular significance to this space.

If the spring fingers are reasonably stiff, it does not make a particle of difference how much space may intervene be-

tween them and the surrounding shell. There are ample reasons, other than the accommodation of the movement of the spring fingers, for any space which may intervene between the spring fingers and the surrounding shell.

For all of the many reasons hereinabove indicated it seems to us to be an inescapable conclusion that Butler described a coupler in which an "inner cylinder" projected forwardly from the face of the piston 43 and that the end sealing leather washer 51 was mounted to slide forwardly within the bore of this inner cylinder upon the application of grease pressure, and that it was merely the forward end of the inner cylinder which was slitted or slotted to provide fingers having a slight degree of springiness under the forces to be employed.

The sample submitted by the plaintiff as exhibit 63 conforms with this understanding of Butler's entire disclosure. Everything about the exhibit 63 sample is consistent with all that Butler has said in his specifications and shown in his drawings. Nothing in the specifications or drawings is inconsistent with the sample. We cannot conceive of any construction different from that which we have presented and which would be consistent with Butler's drawings and description of construction, mode of operation, and result.

With an inner cylinder projecting forwardly from the base of the piston and slitted or slotted at its forward end, the jaws will necessarily operate to grip or clamp the fitting as distinguished from merely latching beneath the head of the fitting. It is fundamental that the resistance offered by a spring increases with the amount of deflection from its normal at rest position. This fundamental law of mechanics is known as Hooke's Law, and is usually stated: "Strain is proportional to stress." The law is illustrated in a spring balance wherein the spring is strained to a certain distance when weighing a one pound fish, and wherein

the spring is strained or stretched to ten times that distance when subjected to the gravitational pull of a ten pound fish. Butler's spring fingers 42 are necessarily flexed as they are pushed forwardly by the piston. The greater the flexure, the greater will be the inwardly directed force upon the jaws, and the tighter will be the gripping effect of the jaws upon the nipple. If locking only had been the desired function, it would have been necessary merely to provide a means which would move the jaws into position beneath the head of the fitting,—it would not have been necessary to increase the pressure of the jaws around and against the nipple upon an increase in lubricant pressure.

In order to accomplish Butler's general purpose of "high pressure" "force feed" lubrication, the spring fingers must necessarily be quite stiff. They may desirably have a very small amount of springiness. Such was demonstrated upon the trial to be characteristic of an inner cylinder extending forwardly from the base 43 of the piston and slitted or slotted at its forward end so as to provide arcuate sectors of a cylinder to engage with the segmental jaws 40. The reason for this strength can be well demonstrated by means of a calling card. When the card is flat, it may be very easily bent along a transverse line. If, however, the card is bent into a longitudinally extended trough shape, a force probably a hundred times as great will be required to bend it along a transverse line. Butler's "spring fingers" would necessarily be trough shaped or arcuate in transverse cross section. If constituted by the slitting of the forward end of an inner cylinder, they would therefore have strength against bending very much greater than would be their strength against such bending if they were of flat or other non-arcuate cross section.

Such spring fingers as Butler, therefore, contemplated

and described, would necessarily be very stiff and strong and their stiffness and resistance to bending would increase proportionately with the extent to which they were moved from normal position. As a result, the force with which the "spring fingers" press the jaws 40 against the nipple, greatly increases as the piston pushes the "spring fingers" against the jaws, and the tightness of the grip of the jaws on the nipple is necessarily proportional to the lubricant pressure acting upon the piston.

There Is Identity of Function and Result No Matter What May Be the Form and Shape of the Spring Fingers Within the Limitations of Butler's Drawing.

We have found it impossible, as has been said, to formulate any conception of a Butler device which does not have an "inner cylinder" extending forwardly from the piston 43, 44, 45, and within which the end sealing leather washer 51 is reciprocally located, and which would correspond with Butler's specifications, drawings, and claims, and which would operate in the manner described by Butler to accomplish the results described by him. Nevertheless, we have made up a sample of a piston having four wholly independent and unconnected fingers extending forwardly from the face of the piston. We have inserted a leather end sealing washer within the embrace of these four fingers. A photograph of this sample is here inserted in this brief.

This photograph corresponds with what seems to us to have been the Eighth Circuit Court of Appeals' conception of the thing described and illustrated in the Butler patent. We submit that if this piston having these four projecting prongs or fingers does represent the Eighth Circuit Court of Appeals' conception of what the Butler patent intended to illustrate and describe and claim, then for the reasons previously outlined, it rather concretely and clearly dem-



This photograph represents what we understand to have been the conception of Butler's piston member as entertained by the Eighth Circuit Court of Appeals. Any such conception of the Butler invention was quite contrary to the respondent's understanding. It was explicitly repudiated by the evidence offered by the petitioner in the instant suit.

A piston having "spring fingers" of the kind shown in this photograph could not possibly "work," - because the grease would leak out of the space between the base of the piston 43 and the sealing disc 51. The leakage would occur between the several "fingers" in such a way as to prevent the development of any grease pressure behind the sealing disc 51 and in such a way, therefore, as to prevent the accomplishment of the sealing of the joint between the end of the nipple and the coupler.

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In the accompanying photograph of the model (Plaintiff's Exhibit 40) built in exact conformity with Fig. 2 of Butler's drawings, we have, as previously stated, included, in the upper view, the second half of the piston and "inner cylinder" member (Plaintiff's Exhibit 40-A). The third of the three slits appears clearly in this picture. The other two slits of the trio are of course to be found in the second half of the piston member, which in this photograph is in place with the other mechanism.

If, therefore, an inner cylinder projecting forward from the face of Butler's piston 43 be slotted or slotted at its forward end in accordance with the common practice of the art, we have something which is entirely consistent with all of Butler's drawings and specifications, and something which will accomplish all of Butler's purposes and functions. There is nothing in Butler's specifications or drawings which is inconsistent with such an understanding of his structure as exemplified in the Plaintiff's Exhibit 63.

Indeed, Butler himself shows just such a slitting of a forwardly projecting cylindrical member in the manually operated construction of Fig. 4. Here it will be observed that a cylindrical member 72 extends forwardly to the right. The right-hand end of this member is bent inwardly at a 45° angle to provide jaws for gripping underneath the head or shoulder of the nipple. In this case, the hypothetical saw cut provided by the draftsman for making his cross-sectional view, shows the upper cut in full cross-section, and therefore correspondingly cross-hatched from end to end. On the lower side, however, the cross-hatching extends only about a quarter of the distance from the left. Beyond that point, this member 72 is shown in elevation. This means, of course, that in this case the cross-sectional cut was taken through one of an odd number of slits. If this cross-sectional view had been taken in some other plane, it

might have missed all of the slits, as was the case in Fig. 2. This cylinder of Fig. 4, slitted as it is at the forward end, is described as providing "spring fingers"—exactly the same name as that applied to what we very confidently understand to be the same kind of an arrangement in Fig. 2. Of this arrangement as shown in Fig. 4, Butler says, "The fingers 72 are slightly separated from one another, have turned-in ends 73 to engage with 41 of 38, and are adapted when not under compression to spring outwardly. The collar 67 is adapted to compress these *spring fingers* just as in Fig. 3." (P. 3, l. 78.)

One of the reasons given in the opinion of the Eighth Circuit Court of Appeals for believing that Butler did not disclose a construction which would provide any substantial gripping of the nipple, and for believing, therefore, that Butler's spring fingers must be comparatively weak and flexible, was that "Ample room is left in the cylinder for the free play of the spring fingers" (Opinion, p. 793). We do not believe that the space between the "spring fingers" and the outer shell of the coupler can fairly be taken as indicative of any intention on Butler's part to secure or insure any large movement of the spring fingers. In any mechanism, one of the requisites is that it be possible to put the parts together. Another requisite is that it be possible to manufacture each of the several parts.

In order to be able to assemble the mechanism of Fig. 2 of the Butler patent, the outer shell is made in two parts so that the collar part 32, 33 may be unscrewed from the forward end of the cylindrical part of the head 31. When these two parts of the outer shell are separated, the piston 43, 44, and 45 may be inserted into the outer cylinder from the forward end. So also when these parts are separated, the three segmental jaws 40 may be inserted and arranged in a ring within the cylindrical bore of the collar part 32.

If this bore were not of this relatively large diameter, it would be difficult, if not impossible, to insert these parts before screwing the two halves of the coupler shell together. The diameter of the coupler shell must of course be large enough to accommodate the piston 43, 44, and 45. The piston must have large diameter as shown in the patent drawing, in order to provide an area sufficient to enable the grease pressure to exert the requisite force. When this large diameter of the cylinder must be and is provided for this purpose, and when all of the parts must be inserted from one end or the other within the two halves of the coupler shell, it does not seem reasonable to us to ascribe to the diameter of the inner bore of the forward part of this shell the purpose of providing space for any wide movement of weak and easily flexible "spring fingers".

The forward end of the collar 32 must provide an in-turned flange portion 33 against which the segmental jaws 40 may abut. These jaws must be capable of a radially in and out movement sufficient to permit the insertion and withdrawal of the head of the nipple. This screw threaded collar member 32 must be made in some kind of a lathe by turning and boring operations. It is vastly easier and cheaper to bore out the collar 42 at one diameter (comparable with the outermost diameter of the segmental jaws 40) than to bore a small diameter (comparable with that of the "inner cylinder") followed by an internal peripheral groove into which the outer peripheral flanges of the jaws might be inserted. The space between the "inner cylinder" and the bore of the shell 32 is readily explained, therefore, on the mere score of facility and economy in manufacture.

There is no warrant, therefore, for ascribing any particular significance to this space.

If the spring fingers are reasonably stiff, it does not make a particle of difference how much space may intervene be-

tween them and the surrounding shell. There are ample reasons, other than the accommodation of the movement of the spring fingers, for any space which may intervene between the spring fingers and the surrounding shell.

For all of the many reasons hereinabove indicated it seems to us to be an inescapable conclusion that Butler described a coupler in which an "inner cylinder" projected forwardly from the face of the piston 43 and that the end sealing leather washer 51 was mounted to slide forwardly within the bore of this inner cylinder upon the application of grease pressure, and that it was merely the forward end of the inner cylinder which was slitted or slotted to provide fingers having a slight degree of springiness under the forces to be employed.

The sample submitted by the plaintiff as exhibit 63 conforms with this understanding of Butler's entire disclosure. Everything about the exhibit 63 sample is consistent with all that Butler has said in his specifications and shown in his drawings. Nothing in the specifications or drawings is inconsistent with the sample. We cannot conceive of any construction different from that which we have presented and which would be consistent with Butler's drawings and description of construction, mode of operation, and result.

With an inner cylinder projecting forwardly from the base of the piston and slitted or slotted at its forward end, the jaws will necessarily operate to grip or clamp the fitting as distinguished from merely latching beneath the head of the fitting. It is fundamental that the resistance offered by a spring increases with the amount of deflection from its normal at rest position. This fundamental law of mechanics is known as Hooke's Law, and is usually stated: "Strain is proportional to stress." The law is illustrated in a spring balance wherein the spring is strained to a certain distance when weighing a one pound fish, and wherein

the spring is strained or stretched to ten times that distance when subjected to the gravitational pull of a ten pound fish. Butler's spring fingers 42 are necessarily flexed as they are pushed forwardly by the piston. The greater the flexure, the greater will be the inwardly directed force upon the jaws, and the tighter will be the gripping effect of the jaws upon the nipple. If locking only had been the desired function, it would have been necessary merely to provide a means which would move the jaws into position beneath the head of the fitting,—it would not have been necessary to increase the pressure of the jaws around and against the nipple upon an increase in lubricant pressure.

In order to accomplish Butler's general purpose of "high pressure" "force feed" lubrication, the spring fingers must necessarily be quite stiff. They may desirably have a very small amount of springiness. Such was demonstrated upon the trial to be characteristic of an inner cylinder extending forwardly from the base 43 of the piston and slitted or slotted at its forward end so as to provide arcuate sectors of a cylinder to engage with the segmental jaws 40. The reason for this strength can be well demonstrated by means of a calling card. When the card is flat, it may be very easily bent along a transverse line. If, however, the card is bent into a longitudinally extended trough shape, a force probably a hundred times as great will be required to bend it along a transverse line. Butler's "spring fingers" would necessarily be trough shaped or arcuate in transverse cross section. If constituted by the slitting of the forward end of an inner cylinder, they would therefore have strength against bending very much greater than would be their strength against such bending if they were of flat or other non-arcuate cross section.

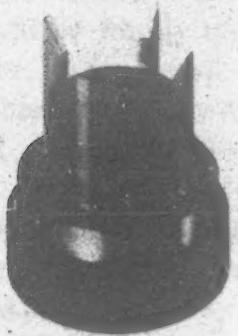
Such spring fingers as Butler, therefore, contemplated

and described, would necessarily be very stiff and strong and their stiffness and resistance to bending would increase proportionately with the extent to which they were moved from normal position. As a result, the force with which the "spring fingers" press the jaws 40 against the nipple, greatly increases as the piston pushes the "spring fingers" against the jaws, and the tightness of the grip of the jaws on the nipple is necessarily proportional to the lubricant pressure acting upon the piston.

There Is Identity of Function and Result No Matter What May Be the Form and Shape of the Spring Fingers Within the Limitations of Butler's Drawing.

We have found it impossible, as has been said, to formulate any conception of a Butler device which does not have an "inner cylinder" extending forwardly from the piston 43, 44, 45, and within which the end sealing leather washer 51 is reciprocally located, and which would correspond with Butler's specifications, drawings, and claims, and which would operate in the manner described by Butler to accomplish the results described by him. Nevertheless, we have made up a sample of a piston having four wholly independent and unconnected fingers extending forwardly from the face of the piston. We have inserted a leather end sealing washer within the embrace of these four fingers. A photograph of this sample is here inserted in this brief.

This photograph corresponds with what seems to us to have been the Eighth Circuit Court of Appeals' conception of the thing described and illustrated in the Butler patent. We submit that if this piston having these four projecting prongs or fingers does represent the Eighth Circuit Court of Appeals' conception of what the Butler patent intended to illustrate and describe and claim, then for the reasons previously outlined, it rather concretely and clearly dem-



This photograph represents what we understand to have been the conception of Butler's piston member as entertained by the Eighth Circuit Court of Appeals. Any such conception of the Butler invention was quite contrary to the respondent's understanding. It was explicitly repudiated by the evidence offered by the petitioner in the instant suit.

A piston having "spring fingers" of the kind shown in this photograph could not possibly "work," - because the grease would leak out of the space between the base of the piston 43 and the sealing disc 51. The leakage would occur between the several "fingers" in such a way as to prevent the development of any grease pressure behind the sealing disc 51 and in such a way, therefore, as to prevent the accomplishment of the sealing of the joint between the end of the nipple and the coupler.

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onstrates the error of that conception, since all of the grease would escape around the edges of the sealing washer 51 and the structure would be wholly inoperative for any useful purpose whatsoever. As we shall point out in more detail at a later point in this brief, at the trial of the instant suit, the petitioner itself repudiated any such conception of the Butler invention. It is practically estopped by its own evidence in the present case, to urge the correctness of the view which seems to have been entertained by the Eighth Circuit Court of Appeals.

The Claim in Issue Is Not Directed to a Coupler Having Spring Pressed Jaws.

Petitioner erroneously construes the word "compressively," appearing in claim 2 of the Butler patent, as limited to *spring* pressure. In so doing petitioner departs widely in another direction from the opinion of the Eighth Circuit Court of Appeals. In so doing it is not supported either by the opinion in *Stewart-Warner v. Jiffy*, by the dictionary, or by the specification of the Butler patent itself.

In no place in its opinion does the Eighth Circuit Court of Appeals suggest that the word "compressively" is limited to spring pressure. The dictionary makes it clear that this word is not so limited. Thus, in Webster's Collegiate Dictionary (5th Ed.) the word "compressively" is defined as, "tending to compress," and the verb "to compress" is defined as meaning "to press or squeeze together." There is no suggestion whatsoever that such pressing or squeezing can be accomplished by a spring but not by a relatively rigid piece of metal.

The specification of the Butler patent itself is a good refutation of petitioner's argument in this regard. The claim in issue uses both the noun "compressor" and the

adverb "compressively." Both are derived from the verb "to compress," the noun "compressor" meaning "one that serves to compress." The Butler patent discloses the compressor in Figure 1. It shows a cylindrical container 9 having a piston which is positively advanced by a screw threaded stem 2 attached to the actuating handle 1. In describing this rigid and unyielding device, Butler conforms to the practice of the art wherein it is common to apply the term "compressor" to describe various kinds of positive devices for discharging lubricant under pressure.

We submit that petitioner is entirely unwarranted in attempting to construe the word "compressively" as being limited to *spring* pressure, as distinguished from unyielding pressure.

The Decision of the Eighth Circuit Court of Appeals Does Not Conform to the Holding of the Patent Office, Whereas the Decision of the Seventh Circuit Court of Appeals Is in Agreement with the Patent Office.

The opinion of the Eighth Circuit Court of Appeals in *Stewart-Warner v. Jiffy* contains an admission that its ideas of the disclosure of the Butler patent are at variance with those held by the United States Patent Office, which granted the patent. On this point the Eighth Circuit Court of Appeals said at page 793:

"Although we consider the Jiffy coupler a clear mechanical equivalent of the coupler which has been made up by the plaintiff to demonstrate the Butler patent, we find the latter to be a departure and different from the real disclosure of that patent. The file wrapper of the Patent Office in the matter of the patent to August Johnson, No. 1,984,878,* reflects that claims made by Johnson were denied on account of the prior patent to Butler. The rulings indicate an

* This patent disclosed and claimed the specific structure of the Jiffy coupler.

opinion in the Patent Office as to the scope of the Butler patent differing from that reached by the District Court, but the courts are not bound to follow the Patent Office. *Dwight & Lloyd Sintering Co. v. Greenawalt* (C. C. A. 2) 27 F. (2d) 823, 832."

The decision of the Seventh Circuit Court of Appeals in the instant case, however, holds that the sample coupler (Plaintiff's Exhibits 62 and 63) made by respondent to demonstrate the Butler patent corresponds to the disclosure of that patent. The Seventh Circuit Court of Appeals is thus in complete agreement with the Patent Office experts concerning the real construction and mode of operation of the apparatus illustrated and described in the Butler patents.

The Evidence in the Instant Case Shows That the Butler Invention Is Not Limited to a Coupler Having Spring Fingers and That the Respondent's Commercial Apparatus Embodies the Invention of the Butler Patent.

In this suit against the Lincoln Engineering Company of Illinois the District Court and the Circuit Court of Appeals had before them evidence which was not offered in the Jiffy case and which incontrovertibly proves that the claim in issue is entitled to its literal meaning and thus covers the combination of the respondent's hydraulic coupler and the petitioner's headed nipple. This additional evidence is the testimony of the inventor, Mr. Butler, and also the testimony and exhibits presented by petitioner's own vice-president and expert, Mr. Fox. It is for this reason that petitioner's brief refers only to the decision of the Eighth Circuit Court of Appeals, and not to the evidence in the instant suit, as supporting petitioner's argument that the claim in suit is limited to what petitioner now chooses to consider as constituting spring fingers.

The original sample made by Mr. Butler and which sample was used by Butler's solicitors in preparing the application for the Butler patent in suit, was offered in evidence as Plaintiff's Exhibit 8 (R. p. 36). This original sample corresponds identically with the drawing of Figure 2 of the Butler patent in suit (R. p. 54). Mr. Butler testified that he had used this original sample in lubricating the bearings of automobiles (R. pp. 36, 37).

His testimony in regard to this matter is of much consequence in showing the utter inapplicability of the opinion of the Eighth Circuit Court of Appeals in the Jiffy case to the facts and questions involved in the present case. For the moment, and in the present connection, we refer the court particularly to the testimony of the plaintiff's expert witness at R. pp. 54-56.

He demonstrated upon the trial that the invention of the Butler patent works equally well, and in substantially the same way, regardless whether the tubular extension 42 is solid or whether it is slotted into spring fingers at the right-hand end (R. pp. 55, 245-252). Because of the loss of two of the three jaws of Butler's original device, Plaintiff's Exhibit 8, it was impossible to demonstrate its operation; but an exact and complete duplicate, Plaintiff's Exhibit 62, was demonstrated and it operated perfectly (R. pp. 245-252).

The plaintiff also introduced in evidence as Exhibit 63 another sample of the Butler device. This other sample corresponded identically with Figure 2 of Butler's patent drawings, but it embodied the spring fingers referred to in Butler's specification by such a longitudinal slitting of the tubular cylinder 42 as has been described. This "spring finger" sample also operated perfectly, thus showing that the Butler invention may assume either that form in which the cylindrical projection is slitted into spring fingers, or

in the form represented by Butler's original sample, Plaintiff's Exhibit 8, in which the cylinder 42 is not slitted into "spring fingers" (R. pp. 248-257).

These demonstrations showed that with both of these minor variants of the Butler invention, the grip between the coupler and nipple was automatically effected by the lubricant pressure, and was proportional to the degree of that pressure (R. pp. 245-250). Also, in each instance (since the slits did not extend all the way to the base part 43 of the piston member), the sealing means 51 functioned perfectly to provide a lubricant tight seal between the coupler and the nipple (R. pp. 245-254).

For all of the purposes of this suit, the defendant's position relative to this "spring finger" matter was such as to reject absolutely the "crochet needle" concept or any other such concept as the Eighth Circuit Court of Appeals apparently had relative to the "spring finger" remark of Butler's patent specification. Through its vice-president and expert witness, Fox, the defendant presented a sample of the Butler construction. (Defendant's Exhibit A-61.) In the defendant's sample, as in ours, the base 43 of the piston was provided with a tubular or cylindrical extension 42 in which the sealing washer 51 was mounted to reciprocate under the pressure of the grease admitted through the aperture 48 in the base of the piston. This cylindrical extension was, in the defendant's sample, slitted in several places at its forward end so as to provide such resiliency as would admit of the appellation "spring fingers" (Defendant's Exhibit A-61, Fox testimony, R. pp. 101-103).*

* The defendant's witness Fox made an elaborate attempt to imply and to impress the Court with the fact that in order to be operative at all, the Butler device must have "spring fingers" of very considerable resiliency, and therefore of very pronounced flimeliness,—such pronounced flimsiness that the "spring fingers" could not exert sufficient pressure upon the jaws 40 to grip the parts together with the pressure of grease. Fox's demonstrations involved the use of a tight ring (see the lower figure of Defendant's Exhibit C-21 drawing) (R. p. 105) which could be slipped

In essence this slitting of the cylinder 42 conforms exactly with the plaintiff's views as to the disclosure of the Butler patent. It was, however, directly in conflict with the views expressed by the Eighth Circuit Court of Appeals (81 Fed. (2d) 786, 793). As more fully explained in the accompanying footnote, the defendant's own sample, when relieved of a certain falsification in relative dimensions, demonstrated beyond question that the Butler construction was entirely operative to accomplish Butler's results, regardless whether the forward end of the cylinder 42 be quite rigid or whether it have some slight "give" or resiliency,—as might be effected by an appropriate slitting of an appropriate cylinder.

The sample which the defendant itself produced (Defendant's Exhibit A-61 herein, R. p. 102) to show the construction which is described and illustrated in Butler's patent, corresponded in every important respect with the

over the slitted right-hand end (for some reason the defendant awkwardly reversed the direction in which the device faces) of the cylindrical extension 42 in such a way as to eliminate any possible "give" of the "spring fingers." With this ring in place,—corresponding, as he rightly said, with an unslit cylinder 42, he attempted to demonstrate his inability to separate the coupler from the nipple at the conclusion of a greasing operation. With the ring removed, he attempted, on the other hand, to demonstrate that only very low grease pressures could be developed because of the inability of the flimsy "spring fingers" to wedge or cam the jaws 40 with sufficient force to withstand the disrupting tendency of the grease. (R. pp. 99-104)

All of these demonstrations and arguments were completely blasted when in rebuttal the plaintiff's witness Lynn Williams, Jr., discovered and demonstrated that the real reason for the defendant's inability to operate its sample, when the flimsiness of the "fingers" was eliminated by the employment of the surrounding ring, was the fact that, contrary to the drawing, Defendant's Exhibit C-21, which Mr. Fox had presented ostensibly to illustrate his model, was that the defendant's sample was provided with a shell which did not conform either with the drawing of the patent or with Mr. Fox's drawing Defendant's Exhibit C-21. This enclosing shell C was so short from end to end that all of the piston and jaw mechanism was at all times clamped tightly between the base of the shell and the perpendicular shoulder or flange at the forward end of the shell. The result was that there could be no longitudinal movement whatsoever of the piston member relative to the jaws or of the piston 45, 48, 42 relative to the cylindrical shell C. (R. pp. 235-237) In other words, it did not in this regard conform with Butler's drawings and specifications.

As soon as Mr. Williams slightly elongated the cylinder C by unscrewing its forward end a thread or two, so as to correspond with Butler's disclosure the piston was given the requisite play with respect to the

full size operative sample which the Stewart-Warner Corporation exhibited and demonstrated in the Jiffy suit as representative of the disclosure of the patent. In both the plaintiff's sample in the Jiffy suit and in the defendant's (ring) sample in the present suit, the extension 42 of the piston was stiff and strong enough to effect a very great pressure upon the jaws. In both samples the cylindrical extension 42 provided a perfect cylinder in which the sealing washer 51 was slidably mounted in such a way as to respond to the pressure of the grease and to engage the end of the nipple to effect a seal therewith.

The Eighth Circuit Court of Appeals adopted an untenable contention advanced by the Jiffy Company, to the effect that the "spring fingers" must for some unknown reason extend the full length of the tubular extension 42, and therefore in such a way as to eliminate any tubular or cylindrical form in which the sealing washer 51 could slide,

shell and with respect to the jaws. This slight change overcame the defendant's falsification of its own drawing and of that of the Butler patent. As soon as this falsification was removed, the defendant's model operated perfectly and in accordance with the description and disclosure of the Butler patent. (R. pp. 237-239)

We had then from the defendant's own hands a sample of the Butler device which confirmed all of the plaintiff's contentions relative to the real disclosure of the Butler patent, and furthermore a model which completely rejected the theory of flimsy "spring fingers" which had been advanced by the Eighth Circuit Court of Appeals,—upon which theory alone the Eighth Circuit Court of Appeals reached the conclusion that the strong wedging and gripping action of the Jiffy Company's coupler was something quite different from some weak and flimsy action of the Butler patent,—the difference upon which alone the Eighth Circuit Court of Appeals reached the conclusion that the Jiffy Company's device did not infringe claim 1 of the Butler patent.

All of the defendant's evidence,—all of its representations and pretenses in connection with the construction and mode of operation of the Butler device as disclosed in the patent in suit, were so completely shattered on rebuttal that they are nowhere advanced or even alluded to throughout the whole of the appellant's brief in this Court.

In this Court, counsel for the appellant point to the decision of the Eighth Circuit Court of Appeals upon a different claim and upon a different product, and urge that this Court find that the plaintiff's commercial coupler is so rigid and so strong as to "avoid" claim 2 of the Butler patent, thereby leading to a holding of "non-infringement,"—and this, despite the fact that in this case the defendant itself has shown by its own sample of the Butler construction that the very basis of the reasoning and opinion of the Eighth Circuit Court of Appeals was erroneous and untenable.

or could be subjected to the pressure of the grease. It was upon this very matter that the Eighth Circuit Court of Appeals said, at page 793 of its opinion:

"We have considered the argument of the plaintiff that the saw slots cut into the smaller cylinder of its device result in arcuate end portions and bring the smaller cylinder of the device within the specification of 'spring fingers,' but we are not persuaded. No inner cylinder projecting from the forward face of the piston is specified in the Butler patent and we are not persuaded that one is implied by the presence of the washer 51 shown in the drawing and specified as 'providing a ready means of adjusting the junction of 38 with the remainder of the mechanism.' It is not certain that said washer was intended to move away from its seat upon the face of the piston as it appears that spring fingers mounted upon the piston would not afford a suitable environment for such movement. . . .

"Although we consider the Jiffy coupler a clear mechanical equivalent of the coupler which has been made up by the plaintiff to demonstrate the Butler patent, we find the latter to be a departure and different from the real disclosure of that patent."

What the Eighth Circuit Court of Appeals here says, is in effect that

"The Jiffy coupler is a clear mechanical equivalent of the coupler which has been made up by the plaintiff in the Jiffy suit to demonstrate the Butler patent, and a clear mechanical equivalent of the couplers which have been made up both by the plaintiff and by the defendant in the Lincoln suit to demonstrate the Butler patent."

What the defendant has said in this suit, is in effect:

"The sample which we have made up to illustrate and demonstrate the construction and operation of the Butler patent, is identical with the samples made up by the plaintiff in both the Jiffy suit and in the present suit. The real disclosure of the Butler patent corresponds with our sample and with those of the plaintiff. The Eighth Circuit Court of Appeals considered the Jiffy coupler to be a clear mechanical equivalent both

of our sample and of the plaintiff's samples of the construction illustrated and described in the Butler patent."

Mr. Butler was not a witness in the Jiffy suit, and his original sample was not there in evidence.

In and by its record in the instant suit, the petitioner itself rejected the only ground upon which the Eighth Circuit Court of Appeals reached its decision of non-infringement in the Jiffy case. Nevertheless, and in spite of the fact that the defendant so elaborately proved the error of the Eighth Circuit Court of Appeals, the defendant relies wholly upon a mere dictum of the Eighth Circuit Court of Appeals,—a dictum which was an outgrowth of identically this same fundamental error, and then urges this court to adopt and apply this admittedly erroneous dictum of the Eighth Circuit Court of Appeals and to do so directly in the face of the petitioner's own testimony and exhibits in the present suit.

A Brief Summary of the Concurring Evidence of Both Parties to the Effect That the Inconsequential Dictum of the Eighth Circuit Court of Appeals Was in Error, and That the Stewart-Warner Corporation's Hydraulic Lubricating Apparatus Does Embody the Construction and Operation of the Invention of Claim 2 of the Butler Patent in Suit. All of the Testimony and Exhibits of Both Parties to This Suit Reject the Views Entertained by the Eighth Circuit Court of Appeals, and Force the Conclusion That Claim 2 of the Butler Patent in Suit is Embodied in Any Combination of the Petitioner's Headed Nipple with the Respondent's Compressor and Coupler.

Upon the basis of the petitioner's testimony and exhibits in this suit (and upon the basis of the respondent's concurring testimony and exhibits), the petitioner cannot pos-

sibly urge that the Stewart-Warner Company's hydraulic lubricating apparatus does not embody the invention of claim 2 of the Butler patent;—it cannot possibly urge that the combination of the petitioner's headed nipple with the respondent's compressor and coupler does not embody claim 2 of the Butler patent in suit. The petitioner's evidence confirmed the respondent's evidence.

At the trial of the instant suit, the petitioner was obviously aware that the view entertained by the Eighth Circuit Court of Appeals was untenable. It undertook to show, therefore, that although this view was untenable, there were nevertheless other grounds upon which non-infringement might be urged. These other grounds of alleged non-infringement were completely demolished by the discovery and proof that the petitioner's demonstration apparatus had in some way been falsified.

Now, in this Court, therefore, the petitioner has entirely abandoned the contentions of non-infringement to which its evidence was directed in the District Court. It is now asking this Court to adopt the view which was entertained by the Eighth Circuit Court of Appeals despite the fact that it was a view which both parties in the instant suit demonstrated to be erroneous and untenable.

It is wholly upon the basis of this admitted and demonstrated error of the Eighth Circuit Court of Appeals that the petitioner now asks this Court to construe claim 2 of the Butler patent in such a way that it does not even apply to the Stewart-Warner Company's own lubricating apparatus.

Upon the sole basis of this contention that the parts of the equipment sold by the Stewart-Warner Company itself do not embody the invention of its own patent, the petitioner is asking this Court to hold that the Stewart-Warner apparatus does not embody the invention of the Butler pat-

ent, regardless whether its own headed nipple or the headed nipple of the Lincoln Company be incorporated as a part of it.

We respectfully submit that the contention is utterly unsound and untenable, and is contrary to all of the evidence offered by both parties in the instant suit.

We respectfully submit that the Stewart-Warner Corporation's lubricating apparatus does embody claim 2 of the Butler patent in suit.

We respectfully submit that when the petitioner's vendees combine the petitioner's headed nipple with the respondent's compressor and coupler, there is a complete and perfect embodiment of the invention of claim 2 of the Butler patent in suit.

We respectfully submit that the petitioner's manufacture and sale of its headed nipple with the knowledge and intention that its purchasers shall and will combine it in use with the Stewart-Warner Corporation's compressor and coupler parts of the complete combination, is an act of contributory infringement which the Stewart-Warner Corporation is entitled to have enjoined and stopped.

IV.

NOTHING IN THE PRIOR ART ANTICIPATES AND THEREFORE INVALIDATES THE BUTLER PATENT IN SUIT.

BUTLER WAS THE FIRST TO HAVE DEVISED A LUBRICATING SYSTEM OF ANY KIND WHATSOEVER IN WHICH THE TWO HALVES OF THE CONNECTOR MECHANISM WERE AUTOMATICALLY GRIPPED TOGETHER, AND IN WHICH THE END OF THE NIPPLE HALF WAS AUTOMATICALLY SEALED TO THE COUPLER HALF OF THE CONNECTOR BY THE NORMAL OPERATION OF THE COMPRESSOR WHILE IN THE ACT OF INJECTING GREASE INTO AN ASSOCIATED BEARING, AND IN WHICH THE HEADED NIPPLE PART AUTOMATICALLY COCKED AND RESET THE GRIPPING AND END SEALING MECHANISM OF THE COUPLER PARTS FOR COOPERATION WITH A SECOND NIPPLE UPON DISCONNECTING THE COUPLER FROM A FIRST NIPPLE (AND IF NEED BE UPON INITIAL CONNECTION WITH THE SECOND NIPPLE).

NO ONE PRIOR TO BUTLER EVEN RECOGNIZED THE DESIRABILITY OR THE POSSIBILITY OF SUCH A LUBRICATING APPARATUS IN ANY FORM WHATSOEVER.

Upon the trial, Mr. Alexander P. Fox, the defendant's Vice-President and Chief Engineer and expert witness, stated on pages 221 and 226 of the record, that he regarded the Winkley Reissue patent (R. 526) as the closest thing in the prior art to the invention of the Butler patent. In

this Court, counsel for the petitioner completely abandon the Winkley patent, and stress the Newton patent No. 1,118,876 (R. 502) for an air brake hose testing device as substantially anticipating and invalidating the Butler patent in suit.

On pages 60 to 67 of this brief, we have discussed briefly and referred explicitly to the parts of the record showing that this contention is absolutely unwarranted and untenable.

V.

THE BEST EVIDENCE THAT THE BUTLER PATENT DISCLOSES A REAL INVENTION OVER ANYTHING AND EVERYTHING IN THE PRIOR ART, IS THE RECORD OF THE DEFENDANT'S UNSUCCESSFUL EFFORT IN BRASS AND IRON TO INCORPORATE SUCH CHANGES AND MODIFICATIONS AS WOULD RECONSTRUCT NEWTON'S AIR BRAKE HOSE TESTING DEVICE INTO THE LUBRICATING APPARATUS OF THE BUTLER PATENT.

The testimony and exhibits which record this attempt and its failure, are briefly presented in our statement of the facts at pages 61 *et seq.* of this brief. This statement of the facts refers explicitly to the applicable parts of the record.

VI.

THE DEFENDANT'S ANSWER DOES NOT PLEAD OR RAISE ANY ISSUE WITH RESPECT TO THE PETITIONER'S CLAIMS NOW MADE IN THIS COURT FOR THE FIRST TIME THAT THE PLAINTIFF HAS VIOLATED THE CLAYTON ACT (A MATTER WHICH IS NOT IN ANY EVENT A PERMISSIBLE DEFENSE TO A BILL FOR PATENT INFRINGEMENT), OR THAT THE DEFENDANT HAS BEEN LICENSED BY THE CONDUCT OF THE PLAINTIFF TO MANUFACTURE AND SELL THE HEADED NIPPLE PARTS OF THE BUTLER COMBINATION.

The foregoing caption states all that need be said relative to these two new matters, neither of which was presented or urged in the District Court nor in the Court of Appeals.

Since neither the Clayton Act defense nor the license defense was in any way put in issue by the pleadings, neither party adduced any evidence relative to these *de novo* defenses.

Even if this Court were for the first time in this suit, to consider the matter of alleged violations of the Clayton Act, upon the basis of a record which was not directed to that subject in the slightest degree, we are satisfied that it must reach the conclusion that the petitioner has not violated nor attempted to violate the Clayton Act. The Clayton Act prohibits certain contracts of lease or sale. The record is barren of any evidence that *any* lease or contract of sale was ever even entered into by the Stewart-Warner Corporation.

As to the new defense now presented in this Court for the first time, that the Stewart-Warner Corporation has

impliedly licensed the Lincoln Company to manufacture and sell the headed nipple parts of the Butler combination, the authorities are uniform in holding that any defense of license must be pleaded, and that it cannot be raised unless it has been pleaded.

No such defense was pleaded in this suit. Neither party adduced any evidence directed toward this matter of an alleged license. Any consideration which the Court might be tempted to give the matter can be based only upon surmise as to what the real facts are.

The petitioner's *de novo* arguments alleging an implied license to the defendant, assume the fact to be that when Stewart-Warner first sold the compressor and coupler parts of the Butler invention, the world was full of old headed nipple parts with which the purchasers could use these compressor and coupler parts. The fact of the matter is that until the Stewart-Warner Corporation put the Butler invention on the market for the first time in April, 1933, there had not been in all the world a headed nipple with which these compressor and coupler parts could be combined in use.

The record shows that within a few months of the commercial advent of the Butler invention upon the market, every automobile and every automobile truck in America was being equipped at its factory with an installation of the Butler lubricating apparatus. The petitioner's theory of an implied license means that every farmer who bought a new automobile thus equipped at its factory with the lubricating apparatus of the Butler patent, had the right thereupon to make for himself enough additional headed nipples to "increase the repertory" (*Leeds & Catlin v. Victor*, 213 U. S. 325, 331) of his one compressor and coupler, sufficiently to enable him to grease his reaper, his mower, his threshing machine, and his two old automobiles; in do-

ing so, he was to have the benefit of the complete lubricating apparatus of the Butler patent; he was to use the compressor and coupler parts which the automobile manufacturer had bought from the respondent and placed in the tool kit of the new car, whose bearings were equipped with the headed nipple parts which the car manufacturer had purchased from the respondent. The petitioner's theory is that since the farmer acquired some sort of a license indefinitely to expand the size and use of one small installation of the Butler invention, the Lincoln Engineering Company had the right some eighteen months later to step in and begin for the first time to manufacture and sell something which no one other than Stewart-Warner had ever manufactured or sold before, namely, headed nipple parts of a new kind, to be supplied to the farmer to enable him thus to enlarge his use and enjoyment of the Butler combination. The petitioner's theory is that, having the right to supply any number of additional nipple parts to one farmer, it has a right to do the same thing in the case of every one of the purchasers of all of the millions of automobiles which have been sold since April, 1933.

The petitioner's theory is furthermore that when the Stewart-Warner Corporation sold one of its Butler compressor and coupler units to a garageman, so that he might combine these compressor and coupler parts with the headed nipple parts of any one of the 5,000,000 automobiles whose bearings had been equipped at the automobile factories with the headed nipple parts of the complete combination, that that one sale impliedly licensed the garageman not only to grease any one of these 5,000,000 cars but also to make and sell enough additional headed nipple parts to enable him to use the complete combination of the Butler patent in greasing all of the 25,000,000 automobiles which had been sold prior to the advent of the Butler invention upon the market. The record shows (p. 40) that between

April, 1933, and March 31, 1936, the Stewart-Warner Corporation had sold 218,555,000 of the headed nipple parts of the combination. The petitioner's theory is that when the garageman bought a compressor and coupler unit from the Stewart-Warner Corporation, so that he might use it in greasing the cars equipped with all of these millions of headed nipples, he necessarily understood from the Stewart-Warner Company that the Stewart-Warner Company had thereby given him the privilege of making and selling enough of the headed nipple parts to equip the bearings of all of the automobiles which might ever be made in the future. The theory is that upon its first sale of its first compressor and coupler unit to a garageman, the Stewart-Warner Corporation lost all right to the protection of the patent laws in so far as the headed nipple parts of the combination are concerned.

The reverse angle of the petitioner's theory is this: that when Stewart-Warner first sold a dozen of Butler's headed nipple parts without insisting upon the inclusion in that sale of an additional compressor and coupler unit (as, for example, in the case of a farmer who wanted to equip the bearings of his mowing machine), then the purchaser of the nipple parts understood Stewart-Warner to be telling him that he had acquired by virtue of his 25¢ purchase of nipple parts, the right to make for his own use and for sale and use by others, an additional one, or an additional ten million compressor and coupler parts of the combination.

The theory is that since the purchaser of a dozen headed nipples from the Stewart-Warner Corporation acquired the right to make for himself, unlimited quantities of the compressor and coupler parts of the combination, the Lincoln Engineering Company acquired also the right and license to make and to sell these parts to him,—and to everybody else.

The theory is that by the close of its first day's business, the Stewart-Warner Corporation had by necessary implication lost every shred of any exclusive right to make, use or sell any part or parts of the combination which constitutes the invention of its Butler patent in suit.

Just such a theory was advanced by the defendant in the case of *Leeds & Catlin v. Victor*. This Court rejected the theory.

In the present suit the petitioner's theory of implied license is advanced, as we have said, without one word of evidence from any customer of the Stewart-Warner Company or from anyone else, as to what were the understandings or implications involved in the Stewart-Warner Company's sales of the invention of the patent in suit.

The petitioner invites this Court, in the absence of either pleading, or issue, or evidence, to tell the Lincoln Company and all of the world, that Stewart-Warner has licensed them to make, use, and sell all of the component parts of the very best and at the same time the very cheapest lubricating apparatus which the world has ever known.

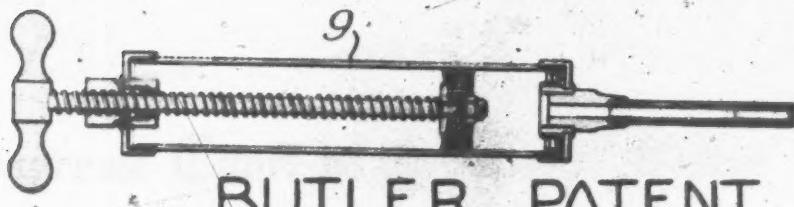
IN CONCLUSION.

We submit that the decree of the Seventh Circuit Court of Appeals should be affirmed.

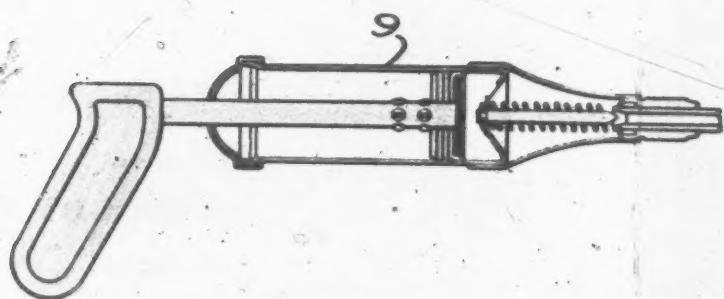
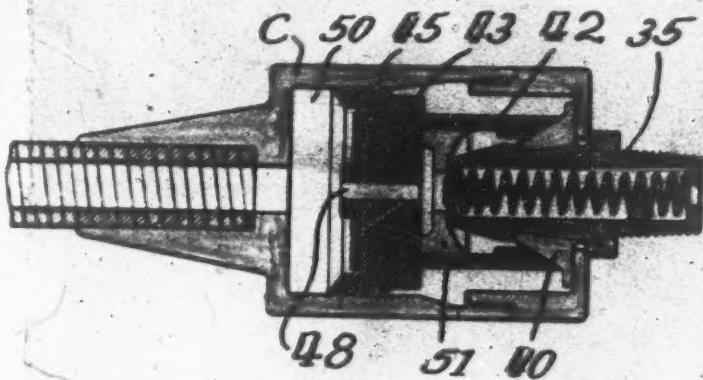
Respectfully,

LYNN A. WILLIAMS,

Counsel for the Respondent.

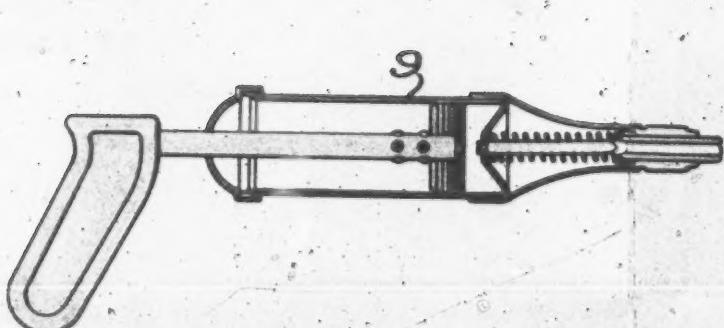
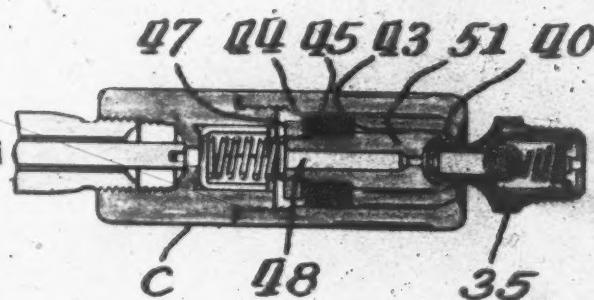


BUTLER PATENT



ALEMITE HYDRAULIC COMPRESSOR,
COUPLER AND NIPPLE

PLAINTIFF'S EX. 34



LINCOLN KLEENSEAL NIPPLE WITH
ALEMITE HYDRAULIC COMPRESSOR
AND COUPLER

PLAINTIFF'S EX. 36

